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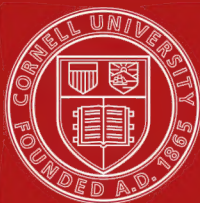
A digest of the law and practice of lett



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A DIGEST  
OF THE  
LAW AND PRACTICE  
OF  
**Letters Patent for Inventions,**  
INCLUDING THE STATUTES AND ALL CASES DECIDED  
FROM THE PASSING OF THE STATUTE OF  
MONOPOLIES TO OCTOBER, 1890.

SECOND EDITION.

BY  
CLEMENT HIGGINS, Q.C.,  
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THE PHYSICAL SOCIETY OF LONDON;

AND  
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IS

MOST RESPECTFULLY DEDICATED

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THE HONORABLE

SIR WILLIAM ROBERT GROVE, D.C.L., F.R.S.,

FORMERLY ONE OF THE JUDGES OF

*The High Court of Justice.*





# P R E F A C E.

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## EXTRACT FROM THE PREFACE TO THE FIRST EDITION.

THIS is essentially a book of reference. Its object is to supply a reliable and exhaustive summary of the reported Patent Law cases decided in English Courts of Law and Equity. No opinion is expressed upon the cases digested, and no attempt is made to reconcile conflicting decisions. All that the book contains rests upon the authority of the Judges. . . . The chronological arrangement of the cases gives a complete history of legal decision on the several points of Law and Practice under which they are arranged. This is the Author's justification for retaining some few overruled cases, and for introducing several decisions upon the same point where they are of different dates.

CLEMENT HIGGINS.

JUNE 1875.

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## PREFACE TO THE SECOND EDITION.

THE bearing of the sections of the Patents, Designs and Trade Marks Act, 1883, on most questions concerning Patents is so immediate and important that it has seemed to us right to state the existing provisions of the Statute Law so as to be easily referred to in connection with the cases relating to similar portions of the subject.

Further, the Act having precluded the possibility of any logical division of the subject other than that adopted by the Act itself, it has seemed advisable to put the various divisions in their

alphabetical order, and thereby to avoid the necessity of a double index with the accompanying trouble to the reader of a double search.

The title has been altered to indicate the more extended scope of the work, but subject to the above exceptions the old form of the book has been retained, including the arrangement of cases in chronological order; and all new decisions up to date have been, with such completeness as we could attain, incorporated under their respective headings.

In giving the sections of the Patents Act, 1883, the words of the amending Acts have been inserted in italics where it has appeared possible to do so without leading to confusion.

CLEMENT HIGGINS,  
5, *Paper Buildings*,  
*Temple.*

G. EDWARDES JONES,  
11, *King's Bench Walk*,  
*Temple.*

Nov. 5, 1890.

## LIST OF ABBREVIATIONS.

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<i>A. &amp; E.</i>	..	..	..	..	..	Adolphus and Ellis's Reports.
<i>App. C.</i>	..	..	..	..	..	Law Reports Appeal Cases.
<i>Arn.</i>	..	..	..	..	..	Arnold's Reports.
<i>B. &amp; Ad.</i>	..	..	..	..	..	Barnewell and Adolphus.
<i>B. &amp; Ald.</i>	..	..	..	..	..	————— Alderson.
<i>B. &amp; C.</i>	..	..	..	..	..	————— Cresswell.
<i>Beav.</i>	..	..	..	..	..	Beavan.
<i>B. &amp; S.</i>	..	..	..	..	..	Best and Smith.
<i>Bing. N. C.</i>	..	..	..	..	..	Bingham's New Cases.
<i>B. Mo.</i>	..	..	..	..	..	B. Moore's Reports.
<i>B. &amp; P.</i>	..	..	..	..	..	Bosanquet and Puller.
<i>Bro. C. C.</i>	..	..	..	..	..	Brown's Chancery Cases.
<i>B. &amp; B.</i>	..	..	..	..	..	Broderip and Bingham.
<i>Bull. N. P.</i>	..	..	..	..	..	Buller's Nisi Prius.
<i>Camp.</i>	..	..	..	..	..	Campbell.
<i>C. &amp; K.</i>	..	..	..	..	..	Carrington and Kirwan.
<i>Car. &amp; M.</i>	..	..	..	..	..	————— Marshman.
<i>C. &amp; P.</i>	..	..	..	..	..	————— Payne.
<i>Carp. P. C.</i>	..	..	..	..	..	Carpmael's Patent Cases.
<i>Ch. D.</i>	..	..	..	..	..	Law Reports, Chancery Division.
<i>C. B.</i>	..	..	..	..	..	Common Bench.
<i>C. B., N. S.</i>	..	..	..	..	..	Common Bench, New Series.
<i>C. L. Rep.</i>	..	..	..	..	..	Common Law Reports.
<i>C. &amp; F.</i>	..	..	..	..	..	Clark and Finnelly's Reports.
<i>Coop.</i>	..	..	..	..	..	Cooper's Reports.
<i>Coop. C. C.</i>	..	..	..	..	..	Cooper's Chancery Cases.
<i>Coryton</i>	..	..	..	..	..	Coryton's Law of Patents.
<i>Cr., M. &amp; R.</i>	..	..	..	..	..	Crompton, Meeson and Roscoe.
<i>C. S.</i>	..	..	..	..	..	Cases in the Court of Session.
<i>Curtis</i>	..	..	..	..	..	Curtis on the Law of Patents.
<i>Dan. &amp; L.</i>	..	..	..	..	..	Danson and Lloyd.
<i>Dav. P. C.</i>	..	..	..	..	..	Davies's Patent Cases.

<i>Dec. of Crt. of Sess.</i> .. .. .	Cases in Court of Session.
<i>De G., F. &amp; J.</i> .. .. .	De Gex, Fisher and Jones.
<i>De G. &amp; J.</i> .. .. .	———— and Jones.
<i>De G., M. &amp; G.</i> .. .. .	————, Macnaghten and Gordon.
<i>De G., J. &amp; S.</i> .. .. .	————, Jones and Smale.
<i>Dick.</i> .. .. .	Dickens's Reports.
<i>Dowl., or D. P. C.</i> .. .. .	Dowling's Reports.
<i>Dow. &amp; Low.</i> .. .. .	Dowling and Lowndes.
<i>D. &amp; R.</i> .. .. .	———— Rylands.
<i>Dr. &amp; S.</i> .. .. .	Drury and Smales.
<i>East</i> .. .. .	East's Reports.
<i>Eden</i> .. .. .	Eden's Reports.
<i>Ell. &amp; B.</i> .. .. .	Ellis and Blackburn.
<i>E., B. &amp; E.</i> .. .. .	———— and Ellis.
<i>E. &amp; E.</i> .. .. .	———— Ellis.
<i>Eq. Rep.</i> .. .. .	Equity Reports.
<i>Ex. Rep.</i> .. .. .	Exchequer Reports.
<i>G. &amp; D.</i> .. .. .	Gale and Davison's Reports.
<i>Giff.</i> .. .. .	Giffard's Reports.
<i>Good. Abst.</i> .. .. .	Goodeve's Abstract of Patent Cases.
<i>Good.</i> .. .. .	———— Patent Cases.
<i>Godson</i> .. .. .	Godson on Patents.
<i>Griff.</i> .. .. .	Griffin's Patent Cases.
<i>Hare</i> .. .. .	Hare's Reports.
<i>H. Bl.</i> .. .. .	H. Blackstone's Reports.
<i>H. &amp; C.</i> .. .. .	Hurlstone and Coltman.
<i>H. &amp; H.</i> .. .. .	Horn and Hurlstone.
<i>H. &amp; M.</i> .. .. .	Hemming and Miller.
<i>H. &amp; N.</i> .. .. .	Hurstone and Norman.
<i>H. L. C.</i> .. .. .	House of Lords Cases.
<i>H. &amp; W.</i> .. .. .	Harrison and Wollaston.
<i>Hind. on Pat.</i> .. .. .	Hindmarch on Patents.
<i>Holroyd</i> .. .. .	Holroyd on Patents.
<i>Holt N. P.</i> .. .. .	Holt's Nisi Prius Reports.
<i>Johns.</i> .. .. .	Johnson's Reports.
<i>Johnson's Pat. Man.</i> .. .. .	———— Patentees' Manual.
<i>J. &amp; H.</i> .. .. .	Johnson and Hemming.
<i>Jur.</i> .. .. .	Jurist Reports.
<i>K &amp; J.</i> .. .. .	Kay and Johnston.
<i>Keen</i> .. .. .	Keen's Reports.



<i>L. J. Ch.</i> .. .. .	Law Journal, Chancery.
— <i>Q. B.</i> , or <i>K. B.</i> .. .. .	Queen's Bench ( <i>or</i> King's).
— <i>C. P.</i> .. .. .	Common Pleas.
— <i>Exch.</i> .. .. .	Exchequer.
— <i>P. C.</i> .. .. .	Privy Council.
<i>L. R.</i> .. .. .	Reports.
<i>L. T.</i> .. .. .	Times Reports.
<i>Lawson</i> .. .. .	Lawson's Patents, Designs and Trade Marks.
<i>Lond. Jour.</i> .. .. .	London Journal.
<i>Macr. P. C.</i> .. .. .	Macrory's Patent Cases.
<i>M. &amp; G.</i> .. .. .	Macnaghten and Gordon.
<i>M. Dig.</i> .. .. .	Monthly Digest of Cases.
<i>M. &amp; W.</i> .. .. .	Meeson and Welby's Reports.
<i>M. &amp; Sc.</i> .. .. .	Moore and Scott's Reports.
<i>Marsh.</i> .. .. .	Marshall's Reports.
<i>Mer.</i> .. .. .	Merivale's Reports.
<i>Mod.</i> .. .. .	Modern Reports.
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<i>Noy</i> .. .. .	Noy's Reports.
<i>O. R.</i> .. .. .	Patent Office Reports.
<i>Par. Rep. Pat.</i> .. .. .	Parliamentary Reports.
<i>P. Wms.</i> .. .. .	Peere Williams's Reports.
<i>Ph.</i> .. .. .	Phillips's Reports.
<i>Prac. Mech. J.</i> .. .. .	Practical Mechanics' Journal.
<i>Prerog. Court</i> .. .. .	Prerogative Court.
<i>Rep. Arts.</i> .. .. .	Repertory of Arts and Sciences.
<i>Rom. Notes to Cases</i> .. .. .	Romilly's Notes to Cases.
<i>Russ.</i> .. .. .	Russell's Reports.
<i>Russ. &amp; M.</i> .. .. .	Russell and Mylne.
<i>Ry. &amp; M.</i> .. .. .	Ryan and Moody.
<i>S., M. &amp; P.</i> .. .. .	Stuart, Milne and Peddie (Scotch).
<i>Scott</i> .. .. .	Scott's New Reports.
<i>Sim.</i> .. .. .	Simon's Reports.

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<i>Swan.</i>	..	..	..	.	..	..	Swanston's Reports.
<i>Taun.</i>	..	..	..	..	..	..	Taunton's Reports.
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# DIGEST OF PATENT LAW.

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## Abandoned Invention.

PATENTS ACT, 1883, sect. 8. (1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.

(2) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

(This period of nine months may now be extended by one month under Patents Act, 1885, sect. 3, *infra*, p. 35.)

By Patents Act, 1885, sect. 4, where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application, shall not at any time be open to public inspection or be published by the comptroller.

### (a) LEWIS *v.* MARLING. [1829]

The abandonment of a part of the invention not suggested as essential will not vitiate the patent. (1 *Web. P. C.* 490.)

### (b) JONES *v.* PEARCE. [1832]

An experiment abandoned as useless on account of defects is not an anticipation of a similar invention in which the defects are remedied. (1 *Web. P. C.* 122.)

### (c) HOUSEHILL COMPANY *v.* NEILSON. [1843]

An invention which has been publicly used and subsequently abandoned will invalidate a subsequent patent for a similar invention. (1 *Web. P. C.* 710.)

### (d) *In re* CARD'S PATENT. [1848]

A general knowledge of an invention, if it is abandoned and not carried out, will not invalidate the patent which has perfected it. (6 *Moo. P. C. C.* 212.)

### (e) OXLEY *v.* HOLDEN. [1860]

A provisional specification abandoned did not become public by abandonment. (30 *L. J. C. P.* 68; 8 *C. B., N. S.*, 666.)

## Abridgments.

PATENTS ACT, 1883, sect. 40 (3). The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.

## Acceptance.

PATENTS ACT, 1883, sect. 7 (4), amended by Patents Act, 1888, sect. 2 (4). The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

Sect. 10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings (if any) shall be open to public inspection.

Sect. 15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

See also under Application, p. 33; and under Specification, p. 408.

**Account** of profits. See under Practice Account, pp. 367 to 372.

**Accounts** of petitioner for prolongation of patent. See under Extension of Term, pp. 95, *seq.*

**Acquiescence.** See under Practice Injunction, Delay, and Acquiescence, pp. 346 to 349.

**Action.** See under Practice.

**Addition** to a known machine or process. See under Subject Matter, pp. 518 to 522.

## Address.

PATENT RULES, 1890, 9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the comptroller. He may in any particular case require that the address mentioned in this Rule be in the United Kingdom.

**Administrator** of inventor may obtain patent, Patents Act, 1883, sects. 12 and 34, p. 81.

**Advertisements** on Petition for Extension. See under Extension of Term Petition, p. 98.

of acceptance of complete specification, p. 2.

of amendment when proposed and when accepted. See under Amendment of Specification, p. 11.

threatening legal proceedings. See under Threats, p. 545.

in derogation of grant, 216, (*k*).



**Affidavits.** See Practice—Affidavits, p. 358.

## Agents.

### *Register of Patent Agents—*

established by 51 & 52 Vict., c. 50, p. 3

Rules made by Board of Trade as to Register, pp. 3 to 6.

### *Agents generally—*

Rules of 1890 as to, rules 8 and 69, p. 6

negligence of, p. 7 (*j*)

may petition for extension, p. 7 (*i*)

infringement by, pp. 6 (*e*), 7 (*h*), 8 (*l*) (*m*)

testing of invention by, is no publication, p. 6 (*f*)

merely for sale cannot bring action for infringement, p. 7 (*k*)

may sign notice of appeal if authorised, p. 8 (*n*).

### *Register of Patent Agents.*

PATENTS ACT, 1888, sect. 1. (1) After the 1st day of July, 1889, a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of section 101 of the principal Act shall apply to all Rules so made, as if they were made in pursuance of that section.

(3) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been *bonâ fide* practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

THE RULES made in pursuance of this section, dated 11th June, 1889, are published in the Gazette of June 14th, 1889. The most important portions of these are as follows:—

[NOTE.—Rules 5 to 7 and 10 to 18 inclusive are given verbatim, but of the remaining rules the effect only is given.]

Rule 1. A Register shall be kept by the Institute of Patent Agents for the registration of patent agents in pursuance of the Act.

2. Such Register shall contain in one list all patent agents who are registered under the Act and these Rules; such list to be alphabetical and to contain the full name and address, date of registration, and such honours, memberships, or other additions as the Council of the Institute may think worthy of mention.

3. A copy of the Register is to be published by the Institute on every 31st of January, and is to be admissible as evidence of all matters stated therein, and the absence of the name of any person from the Register is to be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act.

4. The Institute is to appoint a Registrar who shall keep the Register in accordance with the provisions of the Act and Rules, and subject thereto shall act under the directions of the Institute and the Board of Trade.

5. A person who is desirous of being registered in pursuance of the Act, on the ground that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, shall produce or transmit to the Board of Trade a statutory declaration in the Form 2 in Appendix A; provided that the Board of Trade may in any case in which they shall think fit, require further or other proof that the person had prior to the passing of the Act been *bonâ fide* practising as a patent agent. Upon the receipt of such statutory declaration or of such further or other proof to their satisfaction as the case may be, the Board of Trade shall transmit to the Registrar a certificate that the person therein named is entitled to be registered in pursuance of the Act, and the Registrar shall on the receipt of such certificate cause the name of such person to be entered in the Register.

6. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board of Trade that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, no person shall be entitled to be registered as a patent agent unless he has passed, and produces or transmits to the Registrar a certificate under the seal of the Institute that he has passed, such final examination as to his knowledge of patent law and practice and of the duties of a patent agent as the Institute shall from time to time prescribe.

7. Any person who has been for at least seven consecutive years continuously engaged as a pupil or assistant to one or more registered patent agents, and any person for the time being entitled to practise as a Solicitor of the Supreme Court of Judicature in England or Ireland, or as a Law Agent before the Court of Session in Scotland, shall be entitled to be registered without passing any examination other than the final examination provided for in the last preceding Rule. The Registrar shall before registering the name of any such person as a patent agent (in addition to the final examination certificate) require proof satisfactory to the Registrar that such person has been for at least seven consecutive years continuously engaged as such pupil or assistant, or is entitled to practise as such Solicitor or Law Agent.

8. Any person who is not qualified under Rule 7 must, in order to be entitled to present himself for the final qualifying examination, be a person who has passed one of the following examinations, or such other examination as the Institute shall with the approval of the Board of Trade prescribe:

(1.) The Matriculation Examination at any University in England, Scotland, or Ireland.

(2.) The Oxford or Cambridge Middle Class Senior Local Examinations.

(3.) The Examinations of the Civil Service Commissioners for admission to the Civil Service.

9. The Institute shall hold at least once in the year, commencing July 1st, 1889, and in every other succeeding year, a final qualifying examination, which shall be the final qualifying examination under Rules 6 and 7; and the Institute shall subject to these Rules have the entire management and control of all such examinations.

10. The Registrar shall from time to time insert in the Register any alteration which may come to his knowledge in the name or address of any person registered.

11. The Registrar shall erase from the Register the name of any registered person who is dead.

12. The Registrar may erase from the Register the name of any registered person who has ceased to practise as a patent agent, but not (save as herein-after provided) without the consent of that person. For the purposes of this Rule the Registrar may send by post to a registered person to his registered address a notice inquiring whether or not he has ceased to practise or has changed his residence, and if the Registrar does not within three months after sending the notice receive an answer thereto from the said person, he may,

within fourteen days after the expiration of the three months, send him by post to his registered address another notice referring to the first notice, and stating that no answer has been received by the Registrar; and if the Registrar either before the second notice is sent receives the first notice back from the Dead Letter Office of the Postmaster-General, or receives the second notice back from that office, or does not within three months after sending the second notice receive any answer thereto from the said person, that person shall, for the purposes of this Rule, be deemed to have ceased to practise, and his name may be erased accordingly.

13. If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the Registrar may send to such registered person to his registered address a notice requiring him, on or before a day to be named in the notice, to pay his annual registration fee; and if such registered patent agent shall not within one month from the day named in such notice pay the registration fee so due from him, the Registrar may erase his name from the Register: Provided that the name of a person erased from the Register under this rule may be restored to the Register by direction of the Institute or the Board of Trade on payment by such person of the fee or fees due from him, together with such further sum of money, not exceeding in amount the annual registration fee, as the Institute or the Board of Trade (as the case may be) may in each particular case direct.

14. In the execution of his duties the Registrar shall, subject to these Rules, in each case act on such evidence as appears to him sufficient.

15. The Board of Trade may order the Registrar to erase from the Register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

16. If any registered person shall be convicted in Her Majesty's dominions or elsewhere of an offence which, if committed in England, would be a felony or misdemeanour, or after due inquiry, is proved to the satisfaction of the Board of Trade to have been guilty of disgraceful professional conduct, or having been entitled to practise as a Solicitor or Law Agent shall have ceased to be so entitled, the Board of Trade may order the Registrar to erase from the Register the name of such person. Provided that no person shall be adjudged by the Board of Trade to have been guilty of disgraceful professional conduct unless such person has received notice of, and had an opportunity of defending himself from, any charge brought against him.

17.—(1.) Where the Board of Trade direct the erasure from the Register of a name of any person, or of any other entry, the name of the person or the entry shall not be again entered in the Register, except by order of the Board of Trade.

(2.) The Board of Trade may in any case in which they think fit restore to the Register any name or entry erased therefrom either without fee, or on payment of such fee, not exceeding the registration fee, as the Board of Trade may from time to time fix, and the Registrar shall restore the name accordingly.

(3.) The name of any person erased from the Register at the request or with the consent of such person shall, unless it might, if not so erased, have been erased by order of the Board of Trade, be restored to the Register by the Registrar on his application and on payment of such fee, not exceeding the registration fee, as the Institute shall from time to time fix.

18. For the purpose of exercising in any case the powers of erasing from and of restoring to the Register the name of a person, or an entry, the Board of Trade may appoint a committee consisting of such persons as they shall think fit. Every application to the Board of Trade for the erasure from, or restoration to, the Register of the name of any patent agent shall be referred for hearing and inquiry to the committee, who shall report thereon to the Board of Trade, and a report of the committee shall be conclusive as to the

facts for the purpose of the exercise of the said powers by the Board of Trade.

19. Any person aggrieved by any order, direction, or refusal of the Institute or Registrar, may appeal to the Board of Trade.

20. Such person shall, within fourteen days from the date of making or giving of the order, direction, or refusal complained of, leave at the office of the Institute, a notice in writing, signed by him, of his intention to appeal.

21. Such notice is to be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

22. The appellant shall, immediately after leaving such notice, send by post a copy of such notice, with a copy of the case in support thereof, to the Secretary of the Board of Trade, 7, Whitehall Gardens, London.

23. The Board of Trade may thereupon give such directions, if any, as they may think fit as to hearing the appeal.

24. Seven days' notice, or such shorter notice as the Board may direct, shall be given to the appellant, and the Institute, and the Registrar, of the time and place of the hearing.

25. The appeal may be heard by the President, or Secretary, or an Assistant Secretary of the Board of Trade.

26. The following fees are to be paid to the Registrar :—

For registration of name .. .. .	£5	5	0
Annual fee to be paid by every registered patent agent on or before November 30th of each year in respect of the year commencing January 1st following .. .. .	£3	3	0
On entry of candidate for final qualifying examination .. .. .	£2	2	0

#### *Agents generally.*

PATENT RULES, 1890. Rule 8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the comptroller and all attendances by the applicant upon the comptroller may be made by or through an agent duly authorised to the satisfaction of the comptroller, and, if he so require resident in the United Kingdom.

Rule 69. (A request for entry of subsequent proprietorship in the Register) shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorised in like manner.

(e) GIBSON *v.* BRAND. [1842]

He who causes and procures to be made articles which are infringements is himself guilty of infringement. (1 *Web. P. C.* 631.)

(f) BENTLEY *v.* FLEMING. [1844]

The testing of an invention by an agent is no publication. (1 *C. & K.* 587.)

(g) STEEDMAN *v.* MARSH. [1856]

(See *Milligan v. Marsh*, 2 *Jur. N. S.* 1083). Wood, V.-C. : If the defendant had been Milligan's agent, and had availed himself of that capacity to wrong Milligan, the Court would probably have held him a trustee for any use he chose to make for his own

benefit of the property so entrusted to him as general agent. (2 *Jur.*, N. S., 391.)

(h) WHEATSTONE v. WILD. [1861]

Wood, V.-C.: A person who endeavours to place himself in the position of an agent to a patentee, and afterwards infringes his patent, is in a different position from a mere ordinary manufacturer who says, "I have a right, as a rival manufacturer, to avail myself of a flaw in your patent, or of a distinction between my patent and yours." The position of an agent is different, for whatever information he has gained is acquired confidentially, and there is a *prima facie* presumption against his coming into the field as a fair competitor against the person who originally obtained the patent. (*Griff.* 247.)

(i) *In re* NEWTON'S PATENT. [1861]

Extension granted to a petitioner who had obtained the letters patent as agent and trustee for a foreign inventor. (14 *Moo. P. C. C.* 156.)

(j) LEE v. WALKER. [1872]

On the 28th of April, 1870, the plaintiffs retained the defendant, a patent agent, to obtain for them letters patent for "a new automatic vase or dépôt for holding coals," and on the 30th a provisional specification was filed. Nothing more was done by the defendant until the end of August, when he gave notice of his intention to proceed with the patent, pursuant to sect. 12 of 15 & 16 Vict. c. 83; and in October he applied for the fiat of the Attorney-General for sealing the patent.

In the meantime, viz., on the 15th of June, 1870, one P. had, as the defendant was aware, filed a provisional specification for "improvements in coal vases," substantially the same as the plaintiff's invention, and had, on the 10th of September, obtained a grant.

The Attorney-General rejected the plaintiffs' application, upon the authority of the decision in *Ex parte Bates*, of which, though pronounced in May, 1869, the defendant was ignorant:—*Held*, that there was evidence of negligence on the part of the defendant. (*L. R.*, 7 *C. P.* 121.)

(k) ADAMS v. NORTH BRITISH RAILWAY COMPANY. [1873]

To a bill stating an agreement made between a general agent of the patentees of an American invention to introduce and sell the invention in Great Britain and the plaintiff, whereby the plaintiff was to have the sole agency and control of the working of the patent in England upon certain terms, including a share of royalties and profits, praying for an account for damages, and an injunction to restrain future infringements, the defendants, who were alleged to be using the invention, demurred:—*Held*, that the plaintiff was a mere agent for the sale of the invention, and was in no such position as gave him the right to file such a bill, which

was in the form of a patentee's bill for infringement. (29 *L. T. Rep., N. S.*, 367.)

(l) *TOWNSEND v. HAWORTH*. [1875]

A. does not infringe a patent for the use of well-known chemical substances in a specified manner by selling the known chemical substances to B. with knowledge that B. intends to use them in infringement of the patent, the validity of which he disputes. (*L. R.*, 12 *Ch. D.* 831 (*n.*), and *v. inf.*, p. 165 (*u.*))

(m) *BAILLIE v. GOODWIN & Co.* [1886]

An action was instituted against the defendants, who were resident in Scotland, for infringement of a patent for improvements in stamping corrugated plates. The defendants employed one Macphail, who had offices at 20, Bucklersbury, as their agent, and, as they alleged for convenience, the defendants' firm's name was affixed to these offices, and the firm's letter paper was headed "London Office, 20, Bucklersbury, Mansion House, E.C." The writ was served on Macphail, and the defendants moved to set aside service on the ground that Macphail had no authority to take orders for the defendants, and that the defendants did not manufacture, sell, or exhibit goods at Macphail's offices, and that their business was not managed or directed by him:—*Held*, that Macphail was only an agent and not a servant of the defendants, and that the service must be set aside. (3 *O. R.* 283.)

(n) *ANDERSON AND MCKINNELL'S APPLICATION*. [1887]

An agent duly authorised may sign a notice of appeal from the comptroller to the law officer. (2 *Griff.* 23.)

**Alteration.** See Amendment.

**Ambiguity** in Specification. See Specification, Complete, Ambiguity in, pp. 436 to 445.

(o) *CAMPION v. BENYON*. [1821]

If there be any ambiguity, either in the patent itself or in the specification in any material point, it is of itself a ground for rendering the patent absolutely void. (6 *B. Mo.* 71; 3 *B. & B.* 5.)

(p) *NEILSON v. HARFORD*. [1841]

Where the title was ambiguous, but was sufficiently explained by the specification, and was not at variance with it, held that such ambiguity was not fatal. (8 *M. & W.* 806; 1 *Web. P. C.* 331.)

**Amendment.**

*Amendment generally—*

Patents Act, 1883. Sects. 7, 9, 18, 19, 20, 21. Rules 52 to 59, pp. 9 to 11

conditions annexed to, p. 12 (*r*)

should not include knowledge acquired subsequently, 12 (*s*)

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*Amendment by Disclaimer—*

patentee who has assigned may enter disclaimer, p. 12 (t)

amendment by disclaimer asked for before the grant, p. 13 (y)

what is a pending action within sect. 18, sub-sect. 10, pp. 12 (w), 13 (a) (b), 14 (c) (f)

amendment not in accordance with advertisement, p. 14 (g)

cannot be opposed by one of the public on ground of prior patent, p. 14 (d)

must not unjustifiably impute want of novelty to prior patent, p. 14 (e).

*Amendment by Disclaimer, when allowed, and on what terms—*

invalidity of patent, 15 (i) (j)

want of novelty in part, 15 (m)

materiality in part, 15 (l) (m)

extension of exclusive right, pp. 15 (k) (l), 17 (r), 24 (t)

creation of a new liability, p. 15 (m)

reasons for entering, pp. 16 (o), 24 (v)

removal of all claiming clauses, p. 17 (s)

verbal alterations, p. 17 (s)

should appear on face of specification, p. 16 (n)

amendments which would make the invention substantially different not allowed, pp. 16 (g), 17 (r) (t), 18 (u) (w), 19 (k)

but should be allowed when there is a doubt, pp. 16 (n), 18 (u).

*Terms imposed—*

discretion of judge as to, is unfettered, pp. 21 (d), 22 (i)

when leave given pending action, pp. 20 (y) (a) (b), 21 (e) (e<sup>1</sup>) (f), 22 (g) (h) (i)

when no action is pending, pp. 19 (x) (u), 21 (c) (d), 23 (q).

*Operation of—*

becomes part of patent, pp. 22 (l) (m), 23 (o)

does not import invalidity of patent, p. 23 (n)

on infringements prior to, pp. 22 (l), 23 (n) (o) (p)

not explanatory of specification, p. 23 (r)

introductory sentences, p. 24 (v)

reasons for entering, p. 16 (o), 24 (v)

is an irrevocable surrender of the part disclaimed, p. 25 (z)

is a nullity if it makes the patent substantially larger, p. 27 (f)

effect of terms imposed as condition for allowing amendment on stock in hand, p. 26 (a) (b) (c).

*Practice—*

Comptroller-General as a rule should neither give nor receive costs, p. 28 (l).

*Amendment of clerical errors—*

Patents Act, 1883, sect. 91: Rules 16 and 59, p. 28.

*Amendment of Particulars of Breaches, p. 319 (w)*

———— *Particulars of Objections*, pp. 305 (s) (t), 306 (v) (w) (x)

———— *Petition for Extension*, p. 104 (a).

*Amendment generally.*

PATENT ACT, 1883, sect. 7, amended by Patents Act, 1888, sect. 2.

For sect. 7 of the principal Act the following section shall be substituted:

7.—(1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may *refuse to accept the application*, or require that the application, specification, or drawings be amended before he proceeds with the application; *and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.*

(2.) Where the comptroller *refuses to accept an application* or requires an amendment, the applicant may appeal from his decision to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any) the application shall be accepted.

[For sub-sects. (4) (5), see p. 35.]

By Patents Act, 1883, sect. 9, (1) amended by Patents Act, 1885, sects. 3, 4. Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

(2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

[For sub-sects. (4) and (5), see p. 35.]

PATENTS ACT, 1883, sect. 18, amended by 51 & 52 Vict. c. 50, sect. 5.

(1.) An applicant or a patentee may, from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same.

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3.) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5.) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6.) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8.) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.



(10.) The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding *for revocation of a patent is pending*.

19. (1.) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

21. Every amendment of a specification shall be advertised in the prescribed manner.

PATENT RULES, 1890, 52. A request for leave to amend a specification must be signed by the applicant or patentee, hereinafter in Rules 54, 55, and 58 called the applicant, and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct.

53. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy.

54. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant.

55. Within fourteen days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition and on so leaving shall deliver to the applicant a list thereof.

56. Upon such declarations being left, and such list being delivered, the provisions of Rules 38, 39, 40, 41, and 44 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated.

57. Where leave to amend is given the applicant shall, if the comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 30, and 31.

58. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office.

59. Every amendment of a specification shall be forthwith advertised by the comptroller in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct.

#### (g) HADDAN'S PATENT. [1885]

In the absence of special circumstances, the amendment of a patent of earlier date will date from the 1st of January, 1884.  
(2 *Griff.* 12.)

## (r) ASHWORTH'S PATENT. [1886]

In settling the conditions to be annexed to an amendment, the law officer would consider it a special circumstance if the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claims. If there is no special circumstance, the law officer will not deprive the patentee of the right which he has according to the settled rule of suing in respect of matters before the amendment, but after the 1st of January, 1884. (2 *Griff.* 6.)

## (s) BECK AND JUSTICE'S PATENT. [1886]

An unopposed application to amend a specification of a patent for improvements in nozzles, for the escape of steam or gases under pressure, was refused as to an amendment which referred to the exhaust of gas engines, as these had not been mentioned in the original patent. Webster, A. G.: "The function of an explanation within sect. 18 is to explain more clearly what is necessary to understand the meaning of the patentee at the time he patented the invention. I do not think it is intended that he should put in subsequently ascertained knowledge." (2 *Griff.* 10.)

*Amendment by Disclaimer.*

## (t) SPILSBURY v. CLOUGH. [1842]

A grantee of letters patent, though having entirely parted with his interest, may enter a disclaimer. (2 *Gale & Dav.* 17; 6 *Jur.* 579; 2 *Q. B.* 466; 1 *Web. P. C.* 255.)

## (u) WALLINGTON v. DALE. [1852]

A grantee had assigned his letters patent before the expiration of the six months within which the specification was to be filed, and after this assignment disclaimed part of the title of the letters patent:—*Held*, that the disclaimer was valid as soon as it was entered of record. (7 *Each.* 888; 23 *L. J. Ex.* 49.)

(v) *In re* GARE'S PATENT. [1884]

The 18th section of the Act of 1883 does not affect the jurisdiction of the Master of the Rolls, to allow an amendment in a patent specification which has been filed under sects. 27 and 28 of the Patents Act of 1852, or has otherwise become a record. So long as it is in the Patent Office, and before the patent is sealed, any one applying for amendment must proceed under sect. 18 of the Act of 1883. (26 *Ch. D.* 105; *Griff.* 309.)

## (w) CODD'S PATENT. [1884]

At the time when the patentee applied for leave to amend, there were two actions pending in respect of the patent, and in only one of these had leave to apply been obtained from the Court under sect. 19:—*Held* by the Comptroller-General, that leave must also be obtained in the second action. (*Griff.* 305.)

(x) *WINTER v. BAYBUT.* [1884]

An action for infringement having been commenced in the Palatine Court and the pleadings having been closed, the plaintiffs applied to the Vice-Chancellor for liberty to apply under sect. 19 for leave to disclaim. The Vice-Chancellor being of opinion that the words, the Court or a judge, must mean a judge having power to try for infringement, held that he had jurisdiction to give liberty to apply, and gave liberty on the terms, that the plaintiffs should pay all the costs of the action up to date. (1 *O. R.* 77.)

But now see *Proctor v. Sutton Lodge Chemical Company.* (5 *O. R.* 184.) The Palatine Court is not "a Court or a judge" within the meaning of the Patents Act, 1883. See p. 392 (y).

(y) *JONES'S PATENT.*

Sect. 18 was intended to apply to the amendment of specifications after they had become public property; any other amendments must be dealt with under sects. 7 and 9. (*Griff.* 313.)

(z) *DART'S PATENT.*

The Comptroller-General has power under sect. 7 (1) to order an amendment of the title in the application, if in his opinion the title does not sufficiently indicate the invention described in the provisional specification; but if the applicant merely desires to omit part of the invention described in the original title and provisional specification, he may do so without amendment by a proper disclaiming clause in his complete specification, or may lodge a complete specification omitting the part desired to be left out, and the Patent Office may permit the original application and provisional specification to be amended accordingly, provided the amendment is confined to excision only. (*Griff.* 307.)

(a) *SINGER v. HASSON.* [1884]

Sect. 19 applies to an action for infringement, which was pending at the passing of the Act, and the Court has power in such an action to give the plaintiff liberty to apply for leave to amend. (50 *L. T.* 326.)

(b) *CROPPER v. SMITH (No. 2).* [1884]

In an action for infringement of a patent, the plaintiffs obtained a judgment against the defendants, S. and H.; but on appeal that judgment was reversed against S., but upheld against H. The plaintiffs afterwards applied, under sect. 18 of the Act of 1883, to amend their specification by way of disclaimer. Subsequently H. appealed to the House of Lords against the decision of the Court of Appeal. The Comptroller-General declined to proceed with the plaintiffs' application, which was opposed until the opinion of the Court had been taken under sect. 19, as to whether the appeal to the House of Lords was a pending litigation within sect. 18, sub-s. 10, and the plaintiffs took out a summons that they might be

at liberty to disclaim:—*Held* that the words, “other legal proceedings in relation to a patent,” in sect. 18, subs. 10, refer to a proceeding for the revocation of a patent, and that an “action for infringement . . . pending” means an action before judgment and the summons was dismissed.<sup>1</sup> (28 *Ch. D.* 148.)

(c) COCHRANE’S PATENT. [1885]

An applicant for the grant of a patent which was opposed applied for leave to amend:—*Held* by the Comptroller-General that the application for leave to amend should be heard before the application for the grant, and that the latter was not a “legal proceeding” within the terms of sect. 18, subs. 10:—*Held*, further, by the law officer that the amendment asked for should be allowed, the effect being to confine the invention to a particular class of slag boxes, which was included with others in the previous claim. (*Griff.* 304.)

(d) BELL’S PATENT. [1887]

It is not competent for a member of the public to set up as a ground of opposition to a proposed amendment, that the patent as amended would still be for substantially the same invention as that described in a prior patent. (2 *Griff.* 10.)

(e) HAMPTON & FACER’S PATENT. [1887]

A disclaimer cannot be permitted which imputes to former similar patents a want of novelty which is not proved to exist. (2 *Griff.* 13.)

(f) *In re* HALL. [1888]

An action having been commenced, under sect. 32 of the Patents Act, 1883, for an injunction to restrain patentees from issuing threats, the patentees brought a cross action for infringement. The patentees then applied in the cross action, and obtained leave from Kay, J., under sect. 19, to apply to the Comptroller-General for leave to amend their specification by way of disclaimer. Upon an application for a writ of prohibition to the Comptroller-General, to prevent him from hearing the application, on the ground that there was “a legal proceeding in relation to the patent pending” within the meaning of sub-s. 10 of sect. 18:—*Held*, that Kay, J. had jurisdiction to make the order, and the prohibition was refused.

It is clear that the procedure under sect. 18 is meant to apply to cases when leave is given by a judge under sect. 19, and a judge has power to give such leave in one legal proceeding, although there may be other legal proceedings pending. (21 *Q. B. D.* 141; 5 *O. R.* 306.)

(g) *REG. v. ATTORNEY-GENERAL.* [1888]

An application for a rule nisi, for a prohibition to prevent the Attorney-General proceeding with an application under sect. 18

<sup>1</sup> See now 51 & 52 Vict. c. 50. s. 5.

of the Act of 1883, was made on two grounds: (1) That the amendment, which was about to be allowed, would extend the grant in the patent; and the decision would be conclusive without any right of appeal, and thereon the rule was refused. (2) That the amendment asked for was not in accordance with the advertisement, and thereon the rule nisi was allowed. (*T. L. Rep.*, IV., 489.)

(h) *Ex parte* SIMON. [1888]

This was an appeal from the first part of the decision in *Reg. v. Attorney-General*, and the Court of Appeal agreed with the Divisional Court that a prohibition should not go. If the Attorney-General allowed an amendment which made the patent substantially larger, or substantially different, such amendment is a nullity. The Attorney-General, acting under sect. 18, is not a "Court," and no prohibition will lie to him. (*T. L. R.*, IV., 754.)

*Amendment by Disclaimer, when allowed and on what terms.*

(i) *In re* DEROSNE'S PATENT. [1835]

A disclaimer may be made after judgment of a court of law adverse to the validity of the patent. (1 *Carp. P. C.* 698.)

(j) *MORGAN v. SEAWARD*. [1838]

A patentee may disclaim a part of his invention after verdict adverse to the validity of a patent, and thus preserve the new and useful parts of the patent. (2 *Carp. P. C.* 104.)

(k) *In re* SHARP'S PATENT. [1840]

If the memorandum goes beyond the Act (5 & 6 Will. 4, c. 83) it is void, and cannot be given in evidence or made any use of. (1 *Web. P. C.* 643.)

(l) *R. v. WHEELER*. *Sci. fac.* [1850]

Maule, J.: "The spirit of the Act (5 & 6 Will. 4, c. 83) seems to be this—that, where there are objections that go only to a small and insignificant part of a patent, which, if sustained, would defeat it altogether, the patentee may relieve himself from the difficulty by a disclaimer." (10 *C. B.* 395; 20 *L. J. C. P.* 16.)

(m) *REG. v. MILL*. [1851]

Romilly, M.R.: "The power to disclaim given by Lord Brougham's Act (5 & 6 Will. 4, c. 83) is very valuable, and of great importance to patentees; but it is a power which, if indiscriminately exercised, would work considerable injustice to the public. In many cases a person may make an invention, some part of which may be comprised in another patent, which he may be advised is wholly invalid, and yet, by the effect of a subsequent disclaimer, it may become perfectly good, and a liability created which did not previously exist. It is very desirable to afford protection to patentees in consequence of the difficulties arising

from the nature of the subject and the state of the law. It is proper they should be allowed to correct errors in their patents by removing from the specification *parts which are not material or substantial*, or which they have since discovered not to be new inventions; but this power ought to be exercised with great care and discretion." (14 *Beav.* 315.)

(n) *In re* BATEMAN & MOORE'S PATENT. [1854]

Where there was some evidence, upon the face of the specification, that the patentees intended their invention to comprise an entire apparatus, but at the end of the specification they claimed the several parts of the apparatus, Bethell, S. G., allowed a disclaimer, the effect of which was to convert the claim into one for the combination.

Upon an application for a disclaimer, the matter must be decided on the words of the specification itself, irrespective of extraneous considerations.

In cases of doubt a disclaimer should be allowed, as the refusal of the law officer to grant the application is final and irrevocable, and may be of serious consequence to the patentee; whereas, if he wrongly grant his fiat so as to extend the claim of the invention, the public will not be injured, as the disclaimer will be void. (*Macr. P. C.* 116.)

(o) *In re* LUCAS'S PATENT. [1854]

No disclaimer can be allowed without a statement of a reason for entering it. (*Macr. P. C.* 235.)

(p) *LISTER v. LEATHER.* [1858]

Those matters which manifestly form no part of an invention need not be disclaimed. (8 *El. & B.* 1034.)

(q) *FOXWELL v. BOSTOCK.* Ch. [1864]

Where, by the operation of a disclaimer, a combination of machinery, described in an amended specification, is different from the combination of machinery described in the original specification, and for which the patent was granted; *Quære*, whether the patent is void, or the disclaimer void? Where the amount by which the disclaimer exceeds the statutory requirements as to its nature can be easily distinguished, the disclaimer is inoperative for such excess.

*Semble*: where the combination of machinery in an amended specification was different from the combination in the original specification, and no specification remained of the invention for which the patent was granted; and where, the combination being claimed as the invention, it was only so far ascertained by the specification, that the latter referred to certain drawings and their description, which did but describe an entire machine and the composition and working of its several constituent parts, without in any manner indicating where the improvement lay or in what

it consisted:—*Held*, that the patent was void at law. (4 *De G., J. & S.* 298; 10 *L. T., N. S.*, 144; 12 *W. R.* 723.)

(r) *RALSTON v. SMITH.* H. L. [1865]

The object of the 5 & 6 Will. 4, c. 83, was only to permit a disclaimer to amend the specification of a patent, by removing from it something superfluous, but not to allow the introduction of that which would convert a description, in itself unintelligible or impracticable, into a practicable description of a useful invention.

R. took out a patent for “improvements in embossing and finishing woven fabrics, and in the machinery and apparatus employed therein.”

Lord Chelmsford said: “The word ‘extend,’ in the 5 & 6 Will. 4, c. 83, cannot be used only in its ordinary sense of ‘adding to’ or ‘enlarging,’ because the exact meaning of the term ‘disclaimer,’ to which it is applied, is the renunciation of some previous claim actually or apparently made or supposed to be made. It must therefore be intended to comprehend a case where the disclaimer would give the patentee a right which he could not have enjoyed under the specification as originally formed. Here the specification was conceived in general terms, embracing an infinite variety of modes of indenting upon all descriptions of rollers any desired design. The plaintiff afterwards discovered that no other rollers but those which had circular grooves, flutings or indentations around their surfaces would answer; and he therefore, by his disclaimer, limited his invention to this description of rollers only. . . . By so doing, though in one sense he may be said to narrow a right, yet he really extends it, because he thereby describes his alleged invention sufficiently to enable him now to assert a right under the patent which he never could have successfully maintained upon the original specification alone.” (11 *H. L. Cas.* 223; 75 *L. J. C. P.* 49; 13 *L. T. Rep., N. S.*, 1; 20 *C. B., N. S.*, 28.)

(s) *THOMAS v. WELCH.* [1866]

All the claiming clauses may be struck out of the specification of a patent by a disclaimer if there remain in the body of the specification words sufficiently distinguishing what the invention is which the patentee claims.

An alteration, verbal merely and not substantive, by means of a disclaimer will not make a patent void. (*L. R.*, 1 *C. P.* 192; 12 *Jur., N. S.*, 316; 35 *L. J. C. P.* 200.)

(t) *HEATH and FROST’S PATENT.* [1886]

The patent was for an improved method of blasting, the charge, preferably dynamite, being enclosed in a case surrounded by a water-tight cartridge containing water, and sealed up. The specification said that when the charge was, as dynamite, impervious to water, the inner case could be dispensed with. Application to amend, by confining the invention to cases where the inner case was omitted, refused on the ground that the amended specification

would be substantially different from the original:—*Held*, further, that the unamended specification did not materially differ from an invention previously patented, the owner of which opposed the application. (*Griff.* 310)

(u) LAKE'S PATENT. [1887]

Where there is a doubt whether the proposed amendment contravenes subs. (8) of sect. 18, the amendment ought to be allowed. The fact that the claim itself is not altered is not conclusive that the sub-section is not contravened, because it may be that the words of the claim are large enough to include any mode of production referred to in the specification. (2 *Griff.* 16.)

(v) NORDENFELDT'S PATENT. [1887]

A complete specification which had been filed in the first instance, and claimed the admixture of metallic aluminium or aluminium alloy with the melted iron or steel before casting the same into moulds substantially as described, stated that the iron or steel was melted in crucibles, converters or metal smelting furnaces of any description, and the addition of the aluminium or alloy of aluminium was made to the metal when molten shortly before it was to be poured. "The addition might, however, be made earlier." These last seven words the applicant now desired to omit, and to insert a long explanation of the principle on which the invention was based, to the effect that the melting point, after the mixture of the aluminium, being very much lowered, the metal could be superheated by the mixture without taking up gases, as was the case when the temperature was gradually raised above the melting point; the explanation ended by stating that aluminium had a very effective influence upon iron in this direction, and was not detrimental, and that as soon as the metal was molten a small quantity of aluminium, say from about 0.05 to 0.03 per cent. was added, producing a lowering of the melting point of 300° to 500°:—*Held* by the Attorney-General that the omission of the words should be allowed, but that the explanation could not be inserted; for either the fact that aluminium when inserted lowered the melting point was new, in which case there was a very valuable invention sufficiently claimed, or it was not new, in which case it was not a sufficient reason for inserting the proposed amendment merely to say that some alloys would act better than others. In considering whether an amendment is to be allowed, the fact that a complete specification was filed in the first instance is to be considered as a reason against the application. (2 *Griff.* 18.)

(w) WALKER'S PATENT.

In a patent for improvements in machinery for cotton-spinning, the claim was for the construction and application of an inclined bearer to support the top clearing rollers substantially as set forth. An application to insert the word "adjustable" before "bearer," wherever it occurred, was refused on the ground that it would make the claim substantially larger. (2 *Griff.* 22.)



(j) RYLAND'S PATENT. [1888]

On an application to limit the patent by disclaimer, the opponent alleged that the proposed amendment would make the invention claimed substantially larger, but this was held not to be so. The opponent then relied on the fact that there was no declaration, but Webster, A.G., said: "If on the face of the specification it is quite clear that the specification is capable of two constructions, it is open to the applicant to satisfy the comptroller or law officer on the face of the specification, that he desires to limit the claim to one or more or two or more constructions to which the specification is open." (5 *O. R.* 665, at p. 668.)

(k) SERRELL'S PATENT. [1889]

The invention claimed consisted in reinforcing the actual contact between two contact pieces of an electric circuit by means of a solenoid. The applicant proposed to amend and to state that his invention consisted of an improved electrical contact device, the main purpose of which is to keep the contact pieces clean. Webster, A.G.: "It would be beyond what is intended by the power of amendment under the Act of 1883, that there being a distinct and specific claim to the operation of what is believed to be new, and there being no claim to the minor arrangement of the contact pieces, the patentee should be allowed to strike out the whole of his claim and insert an independent claim to a subordinate part." (6 *O. R.* 101, at p. 103.)

*Terms imposed.*

(x) *In re* HARRISON'S PATENT. [1853]

Sir R. Bethell, S.G., refused to allow a disclaimer to be entered by the assignee of a patentee who had been unsuccessful in an action for infringement against certain defendants, except upon the terms that an undertaking be given not to bring any further action against the same defendants for any alleged infringement prior to the date of the disclaimer. (*Macr. P. C.* 32.)

(u) *In re* MEDLOCK'S PATENT. [1865]

A patent for "improvements in the preparation of red and purple dyes" thus described the process: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or near to, its boiling-point, until it assumes a rich purple colour." It was proved (and not denied by the patentee) that it was *necessary* to apply heat in order to produce the colour, and upon this ground the patent was held void. An application was now made to disclaim the first of these two methods of preparing the dyes, and the application was opposed by manufacturers who had been defendants in previous actions for infringement of the patent. Collier, S.G., granted leave to enter the disclaimer, upon the terms that the applicants should bring no action against the opposers "for any infringement of the said patent by the use or continued use, during the continuance of the said patent, of any

process or processes for manufacturing or preparing red and purple dyes which is or are in use by them or either of them at the present time." The applicants declined to enter a disclaimer on these terms. (*Newton's London Jour., N. S.*, vol. xxii., p. 69.)

(y) HEARSON'S PATENT. [1884]

An action for infringements of a patent for improvements in penholders being nearly ready for trial, the plaintiffs obtained, under sect. 19, from a judge liberty to apply for leave to amend. The judge, not having imposed terms as regarded the pending action, and his order not having been appealed from the law officer, declined to impose any terms relating to the action as a condition for leave to amend. But as regards other actions, the law officers stated that, as a general rule and apart from exceptional circumstances, it was proper that, when desired, a condition should be imposed that no action should be brought, or other proceeding taken, in respect of any infringement prior to the 1st January, 1884. (*Griff.* 309.)

(z) PIETSCHMANN'S PATENT. [1884]

Under sect. 18, subs. 3, the Comptroller-General has the power of imposing such conditions as the law officer on appeal could impose; but the Comptroller-General cannot dismiss an application for amendment with costs, and it follows that he cannot make the payment of costs by the applicant a condition for allowing an amendment. (*Griff.* 314.)

(a) CODD v. BRATBY. [1884]

In 1883 the plaintiff commenced an action for infringement of a patent dated November, 1870, and in July, 1884, moved for liberty to apply to amend under sect. 19. The defendants asked that in addition to other terms a condition should be imposed that the plaintiff should not in any way sue the defendants on the amended specification. The Court said that that would practically be giving the defendants a licence to infringe the plaintiff's machine, and that although there might be cases in which it would be right to impose such a term, it would be going too far to do so in this case. (*Griff.* 56; 1 *O. R.* 209.)

(b) SINGER v. STASSEN & Co. [1884]

The plaintiff having commenced an action before the date at which the Patents Act of 1883 came into operation applied subsequently to that date, under sect. 19, for liberty to apply at the office for leave to amend his specification by way of disclaimer:—*Held* that the section applied, and that the liberty asked ought to be given upon the terms that the costs of and occasioned by the amendment should be defendants' in any event, and that the specification as amended should not be receivable in evidence in the action. (1 *O. R.* 121. Sub nomine, *Singer v. Hasson*, *W. N.* 1884, p. 82; 50 *L. T.* 326.)

(c) WESTINGHOUSE'S PATENT. [1885]

The patent having been declared bad in 1883, and an amendment opposed by the railway companies having been allowed in March, 1885, the law officer imposed terms that no action should be brought against any of the opponents in respect of brakes made and fitted to rolling stock prior to 1st January, 1884, each of the opponents to furnish to Westinghouse a list of such rolling stock, and to keep him informed of any changes in any apparatus fitted except mere renewal of parts. (*Griff.* 315.)

(d) ALLEN *v.* DOULTON. [1887]

The 18th and 19th sections of the Act give a discretion to the Court or judges as to the terms on which in each particular case he will allow a disclaimer, and this discretion is not fettered by authority (4 O. R. 377). The patent being for the use of pipes of novel form, constructed of earthenware to form, as described, a direct connection, the patentee applied to leave out the words "of novel form" in the claim, and to make corresponding amendments on the ground that the form of the pipes was not new at the date of the patent, and he did not intend to claim them. The law officer allowed the amendment, and declined to impose any condition as to the bringing of actions after the amendments for prior infringements, on the ground that in such an action the Court would have to decide whether sect. 20 applied, and the law officer would not substitute his opinion for that of the Court. (2 *Griff.* 3.)

(e) BRAY *v.* GARDNER. [1887]

Where the plaintiff in an action for infringement asks for leave to apply at the Patent Office to amend his specification by way of disclaimer, the Court will, as a general rule, impose the condition that the amended specification shall not be receivable in evidence, though in particular cases less stringent terms may be imposed. (34 *Ch. D.* 668; 3 *T. L. R.* 352.)

(e<sup>1</sup>) HASLAM FOUNDRY & ENGINEERING COMPANY *v.* GOODFELLOW. [1887]

Where plaintiffs asked to be allowed to apply for leave to disclaim after all pleadings had been delivered, the application was granted on terms that the plaintiffs should pay in any event the costs of the application and of the action up to and occasioned by the disclaimer, except only so far as the proceedings in the action might be utilised for the purposes of the amended action; the plaintiffs and defendant to be allowed to make all necessary amendments in their pleadings after disclaimer; the plaintiffs to undertake forthwith to amend their pleadings confining the action to the specifications as amended by the disclaimer, or to consent to the action being dismissed with costs. (37 *Ch. D.* 118; 5 *O. R.* 28.)

(f) *In re* GAULARD & GIBB'S PATENT. [1887]

Where a petition for revocation was pending and was ready for

trial and the patentee asked to be at liberty to apply for leave to amend by disclaimer, liberty was granted on terms that he should apply forthwith and prosecute the application with diligence. The petitioner to have notice of the result, and then fourteen days to decide whether he would amend his particulars of objection or abandon his petition. The respondent to pay all costs up to that date. (5 *O. R.* 189; *W. N.*, 1887, p. 211.)

(g) *FUSEE VESTA COMPANY v. BRYANT & MAY.* [1887]

Plaintiffs in an action for infringement of a patent dated 1885 moved for liberty to apply, under sect. 19, for leave to amend their specification by disclaimer, no statement of claim having been delivered. Liberty was granted on terms that no further proceedings be taken in the action until the disclaimer had been properly made, and if so made, the plaintiffs to pay the defendant's party and party costs up to disclaimer; the plaintiffs to undertake forthwith to take proceedings for disclaimer, and then to amend the action by stating their disclaimer, founding the action simply upon the specification as amended. (34 *Ch. D.* 458; 3 *T. L. R.* 285.)

(h) *GAULARD v. LINDSAY.* [1885]

Pending an action for infringement of several patents, leave was given to the plaintiffs to apply at the Patent Office to amend one of the specifications by way of disclaimer, and to give the amended specification in evidence at the trial on terms of plaintiff paying all the costs of the action up to the time of leave being given, and waiving all claim to recover damages for infringements prior to the amendment. (38 *Ch. D.* 38; 5 *O. R.* 192; 57 *L. J. Ch.* 687.)

(i) *LANG v. WHITECROSS COMPANY.* C. A. [1889]

The Court of Appeal will not fetter the discretion of the judge as to the terms to be imposed on giving leave to disclaim pending an action by laying down any general rule. When the terms were that no claim should be made for an injunction, or for damages, or for any infringement prior to the disclaimer, and that the plaintiff should pay all costs of action up to that time, the appeal was dismissed with costs. (6 *T. L. R.* 16 and 57; 62 *L. T. Rep.* 119.)

(j) *MEYER v. SHERWOOD.* C. A. [1890]

The plaintiff applied after the close of defendants' case for leave to disclaim, and subsequently, having filed a disclaimer, applied for leave to amend his pleadings:—*Held*, that as the defendants did not intend to infringe the amended patent, leave must be refused and the action dismissed with costs. (7 *O. R.* 283.)

### *Operation of.*

(l) *PERRY v. SKINNER.* [1837]

The Act 5 & 6 Will. 4, c. 83, had not a retrospective operation so as to make a party liable for an infringement, prior to the time of entering a disclaimer. (2 *M. & W.* 471; 1 *Web. P. C.* 250. See sect. 39 of 15 & 16 *Vict. c.* 83.) (Questioned in *R. v. Mills*, *infra*.)

## (m) CLARK v. KENRICK. [1843]

The effect of the statute 5 & 6 Will. 4, c. 83, was to render the disclaimer, when made, part of the patent and the specification. The patentee, from the moment of the disclaimer, becomes patentee of the undisclaimed part only. (12 *M. & W.* 221.)

## (n) STOCKER v. WALLER. [1845]

Tindal, C.J.: "The mere fact of a disclaimer being made by a party to whom a grant has been made does not necessarily import that the original patent was void; for the object of the statute was not only to enable inventors to set themselves right when the letters patent, from some cause or other, would have been held to be void, but also to remove doubts and difficulties which would otherwise hang over the heads of parties bringing actions for an infringement, by enabling them to enter a disclaimer of a part of the specification or title of the patent." (9 *Jur.* 138. Reported under name of *Stocker v. Warner*, 1 *C. B.* 148.)

(o) R. v. MILL. *Sci. fac.* [1850]

In an action of *scire facias*, a disclaimer, though enrolled subsequently to issue joined, is admissible as evidence for the defendant, and is to be read as part of the original specification put in by the prosecutor. *Semble*, in actions or suits, not being proceedings by *scire facias*, and which were not pending at the time of the enrolment of a disclaimer, the disclaimer is to be deemed and taken to be a part of the patent or specification from the time of the granting of the letters patent, and not from the time of its enrolment merely. The decision in *Perry v. Skinner* questioned. (10 *C. B.* 379; 20 *L. J. C. P.* 16; 15 *Jur.* 59; 1 *L. M. & P.* 695.)

(p) *In re* LUCAS'S PATENT. [1854]

There are exceptional cases where a disclaimer should be made retrospective, so as to give the patentee power to proceed against those who infringed before the disclaimer was filed, as where a person, having obtained his information from the patentee, presumes upon a defect in his specification, and infringes the valuable part of his patent. (*Macr. P. C.* 235.)

(q) *In re* SMITH'S PATENT. [1855]

Disclaimer allowed, on condition that an undertaking be given that no action shall be brought in respect of anything done prior to the hearing of the application for a disclaimer. (*Macr. P. C.* 232.)

## (r) TETLEY v. EASTON. [1857]

The effect of a disclaimer is merely to strike out from the specification those parts of the machine which are disclaimed; it cannot be read as explanatory of that which remains. (2 *C. B., N. S.*, 706.)

(s) *LISTER v. LEATHER.* [1857]

In a suit pending at the time of enrolment of a disclaimer, a plaintiff cannot avail himself of it by amending his bill; he must file a fresh bill. (3 *Jur.*, *N. S.*, 433.)

(t) *SEED v. HIGGINS.* H. L. [1860]

A patentee claimed by his specification "the application of the principle of centrifugal force to the flyers employed in certain machinery for roving cotton and other fibrous substances," but declared that his improvements "applied solely to such part of the machinery, called the flyers, which is employed in connection with the spindle for the purpose of winding cotton." He attached drawings to his specification, and went on to say that these drawings and the specification represented "one particular and practicable mode of applying" his invention, but "I do not intend to confine myself to this particular method, but I claim as my invention the application of the law or principle of centrifugal force to the particular or special purpose above set forth, that is, to flyers used in machinery for preparing cotton." He afterwards disclaimed "all application of the law or principle of centrifugal force as being part of my invention, or as being comprised in my claim of invention contained in the specification, except only the application of centrifugal force, by means of a weight acting upon a presser so as to cause it to press against a bobbin, as described in the specification":—*Held*, that this disclaimer did not extend the claim, but confined it to a particular mode of applying the principle of centrifugal force, and did not claim the discovery of that principle, or the application of it, except in a particular way, and that, therefore, the patent was good. (4 *Jur.*, *N. S.*, 258; 27 *L. J. Q. B.* 145; affirmed in Exch. Ch. and Dom. Proc., 27 *L. J. Q. B.* 411; 8 *H. L. Cas.* 550; 30 *L. J. Q. B.* 314; 6 *Jur.*, *N. S.*, 1264.)

(v) *CANNINGTON v. NUTTALL.* H. L. [1871]

The plain language of the operative part of a disclaimer is not to be controlled or modified by any introductory sentences with which the patentee may think fit to preface such disclaimer. (*L. R.*, 5 *H. L.* 205.)

Lord Westbury: "The reason for a disclaimer is no part of the disclaimer itself. The *operative part* of the disclaimer begins in this way: 'I, for this reason, wish to disclaim, and do hereby disclaim.'" (*Ib.* 227.)

(w) *In re BERDAN'S PATENT.* M. R. [1875]

Where a disclaimer has been filed without the consent of the patentee, the Master of the Rolls has jurisdiction, without bill filed, to order it to be taken off the file.

Jessel, M.R., in delivering judgment, said: "The question is, whether the Master of the Rolls has jurisdiction to set this right without bill filed, by removing from the record the documents which have been thus filed. There is no authority on the subject. . . . I may observe that *In re Sharp's Patent* (3 *Beav.* 245) has

no direct bearing on this case, as there the application was not to take documents off the file, but to alter an enrolment; and Lord Langdale considered that he had no jurisdiction to do more by a memorandum of alteration than to amend some slips or clerical errors." (*L. R.*, 20 *Eq.* 346.)

(x) *DUDGEON v. THOMSON.* H. L. [1877]

A patentee, having altered his specification by disclaimer, lodged a complaint against certain manufacturers for breach of an interdict granted anterior to the disclaimer:—*Held*, that the patentee ought to have instituted a new action, and that, after the disclaimer, the question of enforcing the old interdict could not be entertained. (*L. R.*, 3 *App. Cas.* 34.)

Lord Blackburn: "The object of a disclaimer is merely to take out and renounce part of what had been claimed before, and it would vitiate the new specification if by striking out that part you gave an extended and larger sense to what is left so as to make it embrace something which it did not embrace before." (*Ib.* 55.)

(y) *In re PULLAN'S PATENT.* L. C. [1878]

The Lord Chancellor, upon an *ex parte* application, corrected a filed specification by adding drawings alleged to have been omitted through inadvertence. The drawings so added were not described in the specification. Some months after the addition was effected, an application was made to the Lord Chancellor by a patentee, who had been threatened with an action for infringing the amended patent, to rehear the original application. The Lord Chancellor decided to hear the matter afresh, and, upon reading the affidavits on both sides, and considering that his order had been made on imperfect information, ordered the added drawings to be struck out of the specification. (Not reported; see *Johnson's Patentees' Manual*, 5th ed., p. 118.)

(z) *THE PLATING COMPANY v. FARQUHARSON.* [1879–1883]

A patentee who disclaims cannot be permitted to play fast and loose with the public. If he alters the terms of a claim originally wide and general by inserting limiting words, he must be bound by the limitation which he has so designedly introduced. He must be presumed to have made the change, because he knew, or at least was apprehensive, that the claim in its original latitude might not be tenable in law; and whether this be really so or not, he has irrevocably relinquished in favour of the public so much of the original claim as was in excess of the limits within which it has been reduced by the disclaimer.

The patentee of an invention for improvements in the electro-deposition of nickel, by disclaimer struck out three of the five claims in the original patent, and inserted in the first claim (which was for this case the only material one left) the words "as above described" after the word "prepared." It appeared that the defendant's solution was, in fact, prepared in a manner sub-

stantially different from the method described in the specification:—*Held*, no infringement. (*Griff.* 187.)

(a) UNITED TELEPHONE COMPANY *v.* LONDON AND GLOBE TELEPHONE COMPANY. [1883]

In an action for infringement of the Blake patent for telephonic transmitters, the defendants admitted the infringement, and said that, although they did not admit the validity of the patent, they were willing to alter their instruments so as no longer to contravene the patent. The plaintiffs were also owners of Edison's patent for transmitters of similar construction, and the defendants relied on the fact that the Attorney-General, in allowing the plaintiffs to disclaim a certain part of the specification in the Edison patent, had done so on condition that no action should be brought against the defendants and others in respect of instruments made or in course of manufacture at that time. The Attorney-General had subsequently made an award that the defendants were exempt from proceedings in respect of the 800 instruments, the subject of this action, which were admittedly infringements of the Edison patent:—*Held*, that the defendants were neither entitled to succeed on the ground that they had not used nor on the ground of the Attorney-General's award, and that they must be restrained by injunction. (32 *W. R.* 870.)

(b) CHEESEBOROUGH'S PATENT. [1884.]

Leave was given to amend subject to the term that no action was to be brought for infringements committed prior to the 1st of January, 1884, and it was held that the continued use of lamps made prior to that date was protected, and that this protection extended to lamps made *bonâ fide* prior to that date, even although unsold. (*Griff.* 303.)

(c) WESTINGHOUSE'S PATENT. [1885]

Where the stock of the opponents, fitted with any apparatus made in alleged accordance with the specification, was protected from the effects of an order allowing leave to disclaim, each opponent was ordered within six weeks to furnish to the patentee at the office of his solicitors a full statement of the locomotives and vehicles which had been fitted with such apparatus, referring to them by distinguishing marks, and setting forth the nature of brake apparatus fitted prior to the date of the order. And each opponent was from time to time during the subsistence of the patent to give immediate notice to the patentee of any change in any apparatus so fitted except mere renewal of parts. The patentee was allowed eight weeks from the date of the order to deposit in the Patent Office an undertaking to accept the amendment upon the conditions imposed. (1 *Griff.* 315.)

(d) WENHAM *v.* CARPENTER. [1887]

Where there had been an amendment by disclaimer the plaintiff, in the absence of proof that the original claim had been prepared in good faith and with reasonable skill and knowledge, withdrew



his claim for damages in respect of anything prior to the disclaimer, and the account was limited to articles which had since the amendment been manufactured or sold or used by or by the order or for the profit of the defendants. (5 O. R. 68.)

(e) ALLEN'S PATENT. [1887]

The law officer will not impose such a condition in allowing a disclaimer as would in effect substitute his opinion for that of the Court as to whether good faith and reasonable skill and knowledge within the meaning of sect. 20 have been used. (2 Griff. 3.)

(f) *Ex parte* SIMON. [1888]

If the Attorney-General allows an amendment which makes the patent substantially larger or substantially different, such amendment is a nullity. (*T. L. Rep.*, IV., 754.)

*Practice.*

(g) *In re* SHARP'S PATENT. [1840]

The Master of the Rolls has no jurisdiction to remove from the records of the Court of Chancery a memorandum of alteration enrolled under the statute. (1 *Web. P. C.* 641; 3 *Beav.* 245; 2 *Carp. P. C.* 461.)

(h) *R. v. MILL. Sci. fac.* [1851]

Pending a proceeding in *scire facias* to repeal a patent, the patentee disclaimed a part. The prosecutor still proceeded, and ultimately failed:—*Held*, that he ought to pay the costs subsequent to the disclaimer. (14 *Beav.* 312.)

(i) WALLINGTON *v.* DALE. [1852]

The filing of the copy of a disclaimer is a compliance with the provisions of 5 & 6 Will. 4, c. 83, s. 1. (7 *Exch.* 888; 23 *L. J. Exch.* 49.)

(j) *In re* MEDLOCK'S PATENT. [1865]

A fiat had been granted by the Solicitor-General in this case to enter a disclaimer, subject to the acceptance by the applicant of certain conditions. The applicant refused to accede to these conditions, and the Solicitor-General filed a disallowance of the disclaimer. An appeal was then made to the Patent Commissioners, in the form of a petition, setting out the facts of the case, and ending with the following prayer:—

“1. That the Solicitor-General, having granted his fiat for the disclaimer, your petitioners submit that such fiat cannot be recalled, and they pray that you will be pleased to file the said disclaimer with the fiat, so that your petitioners, not having consented to the conditions, may be enabled to try the question of their validity.

“2. Or, that the said disclaimer may be referred to one of the law officers mentioned in the statute, with such instruction as to you the Commissioners of Patents may seem fit.

“3. Or, that the Commissioners of Patents require a fuller statement of the case, that your petitioners may be heard by counsel before the Commissioners of Patents.

“4. That the Commissioners of Patents will give to your petitioners such further or other relief as they may see fit.”

This petition was returned by the Lord Chancellor, indorsed “refused.” (*Newton’s London Jour., N. S.*, vol. xxii., p. 70.)

(k) ARNOLD’S PATENT. [1887]

A patentee for improvements in steam boilers made an application to the Comptroller-General to amend his specification, but was refused, and did not appeal. After some months he renewed his application, was again refused, and then appealed to the law officer:—*Held*, that the appeal could not be entertained, the only reason alleged for not appealing from the first decision being ignorance. (2 *Griff.* 5.)

(l) LAKE’S PATENT. [1887]

As a matter of practice, in the absence of very special circumstances, the Comptroller-General should neither give nor receive costs. (2 *Griff.* 16.)

*Amendment of Clerical Errors.*

PATENTS ACT, 1883, sect. 91. The comptroller may, on request in writing accompanied by the prescribed fee:—

- (a) Correct any clerical error in or in connection with an application for a patent; or
- (b) Correct any clerical error in the name style or address of the registered proprietor of a patent.

PATENT RULES, 1890, rule 16. Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure, which in the opinion of the comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the comptroller may think fit.

Rule 59. Every amendment of a specification shall be forthwith advertised by the comptroller in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct.

(m) *Ex parte* BECK. [1784]

A caveat entered against the sealing of a patent which bore date August 12, 1784, was not discharged until August 27th. The patentee, supposing his patent bore date the latter day, did not enrol his specification till December 18th, when the four months allowed for enrolment had expired. The Lord Chancellor said that although satisfied that the patentee was well entitled to his patent, he could not use his power as Keeper of the Great Seal to alter a patent in any degree upon an application of this sort. (1 *Br. C. C.* 578.)

(n) *In re* REDMOND'S PATENT. [1828]

Clerical error by copying clerk in specification transposing reference numbers, amended by the Master of the Rolls. (5 *Russ.* 44; 1 *Web. P. C.* 649, *note.*)

(o) *In re* WHITEHOUSE'S PATENT. [1830]

Word "wire" substituted by mistake for "fire" in original specification: amended five years afterwards by M.R. (1 *Web. P. C.* 649, *note.*)

(p) *In re* RUBERY'S PATENT. [1837]

Recital in specification that patent had been granted in "October" instead of "November" amended. The petition stated that no *scire fac.*, or other proceedings at law, had been instituted. (1 *Web. P. C.* 649, *note.*)

(q) *In re* SHARP'S PATENT. [1840]

Except for the purpose of correcting mere verbal or clerical errors, proved to have arisen from mistake or inadvertence, the Master of the Rolls had no authority to make any alteration in the enrolment of the patent or of the specification.

If an enrolled memorandum of alteration, by mistake of the writer, contained verbal or clerical errors, by means of which something was enrolled contrary to the true intent of the party, the Master of the Rolls had authority to correct the error and make the enrolment accord with the proved intention of the party at the time of enrolment. (1 *Web. P. C.* 645.) For instances in which verbal amendments have been made by the Master of the Rolls, see 1 *Web. P. C.* 647, *note* (l).

(r) *In re* NICKEL'S PATENT. [1841]

In this case "recovering" had been written for "covering." The Chancellor and Master of the Rolls made a joint order for the re-sealing of the letters patent with an alteration of this mistake, on the undertaking of the patentee to abandon and pay the costs of an action then pending, and not to bring any action for infringement before the re-sealing. (*Turner & Phillips*, 36; 1 *Web. P. C.* 650.)

The petitioner not acceding to these terms, relief was refused; and the petitioner was ordered to pay the costs of the party opposing the petition. (*Hindmarch*, p. 218.)

The Master of the Rolls had no authority to amend letters patent; the Lord Chancellor alone could do so. (1 *Web. P. C.* 660.)

The mode of making the alteration followed in a former case explained to be that the Master of the Rolls came into the Lord Chancellor's court, and under the authority of the Lord Chancellor the patent, having been altered, was re-sealed; and then the Master of the Rolls made the enrolment correspond with the patent so altered. (1 *Web. P. C.* 663.)

*(r) In re DISMORE'S PATENT.* [1853]

Name "Charles" instead of "George" inserted in engrossing specification after enrolment. Lord Romilly, M.R., took time to consider, and after some hesitation made an order on the authority of and similar to that in Rubery's case. He required, however, that the signature of the Attorney-General should be obtained, and that the letters patent themselves should be handed in for inspection. (18 *Beav.* 538.)

*(s) In re ADAMS'S PATENT.* [1853]

The engrossment of letters patent bore date two days after the date of the writ of the privy seal, and the patentee, not being aware of the discrepancy, was a day too late in enrolling his patent; ordered that, as the mistake arose from a misprision of the clerk, the enrolment should be amended. (21 *L. T. Rep.* 38.)

*(t) In re BLAMOND'S PATENT.* [1860]

An application for amendment of a patent granted in 1856, by rectifying an error in the spelling of the name of the patentee, was refused on the ground of lapse of time. *Quære*, whether the Court had power to make such an order under 15 & 16 Vict. c. 83, s. 15. (3 *L. T. Rep., N. S.*, 800.)

*(u) In re JOHNSON'S PATENT.* [1877]

The power of the Master of the Rolls as Keeper of the Records to amend a clerical error in a specification was saved by the Judicature Acts, 1873, sect. 17, subs. 6. When such amendment was directed, notice of the order had to be given to the Commissioners of Patents so that the specification might be reprinted. (5 *Ch. D.* 503.)

*(v) MORGAN'S PATENT.* [1886]

Misdescription of one of the drawings amended by the law officer although the patent was ten years old. (2 *Griff.* 17.)

*Amendment of Particulars of Breaches.**(w) JONES v. PRATT.* [1861]

*Semble* the plaintiff might be allowed to amend his particulars of breaches after issue joined in accordance with defendant's answers to interrogatories delivered after that date. (30 *L. J. Exch.* 365.)

*Amendment of Particulars of Objections.*

See under Practice, Particulars of Objections, pp. 305 (s) (t), 306 (v) (w) (x).

*Amendment of Petition for Extension.*

See Extension of Term. Petition, p. 104 (a).

**Amount of Labour in Invention.**(x) CRANE *v.* PRICE. [1842]

If the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or of some sudden and lucky thought, or of mere accidental discovery. (12 *L. J. C. P.* 81.)

**Amount of Invention.** See under Subject Matter.

**Analogous use.** See Subject Matter, Application of known machine, process, or material to analogous purpose, pp. 532 to 540.

**Analysis.**PATENT TYPE FOUNDRY COMPANY *v.* WALTER. [1860]

The Court of Chancery had jurisdiction to order, and did order, the defendant to deliver a sample of type for analysis. (8 *W. R.* 353).

Now by Supreme Court Rules, 1883, Order L., Rule 3, it shall be lawful for the Court or a judge, upon the application of any party to a cause or matter, and upon such terms as may be just for all or any of the purposes aforesaid, to authorise any samples to be taken, or any observation to be made or experiment to be tried which may be necessary or expedient for the purpose of obtaining full information or evidence.

**Annual Fees.**

In lieu of the fees of £50 and £100 payable on certificates of renewal annual fees may be paid. See under Fees, p. 143.

**Annual Report.**

PATENTS ACT, 1883, sect. 102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

**Anticipation.** See Novelty, p. 220.

**Appeal,**

hearing evidence on, pp. 381 (b) (d) (e) (f), 382 (g<sup>1</sup>)  
 injunction pending, p. 381 (c)  
 account stayed pending, p. 371 (w) (y),  
 delivery of infringing machines pending, p. 381 (a).

*From comptroller—*

when he refuses to accept application, p. 32  
 requires amendment, p. 32  
 decides in case of opposition, p. 32  
 refuses leave to amend, p. 32

rules relating to, p. 380

decision allowing patent not reversed unless case is clear, p. 32 (y) (a).

*Appeal from Comptroller.*

PATENTS ACT, 1883, sect. 7 (2), amended by 51 & 52 Vict. c. 50, sect. 2.

(2.) Where the comptroller *refuses to accept an application* or requires an amendment, the applicant may appeal from his decision to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

[The words of the section are set out in full at p. 34.]

Sect. 9 (2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

[The words of the section are set out in full at p. 35.]

Sect. 11 (2.) (When notice of opposition is given the comptroller shall) . . . decide on the case, but subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and any person so giving notice, and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.

[The words of the section are set out in full at p. 38.]

Sect. 12 (3.) (a.) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

Sect. 18 (6.) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

[For the remainder of the section, see p. 10.]

(y) GLOSSOP'S APPLICATION. [1884]

Where the matter is in doubt, and where the Comptroller-General has allowed the patent, the law officer ought not to disallow the patent and reverse his decision unless the case is a perfectly clear one. (*Griff.* 285.)

(a) PITT'S APPLICATION. [1888]

Where the nature of the case was such that the law officer would have required expert assistance, he declined to reverse the decision of the Comptroller-General, who in his turn had, of course, been advised by those whose duty it was to express an opinion, and dismissed the appeal with costs. (5 *O. R.* 343.)

**Applications** of known machines, processes or materials. See under Subject Matter, p. 522 (*seq.*).

**Application for and Grant of Patents.**

PATENTS ACT, 1883, sects. 4 to 9, amended by 48 & 49 Vict. c. 63, and 51 & 52 Vict. c. 50, pp. 34, 35, 36.

PATENT RULES, 1890, Rules 6, 8 to 14, and 18 to 23, pp. 36, 37.

*Applications generally—*

Patent Office cannot inquire whether claim goes beyond invention described, p. 37 (b)

nor as to the form of the title if it does not infringe the Act, p. 37 (c)

but may strike out what is misleading, p. 38 (e)

or disallow complete specification if borrowed from other specifications, p. 38 (d).

*Application—Opposition.*

PATENTS ACT, 1883, sect. 11, Rules 34 to 44, pp. 38, 39.

*Opposition generally—*

prior user is no longer a bar to the grant, p. 40

cases before the Act of 1883, pp. 40, 41, 42

service on opponent, p. 40 (k)

where grounds of opposition are doubtful, it is proper to grant patent, pp. 40 (l) (m), 41 (s)

delay in opposing, p. 41 (n) (o)

who may oppose, p. 42 (v) (w)

amendment of notice of objections, p. 42 (x) (y).

*Opposition on ground that invention was obtained from opponent—*

cases before the Act of 1883, p. 43

joint inventors, pp. 43 (c), 44 (d) (e), 45 (f) (f<sup>1</sup>)

applications granted with reference to opponent's patent, pp. 44 (c), 46 (k<sup>1</sup>)

words "obtained from opponent" do not include communications from abroad, pp. 43 (e), 46 (i) (k).

*Opposition on ground that invention has been patented in this country—*

cases before the Act of 1883, p. 47

*Who may oppose, pp. 48, 49*

persons interested in prior patent, even though it has expired, may, p. 48 (u) (v) (w)

not those who merely manufacture under it, p. 49 (d) (e)

nor those who have only obtained provisional protection, p. 48 (x) (z)

nor foreign patentees whose patent has been antedated under sect. 103, p. 48 (b).

*Insertion of disclaiming clauses—*

is meant to protect the public and not prior patentees, pp. 50 (l), 51 (p)

prior patentee has no right to be named, pp. 50 (j) (m), 51 (q)

a reference to a prior patent is to be deprecated, p. 50 (j)

form of disclaimer, pp. 50 (i), 51 (n) (r) (s)

opponent may appeal merely to get disclaimer inserted, p. 51 (t).

*Prior invention not the same—*

opposition will not succeed where prior patent is not the same, p. 52

nor when the applicant's invention has been described but not claimed, p. 52 (z).

*Concurrent applicants—*

formerly the first who obtained the seal succeeded, p. 54

might obtain a joint patent, p. 54 (i)

might each obtain provisional protection for same invention, p. 55 (k)

and sometimes separate patents also, p. 55 (l) (m), 56 (p).

*Costs—*

when opposition not unreasonable, p. 56 (r)

successful, p. 57 (u) (x)

*Costs (continued).*

when opposition not unsuccessful, pp. 56 (*s*), 57 (*t*) (*y*)  
 when withdrawn, pp. 57 (*u*<sup>1</sup>) (*w*), 58 (*e*)  
 how taxed, p. 57 (*t*)  
 of appeal to law officer will usually follow the event, p. 58 (*z*).

*Delay—*

in enrolling specification, p. 58 (*f*)  
 in entering opposition, pp. 41 (*o*), 59 (*m*)  
 in filing affidavits in opposition, 57 (*v*).

*Procedure—*

specification cannot be dispensed with, p. 60 (*p*)  
 or received conditionally, p. 60 (*q*)  
 application by opponent for inspection refused, p. 60 (*s*)  
 notice to applicant of appeal to law officer, p. 61 (*v*).

*International and Colonial arrangements—*

PATENTS ACTS, 1883, sects. 103, 104, and 1885, sect. 6, p. 61.  
 Orders in Council, p. 62  
 Rules 24 to 29, pp. 62, 63  
 application must be in name of original foreign patentee, p. 64 (*y*).

PATENTS ACT, 1883, sect. 4. (1.) Any person, whether a British subject or not, may make an application for a patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

[See sect. 5 of Act of 1885, *inf.*, p. 36.]

5. (1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

[See sect. 2 of Act of 1885, *inf.*, p. 36.]

(3.) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required.

(4.) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

[See sect. 2 of Act of 1886, p. 84.]

(5.) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject matter of the invention.

7. (1.) (Amended by 51 & 52 Vict. c. 50, sect. 2). For section 7 of the principal Act the following section shall be substituted, namely: If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller *may refuse to accept the application*, or require that the application, specification, or



drawings be amended before he proceeds with the application; *and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.*

(2.) Where the comptroller *refuses to accept an application* or requires an amendment, the applicant may appeal from his decision to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions [if any], the application shall be accepted.

(4.) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

(5.) If, after an application for a patent has been made, but before *the patent thereon* has been sealed, *another application for a patent* is made, accompanied by a specification bearing the same or a similar title, *the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.*

8. (Amended by 48 & 49 Vict. c. 63, sect. 3.) (1.) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application, [*or within such extended time, not exceeding one month, as the comptroller may on payment of the prescribed fee allow*].

(2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

9. (Amended by 48 & 49 Vict. c. 63, sect. 3.) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

(2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

(4.) Unless a complete specification is accepted within twelve months (*or within such extended time not exceeding three months as the comptroller may on payment of the prescribed fee allow*) from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months [*or of such extended time*], become void.

(5.) (Amended by 51 & 52 Vict. c. 50, sect. 3.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

48 & 49 Vict. c. 63, sect. 2. Whereas sub-sect. 2 of sect. 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts; be it therefore enacted that: The declaration mentioned in sub-sect. 2 of sect. 5 of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

Sect. 3. Whereas under the principal Act, a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required by section twelve to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in certain cases the said times: Be it therefore enacted as follows:

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

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PATENT RULES, 1890. 6. (1.) An application for a patent containing the declaration mentioned in sub-sect. 2 of sect. 5 of the Act of 1883, and sect. 2 of the Act of 1885 shall be made either in the Form A or the Form A 1 or the Form A 2 set forth in the Second Schedule to these rules, as the case may be.

(2.) The Form B in such Schedule of provisional specification and the Form C of complete specification shall respectively be used.

(3.) The remaining forms other than A, A 1, A 2, B and C set forth in the Second Schedule to these Rules may, as far as they are applicable, be used in any proceedings under these rules.

8. An application for a patent must be signed by the applicant, but all other communications between the applicant and the comptroller and all attendances by the applicant upon the comptroller may be made by or through an agent duly authorised to the satisfaction of the comptroller, and if he so require resident in the United Kingdom.

9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the comptroller. He may in any particular case require that the address mentioned in this rule be in the United Kingdom.

10. All documents and copies of documents, except statutory declarations and affidavits, sent to or left at the Patent Office or otherwise furnished to the comptroller or to the Board of Trade shall be written or printed in large and legible characters, and, unless otherwise directed, in the English language upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of 2 inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the comptroller.

11. Before exercising any discretionary power given to the comptroller by the said Acts adversely to the applicant for a patent or for amendment of a specification, the comptroller shall give ten days' notice, or such longer

notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the comptroller may appoint in such notice, the applicant shall notify in writing to the comptroller whether or not he intends to be heard upon the matter.

13. Whether the applicant desires to be heard or not, the comptroller may at any time require him to submit a statement in writing within a time to be notified by the comptroller, or to attend before him and make oral explanations with respect to such matters as the comptroller may require.

14. The decision or determination of the comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby.

18. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

Applications left at the Patent Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Patent Office.

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

Every such application shall, if the applicant notify his desire to that effect to the comptroller, bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Act and by these Rules, as if every such application had been originally made on that date.

20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the comptroller may require.

21. On the acceptance of a provisional or complete specification the comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

22. Upon the publication of such advertisement of acceptance in the case of an application with a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee.

23. An application for a patent for an invention communicated from abroad shall be made in the Form A 1 set forth in the Second Schedule to these Rules.

### *Application generally.*

#### (b) SMITH'S PATENT. [1884]

If at the end of a specification there is a real statement of the invention claimed it is not competent to the Patent Office to inquire whether the statement goes beyond or is in conformity with the description in the specification of the invention. (*Griff.* 268.)

#### (c) BROWN'S PATENT. [1887]

The title being for "improvements in casks and tubs," the specification described the invention as applicable to tubs and

analogous vessels in which the staves were formed with a groove for receiving the head :—*Held*, that the title was sufficient without the words “and analogous vessels.”

The patentee is entitled to frame his title in his own way provided he does not infringe the rules of the statute. (2 *Griff.* 1.)

(d) EVERITT'S APPLICATION. [1888]

The provisional specification only described a general principle of obtaining automatically a given quantity of liquid in exchange for a coin; the complete specification described special mechanism for effecting it. The law officer allowed the patent, but stated that if it were shewn in any case that the applicant had made use of other persons' specifications in drawing up his complete specification, the complete specification would not be allowed. (2 *Griff.* 27.)

(e) ATHERTON'S APPLICATION. [1889]

The claims in a patent are inserted at the risk of the patentee, because he jeopardises his patent by inserting too much; but where the sixth claim was practically identical with the third, the law officer struck it out as unnecessary and misleading. An applicant may insert what he believes to be a statement of prior knowledge, but he must not give therein his own version of what processes have been described in former patents. If he wishes to refer to such patents in connection with his statement of prior knowledge, he should put the statement in this form: “Processes for..... heretofore in use and to which I make no claim are..... Illustrations of such processes are to be found in the specifications of.....” (6 *O. R.* 547.)

(f) C.'S APPLICATION. [1890]

The report of the examiner is not to fetter the judgment of the comptroller, but to assist him, and if the comptroller sees, apart from the report, that the specification is on its face insufficient, he may require an amendment. (7 *O. R.* 250.)

#### *Application—Opposition.*

PATENTS ACT, 1883, sect. 11. (1) (Amended by 51 & 52 Vict. c. 50, sect. 4). Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground.

(2) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3) The law officer shall, if required, hear the applicant and any person

so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.

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PATENT RULES, 1890. 34. A notice of opposition to the grant of a patent shall be on Form D, and shall state the ground or grounds on which the person giving such notice (hereinafter in Rules 37, 38, 41, and 43 called the opponent) intends to oppose the grant, and shall be signed by him. Such notice shall state his address for service in the United Kingdom.

35. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant.

36. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the number, and date of such prior application shall be specified in the notice.

37. Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

38. Within fourteen days from the delivery of such list the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent a list thereof, and within fourteen days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

39. No further evidence shall be left on either side except by leave of the comptroller upon the written consent of the parties duly notified to him, or by special leave of the comptroller on application in writing made to him for that purpose.

40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

41. On completion of the evidence, or at such other time as he may see fit, the comptroller shall appoint a time for the hearing of the case, and shall give the parties ten days' notice at the least of such appointment. If the applicant or opponent desires to be heard, he must forthwith send the comptroller an application on Form E. The comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard, the comptroller shall decide the case and notify his decision to the parties.

42. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the number and date of such prior application shall have been duly specified in the notice of opposition.

43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

44. The decision of the comptroller, after hearing any party who applies under Rule 41, shall be notified by him to the parties.

The following cases relate to prior public user, which was formerly a bar to the grant of letters patent for an invention, but appears to be no longer so under the Act of 1883.

*In re* SAMUDA ; *In re* GRIFFITHS. [1846] (Cited *Hindmarch*, p. 534.)

*In re* TOLHAUSEN'S PATENT. [1866] (14 *W. R.* 551.)

*In re* VINCENT'S PATENT. [1867] (*L. R.*, 2 *Ch.* 341.)

*Ex parte* HENRY. [1872] (*L. R.*, 8 *Ch.* 167.)

(g) *Ex parte* HENSON, *In re* ALCOCK'S PATENT. [1832]

It was a matter of discretion with the Lord Chancellor whether he would allow a person to oppose the sealing of letters patent before him, when he had not already done so before the law officer. (1 *Web. P. C.* 432.)

(h) *In re* CUTLER. [1839]

*Semble*, the sealing of a patent will not be stopped merely on the ground of the alleged want of utility. Because 1st. the question cannot be successfully determined, and 2nd. if useless, the patent, when granted, would be of no value. (1 *Web. P. C.* 426.)

(i) *R. v.* CUTLER. [1847]

The effect of a *caveat*, lodged at the chambers of the Attorney-General, was merely to entitle the party lodging it to notice. (3 *C. & K.* 215.)

(j) *In re* FAWCETT'S PATENT. [1852]

Where a *caveat* was lodged before the great seal was affixed to a patent, the Lord Chancellor declined to enter into the merits of the opposition, but referred the matter back to the Attorney-General. (2 *De G., M. & G.* 439.)

(k) *In re* CAMPBELL'S PATENT. [1853]

Service of a petition for sealing a patent upon the solicitor of an opposing party, who was out of the jurisdiction, granted. (22 *L. T. Rep.* 93.)

(l) *In re* RUSSELL'S PATENT. [1857]

In general, where there is a doubt as to the validity of the grounds of opposition to a patent, the proper course is to grant the letters patent, as an error in refusing them would be irremediable, while one in granting them would not. (2 *De G. & J.* 130.)

(m) *In re* SPENCE'S PATENT. [1859]

Unless a patent is clearly bad, the Lord Chancellor will not refuse to seal it, as the effect of such refusal, if erroneous, would be irremediable, whereas the sealing a bad patent leaves every one at liberty to dispute it. (3 *De G. & J.* 523.)

(n) *In re* MCKEAN'S PATENT. [1859]

Where a petition to have the great seal affixed had been filed and the respondents served with notice two months before the first day of Michaelmas term, for which day the petition was answered, and the respondents only filed affidavits on the morning of that day:—*Held*, that they could not be read; and the patent was ordered to be sealed. (1 *De G., F. & J.* 2; 8 *W.R.* 1; 1 *L. T., N. S.*, 19.)

(o) *In re* BRENNAND'S PATENT. [1861]

Leave was given to oppose the granting of letters patent, notwithstanding the time for entering an opposition had expired, the reason for the delay in entering such opposition being accounted for, and the matter was referred back to the Attorney-General. (7 *Jur., N. S.*, 690; 4 *L. T. Rep., N. S.*, 456.)

(p) *In re* HEATHORN'S PATENT. [1864]

Since the passing of 15 & 16 Vict. c. 83, the practice of entering caveats is discontinued unless special leave is obtained, and, therefore, the Lord Chancellor sealed a patent, notwithstanding a caveat was standing against it, no leave having been obtained. (10 *Jur., N. S.*, 810; 10 *L. T. Rep., N. S.*, 802.)

(q) *In re* MITCHELL'S PATENT; *In re* BROTHERTON'S PATENT. [1867]

A party who has not opposed the sealing of a patent before the law officer of the Crown under 15 & 16 Vict. c. 83, sect. 12, was not allowed to oppose before the Lord Chancellor. (*L. R.*, 2 *Ch.* 343.)

(r) *In re* VINCENT'S PATENT. [1867]

A person might give notice of objection, and oppose the sealing of a patent before the Lord Chancellor without previously applying to the Court for leave to enter opposition. The Lord Chancellor, on an application for sealing a patent, would not interfere with the decision of the law officer of the Crown, unless in case of fraud or surprise, or of some material fact having come to the knowledge of the party since the case was before the law officer. (*L. R.*, 2 *Ch.* 341; 15 *W. R.* 524.)

(s) *Ex parte* SHEFFIELD. [1872]

In opposing the grant of letters patent, the burden is on the opponent to shew that the grant would be clearly wrong. Where the facts on which the opponent relies were within his knowledge when he opposed before the law officer, he could not, when before the Lord Chancellor, raise a new legal argument on these facts; nor could he then bring forward evidence which he might have brought before the law officer. (*L. R.*, 8 *Ch.* 237; 42 *L. J. Ch.* 356.)

(t) *In re* GETHING. [1874]

Where rival applicants had applied on the same day for patents, and had afterwards mutually agreed to withdraw opposition,

letters patent bearing date the day of application were granted to one applicant, although letters patent bearing that date had already been granted to the other. (*L. R.*, 9 *Ch.* 633.)

(*u*) *In re* JOHNSON'S PATENT. [1878] }  
*In re* SOMERSET AND WALKER'S PATENT. [1879] }

The word *caveat* in 15 & 16 Vict. c. 83, sect. 20, meant anything in the nature of opposition at any stage:—*Held*, accordingly, that where opposition had been entered, the Lord Chancellor had power to extend the time for filing the final specification beyond one month after the term of provisional protection. (13 *Ch. D.* 397.)

(*v*) HEATH AND FROST'S PATENT. [1886]

Patent for improvements in blasting cartridges opposed by Hardingham on the ground that the invention had been previously patented by McNab. Hardingham's only interest was as patent agent of McNab. The law officer held that Hardingham could not be heard, as by sect. 11 of the Patents Act, 1883, the only class entitled to be heard in opposition before the law officer are persons who are interested with a legitimate and real interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it. (*Griff.* 288.)

(*w*) SPIEL'S APPLICATION. [1888]

The opponents were the assignees of patents taken out by Johannes Spiel and of all improvements thereon, and they alleged that the present applicant, Adolf Spiel, was put forward by his brother Johannes in order to prevent them (the opponents) from getting the benefit under the assignment of the proposed patent for improvements:—*Held*, by the Comptroller-General, that he had no jurisdiction to enter into the circumstances under which the applicant became possessed of the invention. On appeal Clarke, S.G., held that even if the opponents proved the fraud they were not the legal representatives of Johannes Spiel and therefore could not oppose. (5 *O. R.* 281.)

(*x*) AIREY'S APPLICATION. [1888]

The notice of opposition in this case contained the number and date of the patent as required by the Act, but not the title also as required by the rules. The Comptroller-General allowed the opponent to amend, and said that he had no power to impose terms. (5 *O. R.* 348.)

(*y*) DANIEL'S APPLICATION. [1888]

Opposition successful. Under sect. 7 (6) of the Act of 1883 and rules 11, 12, 13 & 15 of the Rules of 1883, the Comptroller-General has power to hear and determine whether the applicant's invention and the prior patent are the same irrespective of any



opposition, and therefore it is not *ultra vires* for him to allow the opponent to amend his notice of objections. (5 O. R. 413.)

*Opposition on the ground that the Invention was obtained from the opponent.*

(z) *In re Fox.* [1812]

The owners of a patent opposed the grant of a patent for improvements therein, on the ground that the alleged invention was borrowed from their patent. The resemblance of the two inventions was denied. The Lord Chancellor sealed the patent. (1 *Web. P. C.* 431; 1 *V. & B.* 67.)

(a) *Ex parte HENSON, in re ALCOCK'S PATENT.* [1832]

On affidavit that an invention, for which letters patent were about to be sealed, is the invention of the deponent, and had been obtained by a breach of confidence, the Lord Chancellor allowed an opposition at the great seal, though the opponent had not opposed the grant before the law officer. The Lord Chancellor holding that the parties under the circumstances ought to be heard, but that such right ought to be exercised exceedingly sparingly, he referred the matter to the Attorney-General. (1 *Web. P. C.* 432.)

(b) *LOTT'S APPLICATION.* [1853]

This application was refused by the Lord Chancellor on the ground that Lott had obtained the main idea of the invention from Hadden, who had previously lodged a provisional specification. (*John*, 168.)

(c) *In re RUSSELL'S PATENT.* [1857]

Where it appeared that a master and his foreman had both invented certain improvements, for which the master sought letters patent:—*Held*, that they ought only to be granted on the terms of their being vested in trustees for the master and the foreman. (2 *De G. & J.* 130.)

(d) {*HEALEY'S APPLICATION.*} [1872]  
{*CONNIFF'S APPLICATION.*}

Coleridge, S.G., granted a warrant to servants for inventions the results of experiments paid for by their employers, the opponents, on condition that the provisional specifications should be submitted to the opponents, and the portions objected to struck out. (*John*, 165.)

(e) *ABEL'S APPLICATION.* [1876]

The law officer will not look at the circumstances under which an importer of an invention has obtained it abroad. (*John*, 169.)

(f) *MACFARLANE'S APPLICATION.* [1883]

The company of which Macfarlane was manager successfully

opposed on the ground that the invention was obtained from their engineer and chemist. (*John*, 168.)

(c) **HOSKINS'S PATENT.** [1884]

Patent for improvements in folding cots and hammock frames opposed by Needham on the ground that the applicant had obtained the invention from him and that he had previously patented it. A firm with which Needham was negotiating as to a licence had sent a specimen cot with some alterations from Needham's specification to a firm of which Hoskins was a member, for the purpose of ascertaining a price. Hoskins sent back a manufactured sample which was returned to him for alterations and again returned by him. Shortly afterwards Hoskins applied for this patent which Needham alleged was substantially for the same invention as his.

Herschell, S.G. : " I do not think that this patent can be allowed to go except as an improvement on the opponent's. It is impossible to shut one's eyes to the fact that this improved cot which Hoskins seeks to patent never would have been seen or heard of had not Hoskins had before him Needham's cot. . . . The parts differ and the mode of carrying out the idea differs, but there is not a single idea to be found in the one that is not to be found in the other arrangement modified. . . . Can I allow, not as being an improvement or modification of the prior patent, but as an independent patent which the person taking it out is entitled to work independently, this apparatus or cot? I am satisfied that I cannot. I am satisfied, moreover, that I should be doing a very cruel kindness to Hoskins were I to allow him a patent on his present specification, because I am satisfied there is neither any judge nor any jury who would not hold he was infringing Needham's patent, and therefore I should not be giving him any advantage. . . . No doubt the applicant did apply a considerable amount of original thought, and I am quite prepared to believe invention, in improving the opponent's and making a better cot, . . . and so far, as he has made it better, he is entitled to a patent for the improvement. . . . I allow the grant on condition that Hoskins inserts in his complete specification a statement that his invention is an improvement upon Needham's." (*Griff.* 291.)

(d) **EADIE'S PATENT.** [1885]

Application for patent for improvements in travellers opposed : (1) by Bourcart on the ground that a material part of the invention had been obtained from him ; (2) by Clark on the ground that he had already patented a material part on communication from Bourcart. The Comptroller-General was of opinion that the applicant's specification was based upon the idea of a traveller with a straight part first communicated to them by Bourcart, and sealed a patent to Messrs. Eadie and Bourcart as joint inventors. (*Griff.* 279.)

(e) **EVANS AND OTWAY'S PATENT.** [1885]

The evidence being conflicting, the Deputy Comptroller having

no power to take evidence *vivâ voce* sealed a patent without prejudice to the opponent on appeal. It appeared that Evans and the opponent Cutting had been jointly experimenting upon the invention, and Cutting had obtained a patent for the invention without opposition from Evans. The law officer decided that Evans should have a patent on each of the two assigning one half of his patent to the other; but on its appearing that Otway could not be found to agree to this, the order was cancelled, and instead it was ordered that the application should be refused on the terms that Cutting should assign one half of his patent to Evans, the parties thereafter to share in paying the fees, or in default, either party to be at liberty to pay and to retain the patent as security for repayment of his share. (*Griff.* 279.)

(f) GARTHWAITE'S PATENT. [1886]

Patent for fish biscuits for dogs held to be the joint invention of the applicant and King the opponent. King applied for a patent for an invention which appeared to the examiner to be the same, but the applicants thinking them different, asked the comptroller to issue a patent on Garthwaite's application to them jointly, and to grant King a patent, striking out all matter covered by Garthwaite's specification. The Comptroller-General refused to do this, but granted separate patents on each assigning one half to the other and agreeing to pay half the fees. (*Griff.* 284.)

(f<sup>1</sup>) LUKE'S PATENT. [1886]

It appeared that part of the merit of the applicant's invention for improvements in machines for slubbing, roving, &c., fibrous materials was due to the opponent. The law officer, following the precedent set in Russell's patent (p. 43 (c)), ordered the grant on condition that the parties should agree, the patentee to secure to the opponent the rights of a joint patentee, the opponent to undertake to take no proceedings for revocation of the patent. If the applicant refused to agree, the application was to be dismissed with costs; if the opponent refused to agree, the grant was to be allowed unconditionally with costs. (*Griff.* 294.)

(g) PATERSON'S PATENT. } [1886]  
DUNDON'S PATENT.

In 1884 Paterson applied for a patent for improved apparatus for expanding the ends of casks and firkins, leaving a provisional specification in which was described a firkin expander, consisting of segments not overlapping. On June 5, 1885, Dundon applied for a patent, leaving a provisional specification which shewed a firkin expander, consisting of a hoop with the ends overlapping. On July 29, 1885, Paterson filed his complete specification and therein included Dundon's overlapping band. Each one opposed the other's patent on the ground that it had been obtained from him. Dundon's application was granted, and Paterson was required to amend by confining his complete specification to the segmental apparatus. (*Griff.* 295.)

(h) DAVID AND WOODLEY. [1886]

Davey, S.G.: "If a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine, which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them." (2 *Griff.* 26.)

(i) EDMUND'S PATENT. [1886]

Query, whether the words "legal representative" in sect. 11 of the Patents Act, 1883, include a person holding a power of attorney.

The words "on the ground of the applicant having obtained the invention from him," in this section are intended to apply to communications between persons in the United Kingdom and Isle of Man, and not to communications from abroad. The person importing an invention into the realm is the true and first inventor, and for the purposes of the application it matters not under what circumstances he has obtained the invention abroad, and this is not altered by the Act of 1883. The importer may be liable to the person from whom he has obtained the invention abroad in respect of the breach of some contract or duty, but those are matters which the law officer and the Comptroller-General cannot inquire into. (*Griff.* 281.)

(j) FIECHTER'S APPLICATION (referred to in Edmund's patent).

Application for a patent for improvements in dust-collecting apparatus. A communication from Kirk and Fender of America refused on the ground that Fiechter never had authority from Kirk and Fender to apply for a patent, he having offered to become their agent in England and been refused. (*Griff.* 284.)

(k) LAKE'S APPLICATION (Edmund's patent followed). [1888]  
(5 *O. R.* 415.)

(k<sup>1</sup>) NEWMAN'S APPLICATION (2). [1888]

The remarks of Lord Herschell in Hoskins' patent (p. 44 (c)) approved by Webster, A.G. It is not to the interest of the patentee or of the public that the description of an invention should be general when it can only be supported as a description of an improvement. (5 *O. R.* 279.)

(l) MARSHALL'S APPLICATION. [1888]

The invention was admittedly obtained from the opponent, but the applicant alleged that the opponent went with him to a patent agent and instructed him to make the application, and suggested that it should be in the name of the applicant only. The application was refused. (5 *O. R.* 661.)

(m) HOMAN'S APPLICATION. [1888]

The applicant, who had previously obtained a patent for

improvements in fire-proof floors, now applied for a further patent for improvements in fire-proof floors in which bricks of a particular construction were to be used, and were separately claimed as new. The opponent, who had formerly been employed by the applicant in making samples of bricks for experimental purposes, had already registered as a design the same form of brick:—*Held*, by the law officer that the applicant was the person entitled to claim originality in the matter, and was entitled to a patent without amendment and without joining the opponent. (6 O. R. 104.)

(n) GRIFFIN'S APPLICATION. [1889]

The application was refused on the ground that the invention had been obtained from the opponent. (6 O. R. 296.)

(o) DIETZ'S PATENT. [1889]

The patent was allowed, and the opponent not appearing, his appeal was dismissed with costs. (6 O. R. 297.)

*Application—Opposition on the ground that the Invention has been patented in this country.*

(p) *In re* STOLL'S PATENT. [1853]

An application for the sealing of a patent which, with the consent of the petitioner and the opposing party, the Lord Chancellor had referred to the Assistant Commissioner in the Patent Office for his opinion as to whether there was an infringement of a patent already granted, was, upon that officer's opinion being unfavourable to the petitioner, refused. (21 L. T. Rep. 233.)

(q) *In re* TOLSON'S PATENT. [1856]

Letters patent sealed in a case where the evidence showed great similarity between the alleged invention and one for which a patent was already in force. (6 De G., M. & G. 422.)

(r) *Ex parte* YATES. [1869]

The patent was refused on the ground that the invention was a colourable imitation of one which was the subject of an existing patent. (L. R., 5 Ch. 1.)

s) *In re* MANCEAUX'S PATENT. [1870]

Letters patent will not be sealed where a prior patent has been granted for the same invention, and there is no fraud, although the validity of the first patent is disputed. (L. R., 6 Ch. 272; 18 W. R. 1184.)

(t) *In re* SCOTT AND YOUNG'S PATENT. [1871]

Whether an objection to the sealing of a patent, on the ground of a prior patent having been granted, can be made where no complete specification of the prior patent has been filed, *quære*. (18 W. R. 425.)

*Who may oppose.*

## (u) GLOSSOP'S PATENT. [1884]

A manufacturer who has purchased a prior patent which is alleged to be an anticipation, and has been working under it, has a right to be heard in opposition although his patent has become public property. *Quære*, whether one of the public is entitled to be heard. (*Griffin*, 285.)

## (v) LANCASTER'S PATENT. [1884]

Opposition may be grounded on a patent which has expired. (*Griff.* 293.)

## (w) HOOKHAM'S APPLICATION. [1886]

Glossop's case approved. A person who merely comes forward as one of the public will not be allowed to strike out a paragraph of a specification on the ground of a prior patent. (2 *Griff.* 32.)

## (x) DUNDON'S PATENT. [1886]

*Quære* whether an applicant, whose patent has not been sealed, has a *locus standi* to oppose. (*Griff.* 278.)

## (y) GREEN'S PATENT. [1886]

The parts in the applicant's specification which were objected to by the opponents were included in the opponent's complete, but it was alleged not in their provisional specification:—*Held*, that this variance, if proved, would not prevent the opposition from being successful. (*Griff.* 286.)

## (z) BAILEY'S PATENT. [1886]

The words "patented in this country," in sect. 11 (1) of Patents Act, 1883, do not include inventions which have only received provisional protection, and consequently the existence of such inventions is not a ground of opposition. (*Griff.* 269.)

## (a) L'OISEAU AND PIERARD'S APPLICATION. [1887]

A patentee who has lodged a provisional specification and has left a complete specification which has been accepted is entitled to oppose, although no patent has been granted, by virtue of sect. 15 of the Patents Act, 1883. (2 *Griff.* 36.)

## (b) EVERITT'S APPLICATION. [1888]

A foreign patentee who is entitled to have his patent antedated under sect. 103 of the Patents Act, 1883, so as to be prior in date to an application, is not entitled to oppose the application on the ground that the invention had been patented by him on an application of prior date. (2 *Griff.* 28.)

## (c) HALL AND HALL'S APPLICATION. [1888]

Patent opposed on the ground (amongst others) that an invention which was patented by the opponent in 1871 would come within

the general terms of the fourth claim :—*Held*, that this was so, and that the fact that the patent of 1871 had expired was rather a reason for mentioning it than for not mentioning it in the specification. (5 O. R. 283.)

(d) *MACEVY'S APPLICATION*. [1888]

A person who has no interest in prior patents, except that he has manufactured under one of them, is not entitled to oppose on the ground of the invention being comprised in such prior patents. (5 O. R. 285.)

(e) *BAIRSTOW'S APPLICATION*. [1888]

The Comptroller-General, under sect. 11 of the Patents Act, 1883, cannot inquire into the means by which the applicant has obtained an invention abroad. A person who is going to work the invention contained in prior patents is not entitled to oppose on the ground of such patents existing. (5 O. R. 286.)

(f) *WEBSTER'S APPLICATION*. [1888]

The inventions claimed were: (1) In the manufacture of wire ropes the improvements consisting in making all the strands compound, i.e. each strand having some of its wires laid in one direction and the rest in the other. (2) The laying up into a rope compound strands either (a) all having thin external wires in the same direction as the lay of the rope, (b) all except one, or (c) with the direction of the external wires to the right and left hand alternately :—*Held*, that if the compound strand was new, it was amply protected by the first claim, and that if it was not new, the specification did not purport to disclose any invention in the mode of laying up an old strand, and that therefore the second claim was not required and must be struck out.

Webster, A.G.: "Where a patentee, upon the face of both the provisional and final specification, has disclosed a new element . . . and proceeds to use that in an old way without indicating any invention in the mode of use, any person who has a patent or is interested in a patent for the old way has a right to come forward and say, This is a claim which ought not to be inserted in the specification unless there is a distinct claim to invention in the way in which this is proposed to be applied." (6 O. R. 163, at p. 165.)

*Insertion of disclaiming Clause.*

(g) *TEAGUE'S PATENT*. [1885]

The applicant described and showed on his drawings certain parts of a rock drill which were protected by the opponent's patent. The opponent was allowed to elect whether he would have those parts struck out or a disclaiming clause inserted. (*Griff.* 298.)

(h) *WELCH'S PATENT*. [1885]

Application for patent for making bricks, &c., from refuse slate opposed on the ground of a prior patent for a similar process

existing, but allowed with a clause mentioning the prior patent, and expressly disclaiming any claim to the process therein described. (*Griff.* 300.)

(i) COOPER AND FORD'S PATENT. [1886]

The applicant described in his specification certain improvements in knitting machinery and certain frictional driving gear, which latter had been already patented by the opponent. The patent was allowed after the insertion of a clause stating that no claim was made to the driving of the shaft, "as friction driving apparatus of this kind has before been used for driving the shafts of knitting machines." (*Griff.* 275.)

(j) ANDERSON AND MCKINNELL'S APPLICATION. [1887]

The opponent's machine was materially different from the applicant's. The Solicitor-General said: "Of all ways of protecting pre-existing arrangements in matters of this kind, the one I should be the least willing to adopt would be the mention in one specification of the fact of another patent being in existence." (2 *Griff.* 23, at p. 25.)

(k) HOOKHAM'S APPLICATION. [1887]

*Semble*, if there is a distinct reference in the provisional specification to an invention or a device which was within the specification of the opponent, the opponent may be entitled to have a disclaimer inserted. (2 *Griff.* 32.)

(l) LORRAIN'S APPLICATION. [1888]

Where a patent is opposed on the ground of a prior patent having been granted for the same invention, no harm is done to the owners of the prior patent by allowing the specification in a particular form, but the law officer is bound to protect the public, so that they may not be misled by any specification which, on the face of it, might be held to include a wider kind of invention than that to which the patentee is on the evidence entitled. (5 *O. R.* 142.)

(m) GUEST AND BARROW'S APPLICATION. [1888]

A prior patentee has not any right to be specially named unless the applicants are willing to name him, and unless it is clear that there is no other publication except the one that is mentioned.

The applicant's provisional specification admittedly covered the opponent's invention, and the applicant, before the Comptroller-General, inserted a disclaimer as to the general state of knowledge:—*Held*, on appeal, that that was sufficient.

Where a particular patentee or a prior inventor has made a broad general claim, he is not on that account entitled to have limiting words inserted in the applicant's patent, unless he can shew that such words are really necessary to protect him. (5 *O. R.* 312.)



## (n) AIREY'S APPLICATION. [1888]

The Solicitor-General settled the disclaimer in the following form: "I am aware of (the opponent's) patent No. 4726 of 1886 for 'Machine for measuring the height of Human Beings automatically,' and I declare that I do not claim the mechanism therein described and claimed, but what I claim is," &c., &c. (5 O. R. 348, at p. 350.)

## (o) GOZNEY'S APPLICATION. [1888]

A disclaiming clause inserted on opposition is intended to guard against the claiming in a new patent something not only described in the old patent, but included in the claim in the old patent as a part of the previous invention. (5 O. R. 597.)

## (p) HILL'S APPLICATION. [1888]

If patents overlap, the distinction between the inventions in the earlier and later patents should be made clear for the sake of the public. (5 O. R. 599.)

## (q) SIELAFF'S APPLICATION. [1888]

The Attorney-General approved of the remarks made by the Solicitor-General in *Anderson and McKinnell's* application. (5 O. R. 485.)

## (r) LYNDE'S APPLICATION. [1888]

Disclaimer ordered: "I am aware of (the opponent's) patent No. 16,433 of 1884, and do not claim anything claimed and described therein." (5 O. R. 663, at p. 665.)

## (s) WALLACY'S APPLICATION. [1889]

The applicant stated in his specification that the operation of the weighing mechanism was substantially the same as that described in his former patent, and in his former patent a reference was made to the opponent's patent:—*Held*, that a similar reference must be inserted, and the form used in Lynde's Case was followed. (6 O. R. 134.)

## (t) BROWNHILL'S APPLICATION. [1889]

An opponent may appeal in order to get a reference to his specification inserted, although he does not appeal against the allowance of the patent. (6 O. R. 135.)

## (u) HOFFMAN'S APPLICATION. [1890]

The disclaiming clause serves two useful purposes, one to protect the former inventor, and the other to protect the new inventor by limiting his claim, thus showing that his patent is not assailable on the ground that it is an infringement on the former patent. (7 O. R. 92.)

*Where prior Invention is not the same.*

(u) HÚTH'S PATENT. [1884]

An application for a patent for improvements in the manufacture of compounds of india-rubber, gutta-percha, and like materials, opposed on the ground that the invention had been already patented, but granted on the ground of a substantial difference in the ingredients used. (*Griff.* 292.)

(v) CUMMING'S PATENT. [1884]

A patent for an improved fastener for bracelets allowed, although the difference from the invention already patented by the opponent was very slight. (*Griff.* 277.)

(w) STUBB'S PATENT. [1885]

The law officer will not stop a patent which is opposed on the ground that a prior patent exists unless he is satisfied that the patents are identical. (*Griff.* 298.)

(x) JONES'S PATENT. [1886.]

It is not sufficient that the invention proposed should be substantially the same as that of the opponent; it must be identical:—*Held*, therefore, that a notice which included the words “substantially the same” was wrong, because it raised a question of infringement which the law officer had no power to decide. (2 *Griff.* 33.)

(y) NEWMAN'S APPLICATION. [1887]

An opponent who owned a similar patent of prior date raised the objection that the applicant's claim went beyond the title and the provisional specification. If the applicant has good subject-matter, and the invention is not identically the same as that of the opponent, the applicant is entitled to have his patent sealed, though an action for infringement may be with success brought by the opponent. The law officer will not stop a patent at the instigation of an opponent because there is some general principle of patent law which is infringed, although it may be reasonable for the law officer to indicate to the applicant that it would be well to consider such a point. (2 *Griff.* 40; 5 *O. R.* 271.)

(z) VON BUCH'S APPLICATION. [1887]

The opponents, the Welsbach Incandescent Light Company, had described in their patent the method of making the incandescent envelope which the applicant now sought to patent; but they had not claimed it as part of their invention:—*Held*, that as only that is patented which the inventor claims, this portion of the invention could not be said to have been patented within the meaning of sect. 11, and that therefore the application must be granted. (2 *Griff.* 40.)

(a) CHANDLER'S PATENT. [1887]

Where the Comptroller-General found sufficiently indicated on the documents before him what was the particular invention for which a patent was desired, and what was the chief feature in which it differed from those of the opponents—viz., the special form of gas-burner by which the gas issued vertically, and was caused to meet, end on, heated air issuing vertically downwards—he allowed the applicant to amend by confining his claim to such special feature. In such a case the time for appeal to the law officer runs from the time when the amendments are approved by the comptroller. (*Griff.* 270.)

(b) FLETCHER'S APPLICATION. [1887]

In this case a method of dyeing tissue and other papers by pressing the colouring matter through the same by means of a pair of pressure rollers while supported by an endless felt cloth, and apparatus, were held to be substantially different from a previously patented process of colouring paper by saturating it by passing through a bath and apparatus, and the patent was allowed. (2 *Griff.* 30.)

(c) WALLIS AND RATCLIFF'S APPLICATION. [1888]

The application was allowed by the Comptroller-General, but was refused on appeal by the Attorney-General on the ground that the apparatus in question did not substantially differ from that already patented by the opponent. (5 *O. R.* 347.)

(d) LAKE'S APPLICATION. [1889]

There being a strongly controverted question of anticipation by former specifications concerning the manufacture of alpha naphthol disulpho acids for dyes, the Solicitor-General declined to have an expert assessor, on the ground that, even if advised by an expert, he would not think it right to stop the patent where there was such a contest. (6 *O. R.* 548.)

(e) FAWCETT'S APPLICATION. [1889]

The application being opposed on the ground that "the invention or material parts thereof had been patented in this country on applications of prior date," the words "or material parts thereof" were objected to and, by leave of the comptroller, were struck out. (*Good. Prac.* 10.)

(f) HAYTHORNTHWAITHE'S APPLICATION. [1889]

In considering what is the invention in the prior patent, the law officer will not consider whether there is a variance between the opponents' provisional and complete specifications. (7 *O. R.* 70.)

*Concurrent Applicants.**(f) Ex parte DYER.* [1812]

Where there were concurrent applications for letters patent for the same object, he who obtained the great seal first, by getting quickest through the various stages, had the sole right at law. (*Holroyd*, 59.)

*(g) CORNISH v. KEENE.* N. P. [1835]

Tindal, C.J.: "The first who comes to the Crown and takes out a patent is the man who has a right to clothe himself with the authority of the patent, and enjoy its benefits." (1 *Web. P. C.* 508.)

*(h) In re SIMPSON AND ISAACS' PATENT.* [1853]

Objections were filed to an application for a patent, and were overruled by the law officer of the Crown; he issued his warrant to seal, to which also objections were filed. On a petition by the patentees, the Court made an order to affix the great seal without sending the case back to the law officer.

The Lord Chancellor said: "I think that Lord Eldon was correct in *Dyer's Case*. I shall follow the rule which he there laid down. In that case both parties invented the same thing at the same time, and the question was, who was to be preferred, the first who applied for, or the first who obtained, the patent? His lordship decided in favour of the latter. In that case the patentees first applied, and the Act means to put the order for protection granted at the time of the application on the same footing as the patent stood before; you are therefore the first entitled. I am of opinion, too, that you are entitled to have the patent sealed. No doubt, in advising the Crown to seal letters patent, I ran the risk of occasioning great injury to parties, by driving them into litigation; but by the contrary course I run the risk of doing irreparable injury. In my opinion, the question is the same as if, under the old law, application were being made to me for letters patent to be granted at the time when the application for this patent was made. This application is rested on two grounds: first, that these patentees are not the true inventors; secondly, that the invention is not new. I am quite ready to say that I think there is strong evidence that it was not; but I shall not take upon myself so to decide. . . . I think I am bound to decide myself, not whether they have made out that they are the true inventors, and that the invention is new, but whether such a *primâ facie* case has been made that I ought to put them into a position to litigate the question with the public." (21 *L. T. Rep.* 81.)

*(i) HEATH v. SMITH.* [1854]

Campbell, C.J.: "When I was Attorney-General, and it appeared that there were two contemporaneous discoveries, I used to give a patent to the two jointly." Sir A. E. Cockburn, Attorney-General: "I have adopted the same practice, but I have found

parties ordinarily unwilling to accept patents on such terms." (2 *Web. P. C.* 271.)

(j) *In re* LOWE'S PATENT. [1856]

L. and W. were joint patentees of an invention for propelling vessels, and whilst engaged in making experiments with regard to it an accident happened, which appeared to have suggested to each an improvement upon the method previously adopted. They communicated their ideas to each other, but neither took any steps to secure the benefit of the invention for two years, when L. applied for a patent, against the sealing of which W. entered a *caveat*, on the ground that he (W.) was the first inventor. The evidence on this point being conflicting:—*Held*, that L., having first applied, was entitled to have his patent sealed, though possibly W. might be able to get it repealed upon *scire facias*. (25 *L. J.*, *Ch.* 454.)

(j<sup>1</sup>) CRAIG AND MACFARLANE'S APPLICATIONS.

Coleridge, S.-G., being satisfied that one of the applicants was entitled to one part of the invention whilst the other could more fairly claim another part, issued his warrants to both limiting the provisional specifications accordingly. (*John*, 165.)

(k) *In re* BATES AND REDGATE'S APPLICATION. [1869]

The existence of a prior provisional specification is not a ground, in the absence of fraud, on which the Attorney-General ought to refuse to allow a second provisional specification by another inventor to be filed; and, in the event of the later applicant for provisional protection being the first to obtain a grant of letters patent, his patent is a bar to the grant of letters patent for the same invention to the earlier applicant for such provisional protection. (*L. R.*, 4 *Ch.* 577; 38 *L. J.*, *Ch.* 501.)

(l) *Ex parte* MANCEAUX. [1870]

Where the law officer has reported that part of an invention, for which a patent is sought, is identical with part of an invention which is the subject of an existing patent, a second patent will not, except under special circumstances, be granted for that part, although the validity of the first patent is disputed. (*L. R.*, 6 *Ch.* 272.)

(m) *Ex parte* SCOTT AND YOUNG. [1871]

When a servant filed a provisional specification for an invention, after which the master filed a provisional specification for a similar invention, and subsequently filed a complete specification and obtained letters patent:—*Held*, that under the circumstances, which threw the gravest suspicion on the *bona fides* of the master, the great seal might be affixed to the letters patent for the servant's invention, and that the letters patent might bear the date of his provisional specification. (*L. R.*, 6 *Ch.* 274.)

(n) *In re* HENRY'S APPLICATION FOR LETTERS PATENT: '*Re* FARQUHARSON'S APPLICATION FOR LETTERS PATENT. [1872]

An applicant for a patent does not, by lodging a complete specification under the 9th section of the Patent Law Amendment Act of 1852, acquire the rights of a patentee so as, during the six months' protection, to prevent any other person who has previously obtained provisional protection for a similar invention from obtaining a patent. (*L. R.*, 8 *Ch.* 167; 42 *L. J.*, *Ch.* 363.)

(o) *In re* HARRISON. [1874]

Applications were made for two patents for inventions alleged to be similar. The second applicant obtained a patent. The first applicant then presented a petition to have the great seal affixed to letters patent for his invention, alleging that his delay had been caused by the representations of the second applicant, and also that the inventions were not similar. The Lord Chancellor examined the provisional specification of the first applicant, and the complete specification of the second applicant, and finding no substantial similarity between the inventions, directed the letters patent of the first applicant to be sealed. (*L. R.*, 9 *Ch.* 631.)

(p) *In re* DERING'S PATENT. [1880]

Lord Cairns, L.C., refused to follow the decision in the case of *In re Bates and Redgate's Patent* (*L. R.*, 4 *Ch.* 577), on the ground that the legislature intended patentees to have the full term of protection given by the provisional specification for perfecting their inventions, and ordered the applicant's patent to be sealed, although the sealing was opposed by an inventor who had at a later date obtained provisional protection for the same invention, and had already had the great seal affixed. (13 *Ch. D.* 393.)

(q) HATFIELD'S PATENT. [1885]

The evidence being conflicting, the Comptroller-General not being able to have the declarants cross-examined, sealed a patent. On appeal, it was agreed between the parties that if the opponent, who had also applied for a patent, withdrew his opposition, the applicant would not oppose the opponent's application, and the law officer, without actually sanctioning the terms, adjourned the case to enable them to be carried out. (*Griff.* 288.)

#### *Costs.*

(r) *Ex parte* FOX. [1812]

No costs will be given when the opposition is not unreasonable. (1 *V. & B.* 67; 1 *Web. P. C.* 431.)

(s) *Ex parte* HENSON, *In re* ALCOCK'S PATENT. [1832]

Where a person has not opposed before the law officer, and is admitted to oppose the sealing under special circumstances, he will, if unsuccessful, be ordered to pay the costs (1 *Web. P. C.* 432; 4 *My. & C.* 511.)

(t) *In re* CUTLER'S PATENT. [1839]

A party, who had lodged an unsuccessful *caveat* against the granting of a patent, ordered to pay to the patentee the taxed costs occasioned by the *caveat*. *Semble*, such costs will be taxed upon the principle upon which costs in a cause are taxed as between party and party. (See report in this case for the allowances made on taxation.) (4 *My. & Cr.* 510.)

(u) *In re* NICKEL'S PATENT. [1841]

Petition to re-seal an altered patent, *caveat* entered, and re-sealing refused. The Lord Chancellor ordered the petitioner to pay the opponent's costs. (Cit. *Hindmarch*, 536; 1 *Phillipps*, 36.)

(u<sup>1</sup>) *In re* ASHENHURST'S PATENT. [1853]

The sealing of the patent having been prevented by the filing of objections, which were subsequently withdrawn, the objector was ordered to pay costs. (2 *W. R.* 3; 22 *L. T. Rep.* 109.)

(v) *In re* M'KEAN'S PATENT. [1859]

Where a petition for sealing was answered for the first day of Michaelmas term, and the respondent having only filed his affidavits on that day, was not allowed to read them, and the patent was sealed, the Lord Chancellor refused to give costs against the respondent. (1 *De G., F. & J.* 2; 8 *W. R.* 1; 1 *L. T. Rep.*, *N. S.* 19.)

(w) *In re* COPLEY'S PATENT. [1861]

Where notice of objections to the sealing a patent was filed and afterwards withdrawn, the costs of the objections and of the petition rendered necessary by them were ordered to be paid by the objector. (31 *L. J., Ch.* 333; 8 *Jur.*, *N. S.* 106; 5 *L. T. Rep.*, *N. S.* 387.)

(x) *Ex parte* YATES. [1869]

Where the sealing of a patent was objected to, on the ground that the invention was a colourable imitation of one which was the subject of an existing patent, a reference was made to the law officer, whether, having regard to the prior patent, the seal ought to be affixed to the patent as applied for. The law officer having certified against the patent, the Court dismissed the petition with costs, notwithstanding no opposition had been made to the petitioner's application for a patent until he had applied to have it sealed, and he had given all the requisite notices. (*L. R.*, 5 *Ch.* 1.)

(y) *Ex parte* MANCEAUX. [1870]

When the sealing of a patent is opposed on the ground that the invention is similar to one which is the subject of an existing patent, a reference will be made to the law officer whether, having regard to the prior patent, the seal ought to be affixed to the patent as applied for, *the opponent paying the costs of the hearing*, unless

there has been fraud on the part of the applicant. (*L. R.*, 5 *Ch.* 518.)

(z) STUBBS' PATENT. [1885]

The appeal to the law officer is a rehearing. If no fresh evidence is adduced, and there are no special matters which ought to influence the judgment of the law officer, costs will follow the event. (*Griff.* 298.)

(a) AINSWORTH'S PATENT. [1886]

The applicant, who had succeeded before the comptroller, failed to appear on the day fixed for the appeal. Afterwards he explained, and, on his paying the costs of the adjournment, a rehearing was fixed. (*Griff.* 269.)

(b) ANDERTON'S APPLICATION. [1886]

It is of importance that before the Comptroller-General, who cannot cross-examine, there should be the fullest good faith; and therefore, where the applicant's declaration did not give the whole story, he was not allowed any costs, although successful. (2 *Griff.* 25.)

(c) KNIGHT'S APPLICATION. [1887]

The applicant having given notice of appeal, and then withdrawn it, was ordered to pay costs. (2 *Griff.* 35.)

(d) WOODHEAD'S APPLICATION. [1887]

When the opponents appealed on the ground that the alteration made by the comptroller necessitated a further alteration, but had not asked the applicants to agree to this alteration before appealing, no costs were given. (2 *Griff.* 44.)

(e) SIELAFF'S APPLICATION. [1888]

Each party on an appeal to the law officer should hand in at the official desk a statement of what fees have been paid before the law officer. (5 *O. R.* 487.)

*Delay.*

(f) *In re* BECK'S PATENT. [1784]

Letters patent bore the date 12th August, but a *caveat* was not discharged until the 27th, the patentee, thinking the letters patent bore date the latter day, did not enrol his specification till the 18th December, when the four months had elapsed:—*Held*, that the date of the patent could not be altered. (1 *Web. P. C.* 430.)

(g) *WATSON v. PEARS.* N. P. [1809]

A patent, dated 10th May, contained a proviso that a specification should be enrolled within one calendar month next and immediately after the date thereof. The specification was enrolled on the 10th of June following:—*Held*, that the month did



not begin to run till the day after the date of the patent, and that the specification was in time. (2 *Camp.* 294.)

(h) *In re CAMPBELL'S PATENT.* [1853]

The Court refused to extend the time for filing specifications, &c., under the Patent Act, 1852, where there had been neglect or default. (22 *L. T. Rep.* 93.)

(i) *In re SIMPSON'S AND ISAACS' PATENT.* [1853]

A petition for a patent was lodged on the 2nd October, and the warrant to seal the patent was issued on the 9th February following. By reason of objections having been filed to the application, and to the warrant to seal, the patentees were unable to file their specification within six months from the date of the letters patent. Time extended, on petition, to seven months. (21 *L. T. Rep.* 81.)

(j) *In re HARRIS'S PATENT.* [1855]

Leave was granted to file a specification after the time for that purpose had expired, when the delay had arisen solely from the non-delivery of the letter containing the proper instruction for filing. (25 *L. T. Rep.* 90.)

(k) *In re MACINTOSH'S PATENT.* [1856]

Petition that certain letters patent for materials to be used in warfare might be sealed, notwithstanding the regular time for that purpose had elapsed. On the 6th August, 1855, petition, declaration, and provisional specification deposited. 18th December, warrant for sealing signed, and objections lodged on behalf of the Ordnance. 5th May, 1856, objections withdrawn. 22nd November, petition for sealing; order refused, on the ground that no reason was stated why the application was not made on or immediately after the 15th May. The present petition stated that this delay was owing to the fact that during the period that intervened between 5th May and 17th November, the petitioner was directed by the Secretary of State for War to delay taking the necessary steps for sealing the letters patent.

The Lord Chancellor thought that, under the circumstances, the petitioner's case was made out, and ordered the letters patent to be sealed. (2 *Jur., N. S.* 1242.)

(l) *WILLIAMS v. NASH.* Ch. [1859]

The day of the date of the letters patent is excluded, and the three years do not expire until twelve o'clock at night of the anniversary of the day on which the letters patent are granted. (5 *Jur., N. S.* 596; 28 *L. J., Ch.* 886; 28 *Beav.* 93.)

(m) *In re HERSEE AND SMYTH.* [1866]

The time within which the application for the warrant and for the letters patent ought to be made under the rules of the

Patent Commissioners extended, where the delay was small and accidental. (*L. R.*, 1 *Ch.* 518; 14 *L. T. Rep.*, *N. S.* 842.)

(n) *SEQUELIN v. TERRELL.* *N. P.* [1867]

In an action for not completing a patent for the full term of fourteen years:—*Held*, that, as the effect of the statute 16 & 17 Vict. c. 5, was to give a patent by instalments of three, four, and seven years, a defendant would not be liable to pay the different sums of money required by the Act till the expiration of these different periods. (16 *L. T. Rep.*, *N. S.* 539.)

(o) *Ex parte BAILEY.* [1872]

B. obtained provisional protection on the 30th of March, gave notice to proceed on the 23rd of April, and on the 21st applied for the great seal to be affixed to letters patent for his invention. On the 29th of May a *caveat* was entered against the sealing, and B. petitioned the Lord Chancellor to affix the seal on the 27th of September:—*Held*, that B.'s delay was not an objection to sealing his patent, and that he was not put in a worse position because he had given notice to seal his patent some months before he was obliged to do so. (*L. R.*, 8 *Ch.* 60.)

#### *Procedure.*

(p) *Ex parte HOOPS.* [1802]

Enrolment of a patent could not be dispensed with for the purpose of preventing the specification being made public. (6 *Ves.* 598.)

(q) *In re BROUGH.* [1844]

The clerk at the enrolment office cannot receive an enrolment conditionally, and the Master of the Rolls refused to cancel or vacate an enrolment of a specification which had been left at the office, and had been enrolled, notwithstanding directions not to enrol it until further order. (7 *Beav.* 104.)

(r) *In re SCHLUMBERGER'S PATENT.* [1853]

The Crown could at any time before affixing the great seal, under proper circumstances, countermand the warrant. (9 *Moo. P. C. C.* 1.)

(s) *In re TOLSON'S PATENT.* [1856]

An application under the 2nd section of the 16 & 17 Vict. c. 115, by a person opposing the grant of letters patent, for the inspection of the provisional specification of certain letters patent, on the ground that the subject-matter was the same as that for which the applicant had obtained a patent, refused. (6 *D., M. & G.* 422.)

(t) *WARMAN'S APPLICATION.* [1886]

Notice of hearing had been sent to the opponent by post, but had not been delivered, and the opponent was not at the hearing.

The Comptroller-General having declined to rehear unless directed by the law officer, the opponent filed a notice of appeal, and the law officer directed a rehearing. (2 *Griff.* 43.)

(u) LAKE'S APPLICATION. [1887]

Wrigley, as agent for the opponent, gave notice of opposition, but died before the hearing:—*Held*, that the opponent's own name might be substituted in the notice. (2 *Griff.* 35.)

(v) HILL'S APPLICATION. [1888]

The appellant need not give notice to the respondent on appeal to the law officer if the respondent was the applicant before the comptroller; but notice was in future to be given by the Patent Office or the official clerk. (5 *O. R.* 599.)

*International and Colonial Arrangements.*

PATENTS ACT, 1883, sect. 103. (1.) (Amended by 48 & 49 Vict. c. 63, sect. 6.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, then any person who has applied for protection for any invention, in any such state, shall be entitled to a patent for his invention under this Act, in priority to other applicants; and such patent shall have the same date as the *date of the application* in such foreign state.

Provided that his application is made, in the case of a patent, within seven months from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification.

(2.) The publication in the United Kingdom, or the Isle of Man, during the period aforesaid of any description of the invention, or the use therein during such period of the invention, shall not invalidate the patent which may be granted for the invention.

(3.) The application for the grant of a patent, under this section, must be made in the same manner as an ordinary application under this Act.

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

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PATENTS ACT, 1885, sect. 6. In subsection one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

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PATENTS ACT, 1883, sect. 104. (1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, patented in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the preceding section with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

By Order in Council made the 26th of June, 1884, reciting the above provision and reciting that a declaration had been signed at Paris on March 17th, 1884, duly conveying the accession of Great Britain to the International Convention for the protection of industrial property, and reserving power to thereafter accede to the convention on behalf of the Isle of Man, the Channel Islands, and any of Her Majesty's possessions, it was declared that the above provision of the Act should, from the 7th July, 1884, apply to the following countries, viz. :—

Belgium.	Salvador.
Brazil.	Servia.
France.	Spain.
Guatemala.	Switzerland.
Italy.	Ecuador, and
Netherlands.	Tunis.
Portugal.	

*London Gazette*, July 1, 1884.

By an Order dated 27th January, 1885, the above was extended to San Domingo.

By an Order dated 9th July, 1885, the above was extended to Sweden and Norway.

By an Order dated 17th September, 1885, the above provisions are to apply to Queensland.

By an Order dated 16th April, 1886, the above provisions are to cease to apply to Ecuador.

By Orders dated 24th September, 1886, the above are to apply to Paraguay and Uruguay, and to cease to apply to Salvador.

By an Order dated 12th July, 1887, the above was extended to the United States of America.

By an Order dated 17th November, 1888, the above was extended to the East Indian Colonies of the Netherlands.

By Orders dated 28th May, 1889, the above was extended to Mexico, and was to cease to apply to San Domingo.

By an Order dated 8th February, 1890, the above was extended to New Zealand.

#### PATENTS RULES, 1890 (INTERNATIONAL AND COLONIAL ARRANGEMENTS).—

24. The term "foreign application" shall mean an application by any person for protection of his invention in a foreign state or British possession to which by any Order of Her Majesty in Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1883, have been declared applicable.

25. An application in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made, and shall specify all the foreign states or British possessions in which foreign applications have been made and the official date or dates thereof respectively. The application must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.

26. The application in the United Kingdom shall be made in the Form A<sup>2</sup> in the Second Schedule to these Rules and in addition to the specification, provisional or complete, left with such application must be accompanied by

- (1.) A copy or copies of the specification and drawings or documents corresponding thereto, filed or deposited by the applicant in the

Patent Office of the foreign state or British possession in respect of the first foreign application duly certified by the official chief or head of the Patent Office of such foreign state or British possessions as aforesaid, or otherwise verified to the satisfaction of the Comptroller:

- (2.) A statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification or document corresponding thereto be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

27. On receipt of such application, together with the prescribed specification and the other document or documents accompanying the same, required by the last preceding rule, and with such other proof (if any) as the Comptroller may require of or relating to such foreign application or of the official date thereof, the Comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively.

28. All further proceedings in connection with such application shall be taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications.

29. The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

(w) *In re WIRTH'S PATENT.* L. C. [1879]

Upon the hearing of a petition that the great seal might be affixed to letters patent, the Lord Chancellor did not give effect to an objection going to a matter of form, such as an objection to the jurat of a declaration, which is a matter for the Patent Office solely, as a matter of procedure.

W. was an alien resident abroad. He acted as the agent of M. & Co., and applied for letters patent in *England* for an invention of the latter. He made the usual statutory declaration, which was filed with his petition. In it W. was described as an alien resident abroad, and it was declared before H. B. M. Consul at *Frankfort*. Objection founded on these facts overruled. (*L. R.*, 12 *Ch. D.* 303.)

(x) *L'OISEAU AND PIERRARD'S APPLICATION.* [1887]

The applicants had obtained a patent in France, on the 18th August, 1886, and applied on the 8th October, 1886, without mentioning the French patent in the common form for a patent for "automatic apparatus for subjecting the person to the action of electric currents." Meantime, on the 20th August, 1886, the opponent Everitt had applied for a patent for a similar invention, and had lodged a complete specification, which was accepted. The applicant's English specification contained claims of inventions not described in the French specification, but the applicants were allowed to amend by striking out these additional claims. The law officer considered that there had been no positive misrepresentation, and that that being so he had no power either to post-date the patent or to impose terms. On an application under

sect. 103, the law officer will not insist that the words of the complete specification should be in terms in the form of the foreign specification, but any deviation is inserted at the risk of the applicant, because the only privilege given is that of date, and that privilege is confined to the invention protected in the foreign country. (2 *Griff.* 36.)

(y) SHALLENBERGER'S APPLICATION. [1889]

Shallenberger had taken out a patent in America, and Thompson, as agent of his assignee, now applied for a patent here:—*Held*, that if Thompson wanted the patent dated back it must be a patent in the name of Shallenberger, and not in the name of Thompson, and that the application must be amended accordingly. (6 *L. R.* 550.)

(z) CAREZ'S APPLICATION. [1889]

A patent taken out in the name of a foreigner is valid, and when it is desired to take advantage of the International Convention and sect 103, the application must be made in the name of the original foreign patentee. (6 *O. R.* 552.) *Semble*:—Foreign Corporations can apply under sect. 103.

(a) MAIN'S APPLICATION. [1889]

Main, who was an American, applied for a United States patent on the 18th April, 1887, and on the 18th November applied for a grant of an English patent to be dated the 18th April. The opponent had filed his application for a patent for a similar invention on the 8th June, 1887, and the United States did not come within sect. 103 until July 12th, 1887:—*Held*, by the Comptroller and Law Officer, (1) that “within seven months from his applying,” means within seven months from the date of applying, and that therefore the application was in time, and (2) that although the opponent's application preceded the Order in Council, yet that he was not a third party whose rights were preserved under Article IV. of the Convention, and that therefore the opposition failed. (7 *O. R.* 13.)

(b) VAN DE POELE'S APPLICATION. [1889]

The date of application in America appeared as the date of a “renewed” application. *Held*, that as the former application had proved abortive, the applicant was entitled to a patent as of the later date. (7 *O. R.* 69.)

### Art lost and rediscovered.

(c) HOUSEHILL COMPANY v. NIELSEN. [1843]

An invention which formerly existed, but has been entirely lost sight of and unknown to the public becomes like a new discovery (per Lord Brougham, in the House of Lords). (1 *Webst. P. C.* 717.)

**Art as the subject-matter of a patent.** See Subject-Matter, 492 (*b*).

**Art, explanation of terms of.** See *Hills v. Evans*, p. 470 (*p*).

### Assessors.

PATENTS ACT, 1883, sect. 28. (1.) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct.

(2.) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

### (c) PLATING COMPANY *v.* FARQUHARSON. [1879–1883]

When the defendants objected to their secret process being inspected, the Court appointed an analyst to inspect and report. (*Griff.* 187.)

### Assignment of Patent,

notification of, to be registered. Patents Act, 1883, sect. 23, p. 397  
for part of kingdom. Patents Act, 1883, sect. 36, p. 65  
person entitled by, to be entered on register. Patents Act, 1883, sect. 87, amended by 51 & 52 Vict., ch. 50, sect. 21, p. 65  
to take effect on termination of suit, p. 66 (*d*)  
by bankruptcy of patentee, pp. 66 (*e*), 67 (*g*) (*j*)  
by bankrupt, after mortgaging his right under, p. 66 (*f*)  
before registration of probate, p. 69 (*s*)  
of part of, pp. 69 (*g*), 287 (*t*)  
Assignee may sue for infringement, pp. 287 (*o*) (*p*), 288 (*u*)  
though only assignee of part, p. 287 (*t*)  
and may petition for extension, pp. 100 (*g*), 101 (*i*) (*j*), 102 (*p*), 103 (*u*) (*v*) (*w*)  
Assignment of all future acquired patent right is not against public policy, p. 70 (*x*)  
Assignee of shares of profits is entitled to an account from licensee, p. 71 (*x*)  
assignee not bound to keep the patent on foot, p. 72 (*d*)  
assignor does not warrant validity of patent, pp. 68 (*n*), 71 (*z*)  
communication of improvements by assignor to third parties not restrained by interim injunction, p. 71 (*a*).

PATENTS ACT, 1883, sect. 36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

Sect. 87, amended by 51 & 52 Vict., ch. 50, sect. 21. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent in the register of patents. The person for the time being entered in the register of patents, as proprietor of a patent, shall, subject to the provisions of this Act and to any rights appearing from such register to be vested in any other

person, have power absolutely to assign, grant licenses as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent may be enforced in like manner as in respect of any other personal property.

(d) *CARTWRIGHT v. AMATT.* [1799]

A. by indenture (reciting that a suit was depending between him and B. respecting certain patents, and that the same could not be assigned without hazard of defeating the suit) granted absolutely the said patents, together with some others, to C., excepting, however, until the determination of the above-mentioned suit such patents as should be necessary to support A.'s legal title. Then followed a covenant that A., upon the determination of the suit, should assign the excepted patents to C., and that until such assignment A. should stand legally possessed of the same:—*Held*, that the legal interest in the excepted patents vested in C. upon the determination of the suit, without assignment. (2 *B. & P.* 43; *Dav. P. C.* 240.)

(e) *HESSE v. STEVENSON.* [1803]

An Act of Parliament empowering a bankrupt patentee, his executors, administrators and assigns, to assign the right under letters patent to a greater number of persons than allowed by the letters patent, and declared to be a public Act, does not enable either the bankrupt or his assigns to make a better title than they could before the Act.

When a patentee becomes bankrupt, his patent right vests in the assignees. (3 *B. & P.* 565; *Dav. P. C.* 244.)

Lord Alvanley, C. J., in delivering judgment, said: "Next it is contended, that the nature of the property in this patent was such that it did not pass under the assignment; and several cases were cited in support of this proposition. It is said, that although by the assignment every right and interest, and every right of action, as well as right of possession and possibility of interest, is taken out of the bankrupt and vested in the assignees, yet that the fruits of a man's own invention do not pass. It is true that the schemes which a man may have in his own head before he obtains his certificate, or the fruits which he may make of such schemes, do not pass, nor could the assignees require him to assign them over, provided he does not carry his schemes into effect until after he has obtained his certificate. But if he avail himself of his knowledge and skill, and thereby acquire a beneficial interest, which may be the subject of assignment, I cannot frame to myself an argument why that interest should not pass in the same manner as any other property acquired by his personal industry." (3 *B. & P.* 577.)

(f) *Ex parte GRANGER.* [1812]

A patentee, having mortgaged his right under his patent, continued in the *notorious use* of the invention until his bankruptcy.



The Lord Chancellor was inclined to think the right passed to the assignees under the statute, but directed a case for the Court of King's Bench, which was never argued. (*Godson on Patents*, 2nd ed. p. 225.)

(g) *BLOXAM v. ELSEE*. [1827]

Where an Act of Parliament secured to certain persons, for a further term, the benefit arising from a patent for making a machine, with a proviso that it should become void if they should transfer or assign their interest therein to any persons exceeding the number of five; and two of the patentees became bankrupt:—*Held*, that the assignment of their interests to their assignees for the benefit of creditors, though the number exceeded twenty, was not within the proviso. (9 *D. & R.* 215; 6 *B. & C.* 169; see 15 & 16 *Vict. c.* 83, s. 36.)

(h) *DUVERGIER v. FELLOWS*. H. L. [1830]

Where a bond was given for payment of £10,000, with a condition that the money should be paid on the obligee's procuring subscriptions for 9000 shares in a company to be formed of many persons, for the purpose of becoming assignees of a patent, and carrying on the patent process; and the patent contained a proviso, that it should be void if assigned to more than five persons:—*Held*, that the obligee must be presumed to know of that proviso, and that as the bond was subject to a condition for the performance of an illegal act, it was void. (10 *C. B.* 826; affirmed in H. L., 1 *C. & F.* 39.)

It was also held in the House of Lords that the plaintiff was equally incapable of recovering on the bond, whether he knew or did not know the terms of the letters patent. (1 *C. & F.* 39.)

(i) *LOVELL v. HICKS*. [1836]

Agreement for the purchase of part of the profits of a patent, which turned out to be a mere bubble, set aside as having been obtained by fraud and misrepresentation, and so much of the purchase-money as had been paid under the agreement ordered to be repaid. (2 *Y. & C.* 46.)

(j) *M'ALPINE v. MANGNALL*. Ex. Ch. [1846]

A voluntary assignment by a patentee of letters patent, to trustees for the benefit of creditors, more than twelve in number, is not such an assignment as will avoid the patent. (3 *C. B.* 496; 15 *L. J.*, *C. P.* 298.)

(k) *PAYNE v. BANNER*. Ch. [1846]

A patentee agreed to give one-fourth share of a patent to B., in consideration of £50 then paid, and of £150 to be paid in several sums at various times; and of a sum of £300 to be paid by a particular day, to be applied in taking out foreign patents. The £300 was not paid, and the foreign patents were, consequently, not obtained:—*Held*, that time was the essence of the

contract, and that the patentee was entitled to rescind it, notwithstanding he had accepted payment of the other sums at other times than those which were fixed by the agreement. (15 *L. J.*, *Ch.* 227.)

(l) *ELECTRIC TELEGRAPH COMPANY v. BRETT.* [1851]

The assignee of a patent may maintain an action for infringement. (10 *C. B.* 838.)

(m) *HILL v. MOUNT.* [1856]

By an agreement between A. and B., it was agreed that A. should do all acts necessary, except the advance of money, for the purpose of procuring and perfecting certain letters patent, and should *immediately after the same were procured* execute an assignment of one-third share therein to B.; and B. agreed to pay all fees and disbursements that might be necessary for procuring the letters patent, enrolling the specification, and otherwise *perfecting* the same:—*Held*, that the execution of an assignment by A. was the whole consideration for the undertaking of B. to pay the sums mentioned in sect. 2 of 16 & 17 Vict. c. 5; and, consequently, a condition precedent to his right to sue B. for the non-payment thereof. (18 *C. B.* 72; 25 *L. J.*, *C. P.* 190.)

(n) *HALL v. CONDER.* [1857]

In an agreement between plaintiff and defendant, it was recited that the plaintiff had invented and obtained a patent for a method of preventing boiler explosions and desired to dispose of half such patent, to which he declared he had full right and title, and that he had applied to the defendant to purchase such half, and plaintiff agreed to make over, and did accordingly make over, to the defendant the above-mentioned half of the said patent:—*Held*, that by this agreement the plaintiff did not profess to sell, nor did the defendant profess to buy, a good and indefeasible patent right, but only the moiety of the patent, such as it was; and that, as there was no express or implied warranty of title or quality, it was no answer to an action for the price of the said moiety of the patent, to plead that the invention was wholly worthless, and of no public utility, and not new, and that the plaintiff was not the first and true inventor. (2 *C. B.*, *N. S.* 22; 3 *Jur.*, *N. S.* 366; 26 *L. J.*, *C. P.* 138; affirmed on appeal, 2 *C. B.*, *N. S.* 53; 3 *Jur.*, *N. S.* 963; 26 *L. J.*, *C. P.* 288.)

(o) *SMITH v. NEALE.* [1857]

The defendant made the following written proposal to the plaintiff, who accepted it verbally:—"First, that the patent should be conveyed to myself and any friend of yours, in trust for 'The Ladies' Guild,' subject to the following conditions."

The conditions related to the remuneration of the plaintiff, and the payment of the stamp duty on the patent.

Willes, J., in delivering judgment, said: "Such a contract

involves no warranty that the invention was new, or was a manufacture within the statute of James, but merely that Her Majesty had granted to the plaintiff the letters patent which she proposed to assign. In short, the defendant in this case, as in *Hall v. Conder*, contracted for the use of the plaintiff's right such as it was, without regard to whether it could be sustained upon litigation or not; and there is nothing unreasonable or uncommon in such a bargain." (2 *C. B.*, *N. S.* 67; 3 *Jur.*, *N. S.* 516; 26 *L. J.*, *C. P.* 143.)

(p) *DUNNICLIFF v. MALLET*. [1859]

It is competent for the assignee of a separate and distinct portion of a patent to sue for an infringement of that part without joining one who has an interest in another part. (7 *C. B.*, *N. S.* 209.)

(q) *WALTON v. LAVATER*. [1860]

The sale of a moiety of a patent right conveys an interest *pro tanto* in the patent. (8 *C. B.*, *N. S.* 162; 6 *Jur.*, *N. S.* 1251; 29 *L. J.*, *C. P.* 275; 3 *L. T. Rep.*, *N. S.* 272.)

(r) *KERNOT v. POTTER*. Ch. [1861]

P. agreed to purchase from K. a patent for purifying paraffine, and to work it during fourteen years, "in case it could be so long worked at a profit," and to pay a royalty of one-third of the difference between the market price of crude paraffine and the price it sold at. It turned out, that although it could be worked at a profit, yet deducting the royalty reserved there would be a loss:—*Held*, that the agreement was at an end. (30 *Beav.* 343.)

(s) *ELLWOOD v. CHRISTY*. [1864]

The executors of a patentee having obtained probate of their testator's will, assigned his patent to another person, but the probate was not registered till after the assignment:—*Held*, that the assignment was valid. (10 *Jur.*, *N. S.* 1079; 13 *W. R.* 54; 11 *L. T. Rep.*, *N. S.* 342; 17 *C. B.*, *N. S.* 754; 34 *L. J.*, *C. P.* 130.)

(t) *LEWIN v. BROWN*. [1866]

The declaration stated that a petition had been presented by the plaintiffs, at the request of the defendant, for the granting to the defendant of a patent, that the plaintiffs had filed a provisional specification at their own expense, upon condition that the defendant should complete the specification within six months, and that afterwards it was agreed that the defendant should sell to the plaintiffs his rights in respect of the said patent for the sum of £5, to be paid by the plaintiffs to the defendant on their having completed, at their own expense, the said patent; that it thereupon became necessary, in order to enable the plaintiffs to complete the said patent in pursuance of the said agreement, that the defendant should sign and seal a complete specification; that the plaintiffs tendered to the defendant a

complete specification for his signature. Breach, that the defendant would not sign it:—*Held*, that the defendant was bound, under this agreement, to sign the specification. (14 *W. R.* 640.)

(*u*) *DAW v. ELEY.* Ch. [1867]

A patent was taken out in *France*, in 1858, by A., who, in 1861, obtained letters patent for his invention in *England*. The English patent was assigned by A. to B. In 1866 the French patent was declared void, on the ground of the non-payment by A. of the fees imposed upon patentees by the French law:—*Held*, that B., as assignee of the English patent, was bound by the decision respecting the French patent; for, “it was the business of every one who took an assignment of a foreign patent—having sect. 25 before him—to see that the foreign patent was kept up in its full validity.” (*L. R.* 3 *Eq.* 496; 36 *L. J.*, Ch. 482.)

(*v*) *SMITH v. BUCKINHAM.* [1870]

By an agreement between the plaintiff and defendant, after reciting that the plaintiff had lately invented an improved composition or material to be employed in waterproofing or rendering woven fabrics impervious to moisture, for which he had duly obtained provisional protection, and had obtained a certificate of protection; it was agreed between them for the considerations therein mentioned, and in consideration of a further sum of £350, to be paid on the completion of the necessary specification and grant of the letters patent, to transfer and make over to the defendant all his interest in the invention or improvement thereof, and all benefit to be derived from the provisional protection, or from any letters patent to be thereafter granted for the invention. In an action on this agreement to recover the £350, the defendant pleaded that the plaintiff had not invented an improved composition or material to be employed in waterproofing or rendering woven fabrics impervious to moisture:—*Held*, the plea was bad. (18 *W. R.*, 314; 21 *L. T. Rep.*, N. S. 819.)

(*w*) *CHEVASSE v. STEVENS.* [1874]

Bill to set aside an assignment of a patent on the ground of misrepresentation by the patentee, dismissed on the ground, *inter alia*, that the representations were made *bonâ fide*. (*W. N.* 1874, p. 193.)

(*x*) *PRINTING AND NUMERICAL REGISTERING COMPANY v. SAMPSON.* M. R. [1875]

It is not against public policy for the vendor of a patent to agree to assign to the purchaser all future patent rights which he might afterwards acquire with respect to the inventions sold, or any of a like nature. Specific performance of an agreement to that effect decreed. (44 *L. J.*, *Eq.* 705.)

(x) *BERGMANN v. MACMILLAN.* [1881]

When an assignment is made of a share of profits arising from the working of a patent by licensees, the assignee is entitled to an account from the licensee, but the account must be taken once for all in the presence of all the parties interested. The licensee is not bound to account to each assignee separately. The assignee who asks for an account must place himself in the position of the assignor by offering to pay to the accounting party anything which may be due to them by the assignor. (17 *Ch. D.* 423.)

(y) *RUSTON v. TOBIN.* [1881]

Action to set aside an agreement for purchase of defendant's patent on grounds of misrepresentation and concealment, and counterclaim for specific performance. Plaintiff's action was dismissed with costs, and the defendant had a decree for specific performance, with a reference to ascertain the deductions which ought to be allowed in respect of the French patent, which was invalid, and the Belgian patent, which had lapsed. (*W. N.* 1881, 6.)

(z) *LIARDET v. HAMMOND ELECTRIC LIGHT COMPANY.* [1883]

In an action for specific performance of an agreement for purchase by defendants from the plaintiffs of certain patents, the defendants pleaded that it was an implied term of the contract that the patents were good and valid patents, and that in fact the patents were not good and valid:—*Held*, on the construction of the agreement, that there was no reasonable ground to contend that the case was taken out of the ordinary rule that the vendor of a patent does not warrant its validity, and that therefore the plea ought to be struck out, since otherwise the plaintiff could not safely abstain from producing evidence as to validity. (*W. N.* 1883, 96; 31 *W. R.* 710.)

(a) *LONDON AND LEICESTER HOSIERY COMPANY v. GRISWOLD.* [1886]

The plaintiffs were assignees of a patent; the defendant, the inventor, had therein covenanted to communicate any improvements to the plaintiffs. The plaintiffs moved for an interim injunction to restrain the defendant (1) from infringing, (2) from disclosing his improvements to other persons, (3) from assisting defendants in actions brought by the plaintiffs for infringements. The Court held (1) that there was no infringement; that to grant (2) would be compelling specific performance of the covenant on an interlocutory application; and that as regards (3) the Court could not on an interlocutory motion go so far as to restrain the defendant from communicating to other persons material information within his own knowledge relating to specifications or other matters antecedent to the granting of the patents in question. (*Griff.* 154; 3 *O. R.* 251; 2 *T. L. R.* 676.)

(b) *ANDERSON v. PATENT OXONITE COMPANY, PUNSHON AND VIZER.*  
[1886]

The plaintiff asked for an interim injunction to restrain the defendant company from infringing a patent for an improved method of blasting granted in 1883 to Punshon and Vizer. In 1884 the plaintiffs and Punshon had left a provisional specification for improvements on the said patent, and in 1885 Punshon had signed a document making over to the plaintiff Anderson all his share in the said patent. The name of Anderson was afterwards entered on the register as assignee of a half-share of the patent. The defendant company and Punshon set up a defence that the assignment to Anderson was obtained by fraud, and moved to expunge the name of Anderson from the register. Chitty, J., found that the defence was not proved, and granted an interim injunction, and dismissed the cross motion with costs. (3 *O. R.* 279.)

(c) *In re PARNELL'S PATENT. COLONEL HALKETT'S APPLICATION.*  
[1888]

An agreement which began "It is proposed to form a syndicate to take up patents for an increased number of countries"—say *inter alia* Great Britain—in *re* Mrs. Parnell's patent process, Mrs. Parnell and Colonel Halkett to share equally, "the terms on which the rights are to be transferred to such syndicate to be agreed upon collectively by both the above persons":—*Held*, not to give Colonel Halkett any right of equity to a half-share in a patent for Great Britain which was taken out subsequently. (*T. L. Rep.* IV., 197; 5 *O. R.* 126.)

(d) *In re RAILWAY AND ELECTRICAL APPLIANCES COMPANY.* [1888]

Patentees by deed assigned their patent, with covenants for title and quiet enjoyment, to a company for £250, "and for the other considerations therein appearing." The company covenanted to pay to the patentees a royalty for every article manufactured or sold by the company under the patent "while subsisting," and also a proportion of the profits; but did not expressly covenant either to keep the patent on foot, or to manufacture or sell articles under the patent. Through inadvertence the company omitted to pay the second renewal fee, and the patent lapsed:—*Held*, that no covenant to keep the patent on foot could be implied; and that even if it could, the patentees could not obtain more than nominal damages against the company, as there was no obligation express or implied, to manufacture the patented articles. (39 *Ch. D.* 597.)

### Assistance in carrying out invention.

(e) *BLOXAM v. ELSEE.* [1825]

Where a patentee has employed a professional engineer to assist in carrying an invention into effect, it is no objection to the patent that the assistant has suggested several parts of the patented machinery. (1 *C. & P.* 567.)

**(f) MINTER v. WELLS.** [1834]

If the patentee suggested the principle to another, and the other was assisting him, then the patentee is the true and first inventor, and the assistant is a machine, so to speak, used for the purpose of carrying the conception into effect. (1 *Web. P. C.* 127.)

**Assizes.** See under Practice Venue, p. 353.

**Attachment.** See Practice Injunction, p. 333 (*y*) (*z*).

**Attorney-General.** On petition for extension. See under Extension, pp. 99, 111 (*m*), 113 (*w*), 118 (*q*), 122 (*m*), 139 (*i*) (*k*).

**Bankrupt,**

patent vests in assignees of, p. 73 (*g*)

*quære*, after mortgage, p. 73 (*h*)

assignee of, may sue for infringement, p. 286 (*k*)

action for infringement against, continued against trustee, p. 73 (*k*).

**(g) HESSE v. STEVENSON.** [1803]

When a patentee becomes bankrupt, his patent rights vested in the assignees. (3 *B. & P.* 565; *Dav. P. C.* 244.)

**(h) Ex parte GRANGER.** [1812]

A patentee having mortgaged his right under his patent continued in the notorious use of the invention until his bankruptcy. The Lord Chancellor was inclined to think that the right passed to the assignees under the statute, but directed a case for the Court of King's Bench, which was never argued. (*Godson on Patents*, 2nd ed., p. 225.)

**(i) BLOXAM v. ELSEE.** [1827]

Term of patent extended by Act of Parliament provided that the patentees should not transfer or assign to any persons exceeding the number of five: two of the patentees became bankrupt:—*Held*, that the assignment to their assignees for the benefit of creditors, though the number exceeded twenty, was not within the proviso, and that the assignees might maintain an action for infringement. (9 *D. & R.* 215; 6 *B. & C.* 169.)

**(j) M'ALPINE v. MANGNALL.** [1846]

A voluntary assignment of letters patent to trustees for the benefit of creditors more than twelve in number did not avoid the patent. (3 *C. B.* 496; 15 *L. J. C. P.* 298.)

**(k) WATSON v. HOLLIDAY (C. A.)** [1883]

An action to restrain infringement and for an account of profits or, in the alternative, damages, is not a claim for unliquidated damages within the prohibition of sect. 31 of the Bankruptcy Act, 1869. Consequently when the defendant to such an action had become bankrupt, and had put in a defence but did not appear, and the trustees appeared but put in no defence:—*Held*, that as the

trustees had not moved to stay the action, nor demurred, there must be an account of profits made by Holliday, and the trustees must pay the costs. (30 *W. R.* 747; 31 *W. R.* 536; 52 *L. J. Ch.* 543; 48 *L. T.* 545.)

### Board of Trade,

may order the grant of compulsory licenses, p. 77

has power to settle the amount to be paid to a patentee for models supplied to the South Kensington Museum, p. 220

has power by Patents Act, 1883, sect. 101, to make General Rules, p. 580.

There is no definition in the Patents Act of the words Board of Trade, and their meaning is therefore settled by 24 & 25 Vict., ch. 47, sect. 65, to be "The Lords of the Committee of Privy Council appointed for the consideration of matters relating to Trade and Foreign Plantations" (*Griff.*, p. 321); but now, by the Patents Act of 1888, it is provided (sect. 25):

After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely,

"(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

"(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

"(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified."

**Book**, publication in. See under Novelty, pp. 244 to 261.

**Books**, inspection of defendant's. See pp. 319 (*u*), 326 (*z*).

**Cancelling Letters Patent**. See p. 151 (*a*).

**Caveat** against extension, p. 107

practice of entering is discontinued except by special leave, p. 41 (*p*).

**Certificate** that validity of patent came in question. See under Practice, Costs, pp. 389 (*g*<sup>1</sup>), 390 (*m*) (*n*), 392 (*y*), 393 (*f*) (*g*), 394 (*p*) (*r*), 395 (*s*).

**Certificate** that particulars delivered have been proved or have been reasonable and proper. See under Practice, Particulars, pp. 315 to 318.

**Certificate** of Secretary for War that invention ought to be kept secret. See Secretary for War, p. 406.

**Certificate of the Comptroller**, effect of.

PATENTS ACT, 1883, sect. 96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.



## Certificates of Payment and Renewal.

PATENT RULES, 1890, 45 and 47, provide for the leaving of certificates of payments of fees on renewal at the Patent Office, and Rule 48 provides for the giving out to the patentee of a certificate of renewal.

## Certified Copies.

PATENTS ACT, 1883, sect. 89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with a seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

PATENT RULES, 1890, rule 79. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the comptroller on payment of the prescribed fee.

## Channel Islands.

Sect. 18 of the Act of 1852 provided that letters patent should extend to Great Britain and Ireland, the Channel Islands, and the Isle of Man. This Act is now repealed by Patents Act, 1883, sect. 113, and the Channel Islands are not included in sect. 16 of that Act. (See p. 205.)

## Cheapness of Materials.

The mere quality of cheapness in the material disconnected with any new or different mode of applying that material is not patentable. (See *Curtis*, sect. 73.)

**Chemical equivalents.** See *Infringement, Equivalents*, p. 183.

**Chemical process** may be subject-matter of patent.

*PATTERSON v. GASLIGHT AND COKE COMPANY.*

A new chemical process is a proper subject for a patent, but not a mere instruction for the more efficient working of a known process, although formed on a new theoretical explanation. (*L. R. 2 Ch. D. 812: 3 App. C. 246.*)

**Claim.** See under *Specification Complete*, pp. 481 to 485.

**Clerical Errors.** See *Amendment*, pp. 28 to 30.

## Colonies,

definition of British possession, Patents Act, 1883, sect. 117, p. 76  
arrangements for mutual protection of inventions with, Patents Act, 1883, sect. 103, p. 61, sect. 104, p. 75  
prior user in does not invalidate patent, p. 227 (*n*).

PATENTS ACT, 1883, sect. 104. (1) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding

section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2) An Order in Council under this Act shall, from a date to be mentioned for the purpose in this Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

[For the provisions of Sect. 103, see p. 61.]

Sect. 117. (1) In and for the purposes of this Act, unless the context otherwise requires, . . . "British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act.

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

**Colourable imitation.** See Infringement, Colourable imitation, pp. 183 to 202.

**Combination.** See Subject Matter, Combination, pp. 500 to 511.

### Commissioners' Offices.

The offices of the Commissioners of Patents at 25 Southampton Buildings, became the new Patent Office by virtue of sect. 82 of the Act of 1883.

### Communication,

from abroad, the subject of a patent, p. 278

improvement on confidential, p. 278 (e)

patent for, taken as for original invention, is void, p. 278 (e)

petition for extension should state when patent is for, p. 104 (b)

from abroad, to be distinguished in specification from original invention, p. 449 (a).

### Company,

person includes a body corporate, Patents Act, 1883, sect. 117, p. 76

may be registered by its corporate name, Patent Rules, 1890, 73, p. 76

request for entry of subsequent proprietorship by, to be signed by agent authorised to satisfaction of comptroller, Rule 69, p. 398

form of application, how signed, p. 76

foreign corporation can apply under sect. 103, p. 76 (l).

PATENTS ACT, 1883, sect. 117. In and for the purposes of this Act, unless the context otherwise requires, "Person" includes a body corporate.

PATENT RULES, 1890, 73. A body corporate may be registered as proprietor by its corporate name.

[In the case of application for a patent by a company the form should be signed by the secretary and two directors and the common seal affixed. (*Griff.* 325.)]

(l) CAREZ'S APPLICATION. [1889]

*Semble*, foreign corporations can apply under sect. 103 of the statute of 1883. (6 *O. R.* 552.)

**Complete Specification.** See pp. 421 to 490.

**Comptroller,**

definition of, Patents Act, 1883, sect. 117, p. 77  
 limit on discretionary power of, sect. 94, p. 84  
 may be heard on appeal to the law officer, pp. 32 and 379  
 power of, to refer application to examiner, sect. 6, p. 34, sect. 9, p. 35  
     require amendment, sects. 7 and 9, pp. 9, 10  
     decide between applicant and opponent, p. 38  
     seal patent, sect. 12, p. 148, and sect. 37, p. 82  
     enlarge time for payment of renewal fee, p. 559  
     extend time, p. 557  
     allow amendment of specification, p. 10  
     refuse a grant contrary to law or morality, p. 396  
     make entries in register, sect. 87, p. 397  
     certify copies, sect. 89, p. 75  
     take directions of law officer, sect. 95, p. 83  
     dispense with evidence, Rule 80, p. 77.

**PATENTS ACT, 1883, sect. 117.** In and for the purposes of this Act, unless the context otherwise requires, "Comptroller" means the Comptroller-General of Patents, Designs, and Trade Marks.

**PATENT RULES, 1890, rule 80.** Where under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence is required to be produced to or left with the comptroller, or at the Patent Office, and it is shown to the satisfaction of the comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

**Compulsory Licenses.**

**PATENTS ACT, 1883, sect. 22.** If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

- (a) The patent is not being worked in the United Kingdom; or
- (b) The reasonable requirements of the public with respect to the invention cannot be supplied; or
- (c) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention, and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

[But this provision is not to affect patents granted before the commencement of the Act or on an application then pending (see p. 94).]

**PATENT RULES, 1890. 60.** A petition to the Board of Trade for an order upon a patentee to grant a license shall show clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order.

61. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits, or statutory declarations, and other

documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee.

62. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition.

63. If and when a *prima facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

64. Within fourteen days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.

65. The petitioner within fourteen days from such delivery shall leave at the Patent Office his affidavits, or statutory declarations in reply, and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

66. Subject to any further directions which the Board of Trade may give the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition.

**Concealment** in specification as to best mode of working will invalidate patent, p. 436, *seq.*

**Concurrent Applicants.** See Application for Letters Patent, Concurrent Applicants, pp. 54 to 56.

**Conditions of Grant.** See Grant—Conditions of, p. 148.

**Confidential Disclosure,** communication made to public officers in course of duty cannot be, p. 254 (*i*).

### Confirmation.

The power to confirm which was granted by 5 & 6 Will. IV., ch. 83, sect. 2, appears to be taken away by the repeal of that statute by 46 & 47 Vict., ch. 57, sect. 113. The following cases which dealt with confirmation have therefore been omitted.

WESTRUPP AND GIBBIN'S PATENT. (1 *Web. P. C.* 555.)

HEURTILOUP'S PATENT. (1 *Web. P. C.* 553.)

ROBINSON'S PATENT. (5 *Moore P. C. C.* 65.)

STEAD'S PATENT. (2 *Web. P. C.* 146.)

CARD'S PATENT. (2 *Web. P. C.* 161, 12 *Jur.* 507, 6 *Moore P. C. C.* 207.)

LAMENEAUDE'S PATENT. (2 *Web. P. C.* 164.)

HONIBALL'S PATENT. (2 *Web. P. C.* 201; 9 *Moore P. C. C.* 378.)

STEAD *v.* CAREY. (1 *C. B.* 496; 9 *Jur.* 511; 14 *L. J. C. P.* 177.)

**Consideration of Grant.** See Grant, Consideration of, p. 149.

**Consolidation.** See Practice, Consolidation, p. 293.

**Construction.** See Specification, Construction, p. 460.

**Constructive use.** See Infringement, pp. 183, *seq.*

**Contrivance.** Application of an old. See Subject-matter, p. 522.

**Co-owners.** See Joint Owners, pp. 206 to 209.

**Copies.** See Certified Copies, p. 75.

**Corporation.** See under Company, p. 76.

**Correction.** See Amendment, pp. 8 to 30.

**Costs.** See Practice, Costs, pp. 382 to 395.

## **Court.**

PATENTS ACT, 1833, sect. 117. In and for the purposes of this Act, unless the context otherwise requires, "The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England.

## **Crown,**

effect of patent against, Patents Act, 1883, sect. 27, p. 79  
prerogative of, Patents Act, 1883, sect. 116, p. 79  
private contractors not servants of, p. 80 (o).

PATENTS ACT, 1883, sect. 27. (1.) A patent shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject.

(2.) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

[But these provisions are not to affect any patent granted before the commencement of the Act or on an application then pending (see p. 94).]

Sect. 116. Nothing in the Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding a grant thereof.

(m) **FEATHER v. THE QUEEN.** [1865]

Formerly the Crown might use a patented invention without the assent or remuneration of the patentee. (8 B. & S. 257.)

(n) **CALDWELL v. VANVLISSENGEN.** [1851]

The Crown has always exercised a control over the trade of the country; and though restrained by the common law and the

Statute of Monopolies (21 Jac. 1 ch. 3) within reasonable limits, the Crown might grant the exclusive right to trade with a new invention for a limited period. (9 *Hare*, 415, 16 *Jur.* 115, 21 *L. J. Ch.* 97.)

(o) *DIXON v. THE LONDON SMALL ARMS COMPANY.* [1877]

A patent was granted for an improvement in the manufacture of fire-arms. The Secretary for War issued a notice for a tender for the supply of 13,875 rifles of the description known as that patented, the War Office supplying the steel barrels and the stocks. The rifles might be inspected during manufacture and might be rejected by officers at the War Office if not made according to pattern or not delivered in time. The contractors employed the patented process in the formation and insertion of the lock:—*Held*, that they were not servants or agents of the Crown doing the work of the Crown, but were private contractors to supply a certain manufactured article and were liable for infringement. (*L. R. 1 App. C.* 632.)

**Damages.** See under Practice, Damages, p. 373.

### Date of Patent,

- to be date of application, Patents Act, 1883, sect. 13, p. 80
- in case of revocation on ground of fraud, Patents Act, 1883, sect. 26, p. 402
- in case of invention patented abroad, sect. 103, Patents Act, 1883, amended by Patents Act, 1885, sect. 6, p. 61
- of patents separated by amendment, Rule 19, p. 37
- of extended grant may be after expiration of original patent, p. 133 (*f*).

PATENTS ACT, 1883, sect. 13. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

(p) *RUSSEL v. LEDSAM.* [1845]

Original letters patent for a term of fourteen years were dated on the 26th of February 1825, and renewed letters patent were dated on the 26th of February 1839:—*Held*, that the day of the date must be reckoned inclusively, and that the former term expired on the 25th of February 1839, and consequently the renewed letters patent were granted after the original letters patent had expired. Renewed letters patent, granted under 5 & 6 Will. 4, c. 83, s. 4, are not void if dated after the expiration of the term for which the original letters patent were granted, but may be granted by the Crown after the expiration of that term, provided the preliminary steps which the fourth section of the Act requires to be taken by the patentee were complied with before that term ended. See 2 & 3 Vict. c. 67. (14 *M. & W.* 574; 14 *L. J., Exch.* 353; affirmed in *Exch. Ch.*, 16 *M. & W.* 633; and in House of Lords, 1 *H. L. Cas.* 687.)

(q) *WILLIAMS v. NASH.* [1859]

The day of the date of the letters patent is excluded, and the three years do not expire until 12 o'clock at night of the anniversary of the day on which the letters patent are granted. (5 *Jur. N. S.* 696; 28 *L. J. Ch.* 886; 28 *Beav.* 93.)

(r) *Ex parte BAILEY.* [1872]

B. applied for a patent and obtained provisional protection on the 30th of March; C. on the 3rd of April. B. applied for the great seal on the 21st of May; C. obtained letters patent on the 22nd of May, antedated, according to the usual practice, to the 3rd of April. The patents appearing to be partially for the same invention:—*Held*, that whether the conduct of C. had or had not been fraudulent, the letters patent granted to B. must bear date on the 21st of May, and not on the 30th of March. (*L. R.* 8 *Ch.* 60; 42 *L. J.* 264.)

### Death of Inventor.

PATENTS ACT, 1883, sect. 12, sub-sect. 3 (b). If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the applicant.

[The fifteen months referred to runs from the date of application. See p. 557.]

Sect. 34. (1) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

### Declaration.

PATENTS ACT, 1883, sect. 5, sub-sect. (2). An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or, in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

48 & 49 Vict. ch. 63, sect. 2. Whereas sub-sect. 2 of sect. 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-sect. mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that:

The declaration mentioned in sub-sect. 2 of sect. 5 of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

PATENTS ACT, 1883, sect. 99. If any person is, by reason of infancy lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any

other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

### Dedication,

none by abandoned provisional specification until end of provisional protection, pp. 248 (*y*), 258 (*r*)  
 none by *bonâ fide* experiment although used in carrying out contract, p. 237 (*p*)  
 nor by disclosure to persons under obligation to keep it secret, pp. 242 (*d*), 263 (*i*)  
 unless made for purpose of using invention, p. 243 (*h*)  
 by disclosure to public official although confidential, p. 254 (*i*).

**Default** in payment of fees. See p. 559.

**Definitions.** See under the various heads.

### Delay,

in enrolling specification, pp. 58, 59  
 in applying for great seal, p. 60 (*o*)  
 in application for letters patent, pp. 58, 59  
 in entering opposition to sealing, p. 41 (*n*) (*o*)  
 in filing affidavits on opposition to sealing, p. 41 (*n*)  
 in application for injunction, pp. 346 to 349  
 in using invention, does not prove inutility, pp. 575 (*n*), 577 (*x*)  
 in filing accounts on petition for extension, p. 126 (*z*)  
 in establishing plaintiff's title in suit, p. 337 (*p*)  
 a ground for refusing to decree an account, p. 348 (*n*)  
 caused by appeal to law officer, p. 82.

PATENTS ACT, 1883, sect. 12, sub-sect. 3 (*a*). Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

**Delivering up Articles.** See Destruction, p. 82.

### Destroyed Patent.

PATENTS ACT, 1883, sect. 37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

The form of application for a duplicate is Form N in Schedule II.

The fee for a duplicate is £2. See p. 143.

**Destruction of Property** made in infringement of patent.

(*t*) *VAVASSEUR v. KRUPP*. [1878]

There is a right of property in the infringer in an article made in infringement of a patent, although the Court may order the article to be destroyed. (*L. R.*, 9 *Ch. D.* 351.)

Cotton, L.J.: "The property in articles which are made in violation of a patent is, notwithstanding the privilege of the patentee, in the infringer, if he would otherwise have the property in them. The Court, in a suit to restrain the infringement of a patent, does not proceed on the footing that the defendant proved



to have infringed has no property in the articles; but, assuming the property to be in him, it prevents the use of those articles, either by removing that which constitutes the infringement, or by ordering, if necessary, a destruction of the articles so as to prevent them from being used in derogation of the plaintiff's rights, and does this as the most effectual mode of protecting the plaintiff's rights—not on the footing that there is no property in the defendant. The Court cannot proceed to give that relief, and interfere with the articles, unless it has before it the person entitled to the articles in question, and has, as against this person, power to adjudicate that the articles are made or used in infringement of the plaintiff's rights." (*Ib.* 360.)

**Directions**, comptroller may ask for.

PATENTS ACT, 1883, sect. 95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

### Directors

personally responsible for infringement, p. 83 (*u*)  
form of order against, p. 83 (*v*).

(*u*) BETTS *v.* DE VITRE. [1868]

The directors of a company are personally responsible for the infringement of a patent by their workmen, notwithstanding such infringement may be in contravention of orders. (*L. R.* 3 *Ch.* 441; 37 *L. J.*, *Ch.* 325; 16 *W. R.* 529.)

The directors, acting as agents of the company, had infringed the patent, and a decree had been made against the directors as well as the company, and it had been held that the directors were personally liable to pay the costs. (11 *Jur. N. S.* 9.)

(*v*) SPENCER *v.* THE ANCOATS VALE RUBBER COMPANY. [1888]

It having been found that the defendant company had committed breaches of an injunction to which they had consented, a sequestration was directed in case the company did not comply, with the order with costs on the higher scale, the order to be against the directors as well as the company, but not to be enforced against the directors, except in case of default in payment by the company. (*T. L. Rep.* 4, 681.)

**Disclaimer.** See Amendment, pp. 8 to 28.

**Discoveries**, effect of new.

(*w*) CROSSLEY *v.* BEVERLEY. [1829]

A patent is not vitiated by reason of the specification not applying to matters of subsequent discovery. The terms of the specification must be interpreted according to the state of knowledge at the time. The patentee must be understood to mean things that were in use, and not things which, from being too expensive, were never expected to be used. (1 *Web. P. C.* 106.)

**Discovery.** See Practice, pp. 318 to 324.

**Discovery** disclosed in confidence.

SMITH *v.* DICKINSON. [1804]

Action on an agreement by the defendant not to avail himself of a communication made to him by the plaintiff of an invention for which he the plaintiff intended to take out a patent. Breach, that the defendant fraudulently patented the invention in his own name:—*Held*, that the plaintiff could recover damages. (3 B. & P. 630.)

### Discretion of Comptroller.

PATENTS ACT, 1883, sect. 94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

**Discretion of Judge** as to terms imposed under sect. 19 of the Patents Act, 1883. See p. 22 (*i*).

### Documents.

PATENT RULES, 1890 (10). All documents and copies of documents, except statutory declarations and affidavits, sent to or left at the Patent Office or otherwise furnished to the comptroller or to the Board of Trade shall be written or printed in large and legible characters in the English language upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of 2 inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the comptroller.

[Any document required to be left, made or given at the Patent Office, or to the comptroller, or to any other person under the Rules, may be sent by a prepaid letter through the post. (See under Post, p. 279.)]

### Drawings.

Patents Act, 1883, sect. 5, sub-sect. (3), (4): Amending Act, 1886, sect. 2, p. 84

Patent Rules, 1890: 30 to 33, pp. 84, 85

used to refresh memory of witness, p. 86 (*y*)

effect of, annexed to specification, pp. 485 to 487

added to specification after filing, p. 25 (*y*)

PATENTS ACT, 1883, sect. 5, sub-sect. (3). A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required.

Sub-sect. (4). A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

PATENTS ACT, 1886, sect. 2. The requirement of sub-sect. 4 of sect. 5 of the Patents Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings but referred to those which accompanied the provisional specification.

**PATENT RULES, 1890.**—Rule 30. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but if drawings are furnished, they should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 33. No drawing or sketch such as requires a special engraving for letter-press should appear in the specification itself.

Rule 31. Drawings (if any) must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

They must be made on pure white, hot-pressed, rolled, or calendered drawing paper of smooth surface and good quality, and where possible without colour or Indian-ink washes.

They must be on sheets of one of the two following sizes (the smaller being preferable), 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be  $\frac{1}{2}$  an inch wide. If there are more figures than can be shown on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is inserted in illustration of this requirement. Reference figures and letters must be bold, distinct, not less than  $\frac{1}{8}$  of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shown outside the figure, and connected with the part referred to by a fine line.

The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, &c.; need be shown as effects this purpose. When the scale is shown on the drawing it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner*; the number of sheets of drawings sent, and the number of each sheet in the *right-hand top corner*; and the signature of the applicant or his agent in the *right-hand bottom corner*.

No written description of the invention should appear on the drawings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photolithography.

Rule 32. A *facsimile* of the original drawings, but *without* colour or Indian-ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 31, must accompany the originals, and be marked "true copy."

Rule 33. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those "left with the provisional specification."

(x) **BOULTON v. BULL.** [1795]

Formerly it was not necessary for the patentee to use drawings, provided he so described the improvement as to enable artists to adopt it when his monopoly expired. (2 H. Bl. 479.)

*Drawings used to refresh memory of Witness.**(y)* R. v. HADDEN. [1826]

In proving that a machine is not new you may show a witness who had constructed a machine for the same purposes a drawing not made by himself, and ask him whether he has such a recollection of the machine he made as to be able to say that that is a correct drawing of it. (2 *C. & P.* 184.)

**Duplicate.** See Destroyed Patent, 82.

Duplicate documents shall at any time be left if required by the Comptroller. See p. 84.

**Duration.** See Time, p. 556

Extension of Term, p. 95.

15 & 16 Vict. c. 83, sect. 25, provided that a patent, obtained here for an invention first invented in a foreign country or by a foreigner, which had already been patented abroad, should cease on the expiration of the foreign patent. This is now repealed by 46 & 47 Vict. ch. 57, s. 113.

**Enlargement of Time.** See under Time, Patents Act, 1883, sect. 17, p. 559.

**Equity.** See Practice.

**Equivalents.** See Infringement, equivalent, pp. 183-202

if not known at date of patent, are not included in specification, p. 481 (*n*)

**Errors,**

verbal, in specification, p. 461 (*m*)

clerical, amendment of, in specification, pp. 28, 29

in memorandum of alteration, p. 29 (*q*)

in enrolment of patent, pp. 29 (*q*), 30 (*s*)

of specification, p. 29 (*n*)

in specification, correction of, by workmen, p. 484 (*x*), 430 (*t*)

in drawings, p. 430 (*t*)

**Estoppel,**

in actions, by patentee against licensee where licence is exclusive, pp. 90 (*i*), 211 (*u*)

where licence is *not* exclusive, pp. 87 (*b*), 89 (*h*), 90 (*i*) (*j*) (*l*), 91 (*o*)

where use of and payments under licence have ceased, pp. 88 (*d*), 91 (*r*)

where patent held invalid in proceedings between patentee and third party, p. 90 (*m*)

by assignee against patentee, pp. 87 (*z*), 90 (*k*)

by patentee against equitable assignee of sole licensee, p. 89 (*f*)

of no avail where plaintiff fraudulently claims right to patent, p. 87 (*a*)

as to use or non-use of licence under agreement, p. 88 (*d*)

under special agreement, p. 89 (*g*)

not established by award of arbitrator, p. 90 (*n*)

construction of specification independent of, p. 91 (*p*)

between partners, pp. 91 (*q*) (*t*), 338 (*s*)

by judgment at law need not affect defendants in equity, p. 91 (*s*)

effect of previous decisions as to same patent, p. 92 (*x*)

## (z) OLDHAM v. LANGMEAD. [Before 1789]

In an action by the assignee of the patentee against the patentee, the latter is estopped from showing that it was not a new invention against his own deed. (Cit. in *Hayne v. Maltby*, 3 T. R. 439.)

Lord Kenyon, C.J.: "The patentee has conveyed his interest in the patent to the plaintiff, and yet in violation of his contract he afterwards infringed the plaintiff's right, and then attempted to deny his having had any title to convey; but I was of opinion that he was estopped by his own deed from making that defence." (*Ib.* 441.)

## (a) HAYNE v. MALTBY. [1789]

A., fraudulently asserting that he had a right to a patent machine, covenanted with B. that he should use it in a particular manner, in consideration of which B. covenanted that he would not use any other; in an action by A. on the covenant, B. is not estopped by his covenant from pleading in bar to the action that the invention was not new, or that the patentee was not the inventor; but he may thus show that the patent was void. (3 T. R. 438; *Dav. P. C.* 156.)

## (b) BOWMAN v. TAYLOR. [1834]

Where a licence to use certain patent machines is granted by indenture, in which it is recited that the grantor has invented the machines, and has obtained letters patent for the sole use of the invention, and enrolled the specification, parties to the deed are estopped from pleading, either that the invention is not a new invention, or that the grantor was not the first inventor, or that no specification was enrolled. (4 N. & M. 264; 2 A. & E. 278.)

## (c) NEILSON v. FOTHERGILL. Ch. [1841]

Lord Cottenham, L.C.: "The case of *Hayne v. Maltby* appears to me to come to this—that although a party has dealt with the patentee and has carried on business, yet that he may stop, and then the party who claims to be patentee cannot recover without giving the other party the opportunity of disputing his right, and that if the defendant successfully dispute his right, that notwithstanding he has been dealing under a contract, it is competent to the defendant so to do. That is exactly coming to the point which I put, whether, at law, the party was estopped from disputing the patentee's right, after having once dealt with him as the proprietor of that right; and it appears from the authority of that case, and from the other cases, that from the time of the last payment, if the manufacturer can successfully resist the patent right of the party claiming the rent, that he may do so in answer to an action for the rent for the use of the patent during that year." (1 Web. P. C. 290.)

*(d) BAIRD v. NEILSON.* H. L. [1842]

N. obtained a patent for the application of the principle of smelting iron by the use of heated air applied to furnaces. B. obtained a licence from him to use this process, on the payment of 1s. per ton on the iron thus smelted. Disputes, and then litigation, arose between them, and it was agreed by an instrument in writing, dated 11th of November, 1833 (which recited the previous circumstances), that both parties should withdraw their law processes; that,—“in consideration of the present payment of £400 to be accepted by N. in full of 1s. per ton on the whole iron smelted from the erection of B.’s works up to the 11th of November current, and in consideration of the payment of 1s. per ton upon the whole iron which shall be smelted from the 11th of November current until the expiry of the letters patent, by the use of heated air in any of the modes heretofore applied, or in any other mode falling under the said patent,”—N. should grant to B. a licence, which further on in the agreement was described to relate to “the application or use of heated air in any of the modes heretofore practised at B.’s works, or in any other mode falling under the description in the said patent, or in the specification thereof.” N. afterwards instituted a suit to compel B. to perform this agreement. B. instituted a cross suit to suspend N.’s proceedings, on the ground that the process of smelting by heated air, used at B.’s works, did not fall within the patent:—*Held*, by the Lords, affirming the decree of the Court of Sessions, that, after this agreement, B. could not set up such a defence to the claim of N. (8 C. & F. 726.)

*(e) CUTLER v. BOWER.* [1848]

By an indenture reciting a deed, whereby the plaintiff licensed the defendant to use his patent during a term, paying a certain royalty, plaintiff, in consideration of £2200 to be paid to him by defendant, assigned the patent to a trustee, subject to the previous indenture, and in trust to apply the sums accruing from licences and the royalties, for or under the direction of plaintiff and defendant respectively, in specified proportions, and to stand possessed, as to one moiety of the letters patent, for plaintiff, as to the other, for defendant. Plaintiff covenanted that, for and notwithstanding anything done, &c., by him, the patent was valid, and defendant covenanted with plaintiff to pay him the £2200 by instalments. To a declaration for non-payment of such instalments, defendant pleaded that plaintiff was not the first inventor; by reason whereof the patent, before the supposed breach of covenant, was void. Replication, estoppel:—*Held*, on general demurrer, that the plea was bad. For,

1. Even if the patent was void, the first executed deed would have bound the defendant, by estoppel, to payment of the royalty; and, by the latter deed, he became entitled to half the royalty.

2. The covenant to pay the £2200 was an independent covenant,

and capable of being enforced whether the plaintiff's covenants were performed or not. (11 *Q. B.* 973; 17 *L. J.*, *Q. B.* 217; 12 *Jur.* 721.)

(f) *PIDDING v. FRANKS.* [1849]

Where the court directed an action, instead of granting an injunction, against the equitable assignee of the sole licensee of a patent, it did not exact from the defendant any admission as to the validity of the patent. (1 *Mac. & G.* 56.)

(g) *HILLS v. LAMING.* [1853]

By articles of agreement under seal, reciting that letters patent had been granted to the defendant for improvements in purifying gas, and other letters patent had been granted to the plaintiff for an improved mode of manufacturing gas, and that disputes had arisen between the parties as to their respective rights under the letters patent to the use of oxides of iron for the purpose of purifying gas, and that a *scire facias* had been sued out by the plaintiff to repeal the patent granted to the defendant, and that other patents had been applied for, it was agreed, that the defendant should have the exclusive use of the inventions granted to the plaintiff, so far as the same related to the purification of gas by the hydrated oxides of iron, paying certain royalties; that the plaintiff should have the exclusive use of the inventions granted to the defendant, so far as the same related to the purification of gas by anhydrous oxides of iron, paying certain royalties; that, for the purpose of that agreement and the determination of the amount of royalties it should be assumed that the defendant was entitled to the exclusive use of anhydrous oxides, and the plaintiff entitled to the exclusive use of hydrous oxides. The agreement also provided in case of breach of certain stipulations, for payment of a certain sum as liquidated damages. In an action to recover that sum the defendant pleaded the plaintiff's patents were not valid, that the inventions were not new, and that the plaintiff was not the first inventor:—*Held*, that the pleas were bad, inasmuch as the defendant was estopped by the agreement from disputing the validity of the patents. (9 *Exch.* 256; 23 *L. J.*, *Exch.* 60.)

(h) *LAWES v. PURSER.* [1856]

Declaration for money payable by the defendant to the plaintiff, due by agreement, in respect of manure manufactured or sold by the defendant pursuant to the plaintiff's permission, by the use of an invention mentioned in letters patent granted to the plaintiff. Plea, that at the time of the agreement, and since, the letters patent were void; that the defendant was, before and at the time of the agreement, entitled as of right, and without permission of the plaintiff, to use the invention and sell the manure; and there was not any consideration for the agreement:—*Held*, that the declaration was upon an executed consideration, and that the plea was no answer. (6 *Ell. & B.* 930; 3 *Jur.*, *N. S.*, 182; 26 *L. J.*, *Q. B.* 25.)

## (i) BESSEMAN v. WRIGHT. [1858]

To an action by a patentee upon a licence for the use of his patent, the licensee may not plead that the patent is void for want of utility or novelty, the contract between them not being for the exclusive use of the patent. Compton, J., said: "I had doubts whether I was right at chambers when I refused leave to add this plea, but now I am satisfied that I was right. In *Chanter v. Leese* the bargain was for an exclusive right, which could not be given; but here the plaintiff only says, as against me you may use this patent; but he says nothing as against the rest of the world." (6 W. R. 719.)

## (j) SMITH v. SCOTT. [1859]

To a declaration by a patentee against a licensee by deed, the defendant is estopped to plead that the said invention was worthless and of no public utility, and was not new as to the public use thereof in England, and that the plaintiff is not the first inventor; and that the defendant never got any benefit under the deed in regard to the said invention, and, at the time of the making of the deed the plaintiff knew the matters aforesaid and the defendant did not, nor is the plea good as a plea of fraud. (6 C. B., N. S., 771; 5 Jur., N. S., 1356; 28 L. J., C. P. 325.)

## (k) WALTON v. LAVATER. [1860]

Where, in an action for infringement, the plaintiff is the assignee of a patent taken out by the defendant, the latter is estopped from denying the novelty of the patent. (3 L. T., Rep., N. S., 272.)

## (l) NOTON v. BROOKS. [1861]

If a patentee, in consideration of a royalty, grants to another a licence to use the patent invention, and the latter uses it, he cannot plead, as a defence to an action for the royalty, that the invention was not new, or that the patentee was not the first inventor. (7 H. & N. 499; 8 Jur., N. S., 155; 10 W. R. 111.)

## (m) THE GROVER &amp; BAKER SEWING MACHINE CO. v. MILLARD Ch. [1862]

The fact of a patent having been found invalid at law, upon proceedings between the patentee and third parties, is no answer to a suit, based upon the same patent, for an injunction and consequent relief against a licensee who has covenanted to pay royalties, and is selling the invention, contrary to his covenant, without payment of the royalties. (8 Jur., N. S., 714.)

## (n) NEWALL v. ELLIOTT. [1863]

In an action for the infringement of a patent, the plaintiff, to a plea that he was not the first and true inventor, replied, that on another charge by the plaintiff against the defendant of infringement of the same patent, the question was referred to arbitration by consent, and the arbitrator found that the letters patent were



not illegal and void:—*Held*, that the record did not show an estoppel. (9 *Jur.*, *N. S.*, 359.)

(o) *CROSSLEY v. DIXON*. Ch. [1863]

While a person is using, under a licence, a patent machine and paying a royalty for its use, or the use of its principle embodied in any other machine, he cannot, in a proceeding against him for non-payment of royalties in respect of the use of another machine alleged to embody the principle of the patent invention, set up as a defence that the patent is not valid. He can only be allowed to contend that the second machine does not embody the principle of the patent. (10 *H. L. Cas.* 293; 9 *Jur.*, *N. S.*, 607; 32 *L. J. Ch.* 617; 11 *W. R.* 716; 8 *L. T. Rep.*, *N. S.*, 260.)

(p) *TROTMAN v. WOOD*. [1864]

One who makes a patent article under a licence from the inventor, cannot, in an action against him for royalties, set up any objection to the novelty or utility of the invention, or the validity of the specification; but, if the claim in the specification is susceptible of two constructions, one of which would make the specification bad, and the other and more natural one would make it good, it is competent to him to insist that the latter is the true construction. (16 *C. B.*, *N. S.*, 479.)

(q) *CHAMBERS v. CRICHEY*. Ch. [1864]

Upon the dissolution of a partnership between the plaintiffs and the defendant, the defendant assigned to the plaintiffs all his interest in a patent which formed part of the assets:—*Held*, that the defendant could not afterwards set up the invalidity of the patent as against the plaintiffs. (33 *Beav.* 374.)

(r) *DANGERFIELD v. JONES*. Ch. [1865]

A licensee, on a bill for an injunction to restrain the infringement of a patent, may, after his licence has been determined, dispute the validity of the patent. (13 *L. T. Rep.*, *N. S.*, 142.)

(s) *GOUCHER v. CLAYTON*. Ch. [1865]

Judgment was given by consent before declaration filed in an action by a patentee against the members of a partnership firm for an infringement, and the defendants immediately took a licence to use the invention. A suit to restrain a subsequent alleged infringement having been brought by the patentee against the defendants at law and two fresh partners:—*Held*, that the defendants in equity were not estopped by the judgment at law from disputing the validity of the patent. (11 *Jur.*, *N. S.*, 107; 34 *L. J.*, *Ch.* 239; 13 *W. R.* 336; 11 *L. T. Rep.*, *N. S.*, 732.)

(t) *AXMANN v. LUND*. Ch. [1874]

The plaintiff and defendant had worked in partnership an alleged patent, the property of the defendant:—*Held*, that the plaintiff by so doing had not debarred himself from disputing

the patent after the termination of the partnership. (*L. R.* 18 *Eq.* 330; 22 *W. R.* 789.)

(*u*) *HEUGH v. CHAMBERLAIN.* [1877]

The rule that an assignor of a patent is estopped from disputing its validity, does not prevent his partner from raising that defence in a separate statement of defence to an action for infringement. (25 *W. R.* 742.)

(*v*) *CROPPER v. SMITH.* H. of L. [1885]

The defendant Hancock, who had taken out a patent for improvements in lace machines, went into liquidation, and his patent was assigned by his trustee to the plaintiff. Subsequently Hancock took out another patent for improvements in lace machines, and went into partnership with Smith, the defendant, to work it. In an action for infringement, Hancock set up that the first patent was invalid on the ground of (*inter alia*) want of novelty:—*Held*, that he was not estopped from disputing the validity of the patent, either by matter of record, on the ground that the letters patent were of record, or by deed, by reason of the specification being by deed, or by matter *in pais*, on the ground of the statements in his petition to the Crown, there being nothing to show that the plaintiffs bought on the faith of those statements. (26 *Ch. D.* 700; 10 *App. C.* 249.)

If a patentee becomes bankrupt and his trustee in bankruptcy assigns the patent, the patentee is not estopped from afterwards denying the validity of the patent as against the assignee. (10 *App. C.* 249.)

(*w*) *PROCTOR v. BENNIS.* C. A. [1887]

In an action for infringement by the plaintiff as patentee against Bennis and other defendants, who had purchased the machines alleged to be infringements from Bennis, it appeared that before such purchases the plaintiff had gone to the other defendants and asked them to try his machine, saying that they would find it better than Bennis's, without giving any intimation that he considered Bennis's machine to be an infringement of his, although he admitted that he considered it to be so, and intended to take proceedings when he was in funds:—*Held*, that the plaintiff had not by acquiescence or estoppel lost his right to sue, it not being the duty of a patentee to warn persons that what they are doing is an infringement, and plaintiff's conduct not amounting to a representation that it was not an infringement. (36 *Ch. D.* 740.)

(*x*) *EDISON & SWAN ELECTRIC LIGHT COMPANY v. HOLLAND.* C.A. [1889]

Where a patent has already been before the Court, the former decision, so far as it decides the construction of the patent (*e.g.*, that the invention claimed was a combination of any carbonised filament, with any receiver of glass through which leading wires

pass and from which the air is exhausted), must be followed; but whether the claim is too wide or proper subject matter, and whether the invention is useful and novel, are questions depending partly on fact, and must be decided *de novo*. (6 O. R. 243.)

(y) THOMSON v. MOORE. [1889]

A defendant, who in an action for infringement has consented to a perpetual injunction, restraining him from infringing and to pay damages, is estopped from questioning either the validity of the patent or the fact of the previous infringement. (6 O. R. 426.)

**Evasion.** See Infringement, Colourable Evasion, p. 183, *seq.*

**Evidence.** See Practice, Evidence, pp. 358 to 367.

**Exclusive Licence.**

immaterial in how many persons vested, p. 211 (*t*)  
or what is the extent of, p. 211 (*t*).

**Exclusive Licensee.**

has a right to sue for infringements, p. 288 (*w*)  
may use patentee's name to restrain infringement, p. 288 (*w*)  
estoppel in actions by patentee against, pp. 90 (*x*), 211 (*u*).

**Executor.**

of assignee may petition for extension, p. 101 (*k*).

**Exhibition.**

PATENTS ACT, 1883. Sect. 39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

- (a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and
- (b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

PATENTS ACT, 1886. Sect. 3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the Comptroller the prescribed notice of his intention to do so:

And whereas it is expedient to provide for the extension of the said sections

to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

**PATENT RULES, 1890.** 15. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the comptroller notice in writing of his intention to exhibit, publish, or use the invention, as the case may be.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made the applicant shall furnish to the comptroller a brief description of his invention, accompanied, if necessary, by drawings, and such other information as the comptroller may in each case require.

### Existing Patents.

**PATENTS ACT, 1883.** Sect. 45. (1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licences.

(3.) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

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(z) **MUNTZ v. FOSTER.** N.P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottom of ships." The patentee described his invention as consisting in making the said plates of an "alloy of foreign zinc," and of "best selected copper;" the metals being melted together in certain stated proportions. Tindal, C.J., told the jury that if the

defendant had "actually made any small experiment for the purpose of ascertaining what the proportions or properties of the different alloys would come to, that would scarcely have been said to be a making in violation of the patent." (2 *Web. P. C.* 101.)

(a) *FREARSON v. LOE.* [1878]

If a man makes things merely by way of *bond fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose for which a patent has been granted, but with the view of improving upon the subject of the patent, or with the view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. (*L. R.*, 9 *Ch. D.* 66.)

(b) *UNITED TELEPHONE COMPANY v. SHARPLES.* [1885]

The defendant bought telephones abroad and imported them for the purpose of allowing his pupils to experiment upon them, in order to avoid using similar but more costly instruments which had paid royalty:—*Held*, that this was a user for the purpose of advantage, and was an infringement. (*Griff. p.* 232.)

(c) *BADISCHE ANILIN UND SODA FABRIK v. LEVINSTEIN.* [1883 to 1886]

An independent chemist was appointed by the Court to perform the process as described in the specification, by way of experiment. The chemist was to state the result, and in case of difficulty was to receive instructions from the Judge personally. Each party to be at liberty to name two chemists, of whom the Judge would choose one on each side, to be present at the experiment. (*W. N.*, 1883, 62.)

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*Presentation of Petition.*

PATENTS ACT, 1883, Sect. 25, (1) A patentee may, after advertising in manner directed by any rules made under this Section his intention to do so, present a petition to Her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent.

Sect. 25, (6). It shall be lawful for Her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

The following rules are still in force:—

*Rules to be observed in Proceedings before the Right Honourable the Lords of the Judicial Committee of the Privy Council under the Act of the 5th and 6th William IV., intituled “An Act to amend the Law touching Letters Patent for Inventions,” cap. 83.*

Rule I.—A Party intending to apply by petition, under section 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the County where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition His Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the Council Office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

Rule II.—A party intending to apply by petition, under section 4 of the



said Act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day *caveats* must be entered; and any person intending to enter a *caveat* shall enter the same at the Council Office, on or before such day so named in the said advertisements; and having entered such *caveat*, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

Rule III.—Petitions under sections 2 and 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

Rule IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 4 of the said Act and the 1st and 2nd of these Rules and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the Petitions.

Rule V.—All persons entering *caveats* under sect. 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under sect. 2 of the said Act, and all persons lodging notices of opposition under the 1st of these Rules, shall respectively be intitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

Rule VI.—All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

Rule VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

Rule VIII.—The registrar of the Privy Council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

Rule IX.—A party applying for an extension of a patent, under sect. 4 of the said Act, must lodge at the Council Office six printed copies of the specification, and also four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this rule must be lodged not less than one week before the day fixed for hearing the application.

The Judicial Committee will hear the Attorney-General, or other counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th sect. of the said Act, in case it shall be thought fit to oppose the same on such behalf.

5 & 6 Will. IV., ch. 83, is repealed by the Patents Act, 1883, Sect. 113. Sect. 2, referred to in Rule 1, related to the mode of proceeding where the patentee was proved not to be the real inventor though he believed himself to be so; this section has not been replaced by any enactment giving a similar power of confirmation, and is therefore omitted.

Sect. 4 is inserted for the purpose of explaining the rules only and is as follows :—

If any Person who now hath or shall hereafter obtain any Letters Patent as aforesaid shall advertise in the *London Gazette* Three Times, and in Three

London Papers, and three times in some Country Paper published in the town where or near to which he carried on any manufacture of anything made according to his Specification, or near to or in which he resides in case he carried on no such Manufacture or published in the County where he carries on such Manufacture or where he lives in case there shall not be any paper published in such Town, that he intends to apply to His Majesty in Council for a Prolongation of his Term of sole using and vending his Invention, and shall petition His Majesty in Council to that Effect, it shall be lawful for any person to enter a Caveat at the Council Office; and if His Majesty shall refer the consideration of such Petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any Person or Persons who shall have entered such Caveats, the Petitioner shall be heard by his Counsel and Witnesses to prove his Case, and the Persons entering Caveats shall likewise be heard by their Counsel and Witnesses; whereupon, and upon hearing and inquiring of the whole Matter, the Judicial Committee may report to His Majesty that a further Extension of the Term in the said Letters Patent should be granted not exceeding Seven Years; and His Majesty is hereby authorised and empowered, if He shall think fit, to grant new Letters Patent for the said Invention for a Term not exceeding Seven Years after the expiration of the first Term, any Law, Custom, or Usage to the contrary in anywise notwithstanding: Provided that no such Extension shall be granted if the Application by Petition shall not be made and prosecuted with Effect before the Expiration of the Term originally granted in such Letters Patent.

The last proviso was repealed by 2 & 3 Vic. ch. 67, and the remainder of the section was repealed as mentioned above.

### *The Petitioner.*

(d) *In re* WRIGHT'S PATENT, *Ex parte* SHUTTLEWORTH. [1837]

Extension recommended in favour of the parties having the legal estate, without imposing any conditions with reference to the equitable claim of other parties connected with the patentee. (1 *Web. P. C.* 561.)

In an application for extension by an assignee, the title of the petitioner must be strictly proved, although no notice of intention to dispute the title is contained in the objections. (*Ib.*)

(e) *In re* SOUTHWORTH'S PATENT. [1837]

The new letters patent must be granted to the party in whom the subsisting patent is legally vested. (1 *Web. P. C.* 487.)

(f) *In re* DOWNTON'S PATENT. [1839] *In re* HEATH'S PATENT. [1853]

An extension of a patent may be granted to the administratrix of the patentee. (1 *Web. P. C.* 565; 8 *Moo. P. C. C.* 217.)

(g) *In re* MORGAN'S PATENT. [1843]

Lord Brougham, in delivering judgment, said: "When applications are made to their Lordships for the extension of a patent term, that is to say, of a monopoly, under letters patent by assignees, to whom the interest of the patentee has been parted with, and in whom it is vested, their Lordships have always been used to consider, that by taking into their view and favourably listening to the application of the assignee, they are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated

at all, it might be said that the chance of the patentee ~~of making~~ an advantageous conveyance to the assignee would be materially diminished, and consequently, his interest damnified. For this reason, consideration has been given to the claims of the assignee who has an interest in the patent." (1 *Web. P. C.* 737.)

(h) *In re GALLOWAY'S PATENT.* [1843]

In an application by an assignee, his title must be strictly proved. (1 *Web. P. C.* 725.)

(i) *RUSSELL v. LEDSAM.* [1845]

The power of the Crown to extend letters patent is not confined to *grantees*, but extends to *assignees*, and such renewed letters patent, granted to the *assignee*, are good by the statute 5 & 6 Will. 4, c. 83, independently of the 7 & 8 Vict. c. 69. (14 *M & W.* 574; judgment affirmed in Exch. Ch., 16 *M & W.* 633; and in H. of L., 1 *H. L. Cas.* 687.)

(j) *In re HARDY'S PATENT.* [1849]

Extension of a patent granted to an assignee upon certain conditions. (See p. 137 (*w*).) (6 *Moo. P. C. C.* 441; 13 *Jur.* 177.)

(k) *In re BODMER'S PATENT.* [1849]

The extension of a patent may be granted, on petition, to the executor of the surviving assignee for valuable consideration of a patentee. (6 *Moo. P. C. C.* 469.)

(l) *In re BERRY'S PATENT.* [1850]

Extension of letters patent granted for six years, where the invention was of considerable commercial value, and the importers had embarked a large capital upon machinery in trying to introduce it to general use, and incurred considerable loss in so doing. (7 *Moo. P. C. C.* 187.)

The importer of an invention by the outlay of his capital benefits the public in the proportion of the value of the invention imported, and importation, therefore, is to be considered as a solid claim to the exercise of the power of extension. (*Ib.* 189.)

(m) *In re PETTIT SMITH'S PATENT.* [1850]

The person who has the legal estate in letters patent has the prior right to petition for an extension. In the present case the new letters patent were granted to the trustees of a joint-stock company, although the patentee joined in the petition. (7 *Moo. P. C. C.* 133.)

(n) *In re NOBLE'S PATENT.* [1850]

An equitable assignee is entitled to appear with the legal assignees of a patent, on a petition for a prolongation of the letters patent, if the name of such equitable assignee appears, with the other petitioners, in the advertisements required by sect. 4 of the statute 5 & 6 Will. 4, c. 83, and Rule 2, made in pursuance thereof. (7 *Moo. P. C. C.* 191.)

(o) *In re COOK & WHEATSTONE'S PATENT.* [1851]

*Semble*, a company may obtain a renewal of letters patent. Extension was in this case refused on the grounds of sufficient remuneration; Lord Langdale, however, said: "If the company's speculation had been clearly made out to be a losing concern, it would perhaps have been matter for consideration whether there was not good ground for renewal." (38 *Lond. Jour.* 223.) See Deacon's Patent, p. 127 (g).

(p) *In re CLARIDGE'S PATENT.* [1851]

The importer of an invention from abroad is an inventor within the meaning of the statute 5 & 6 Will. 4, c. 83, and entitled to apply for an extension of the term. But the Judicial Committee will look with jealousy into the merits of the invention imported.

Application for an extension by the trustees of a joint-stock company (the assignees of the patentee) refused; the invention imported having been in common use in *France*, and no great risk or expenditure incurred by the patentee or his assignees in introducing it to the public. (7 *Moo. P. C. C.* 394.)

Jervis, C. J., objected to the prolongation on the ground that the rule in granting letters patent is to limit the number of grantees to twelve. (*Ib.* 395.)

(q) *In re SCHLUMBERGER'S PATENT.* [1853]

An alien, resident abroad, who was interested in an English patent by a foreign inventor, and who had also considerable dealings in this country in respect of sales of the patented machine and in granting licenses for the use of such patent, held, in the circumstances, to have such a *locus standi* as to entitle him to petition the Crown to revoke an order in council for granting an extended term of an English patent, and to recall the warrant for sealing such patent. (9 *Moo. P. C. C.* 1.)

(r) *In re NAPIER'S PATENT.* [1861]

The Judicial Committee had power, under statute 7 & 8 Vict. c. 69, s. 4, to grant an extension of the term of letters patent to the assignee of the patentee (in this case a public company), when the patentee has ceased to have any connection with the working of the patent. (13 *Moo. P. C. C.* 543; 9 *W. R.* 390.)

(s) *In re NEWTON'S PATENT.* [1861]

Extension granted to a petitioner who had obtained the letters patent as agent and trustee for a foreign invention. (14 *Moo. P. C. C.* 156.)

(t) *In re BOVILL'S PATENT.* [1863]

The patentee had been involved in debt arising from extensive litigation in defending his patent rights, and had, moreover,

mortgaged his letters patent, and entered into a deed of arrangement or inspectorship under the Bankruptcy Act with his creditors. The petition was presented by the patentee, and certain mortgagees and others claiming liens on the letters patent. In the circumstances, their Lordships granted the extension of the patent to the patentee alone. (1 *Moo. P. C. C., N. S.*, 348.)

(u) *In re* NORTON'S PATENT. [1863]

Petition by assignee of patentee, who was dead, for prolongation of letters patent, dismissed by reason, (1) that the assignee had never taken any effectual steps to apply the invention to a useful and beneficial purpose; and (2) as the application for extension, though by the assignee, was in reality on behalf of a joint-stock company, who purchased the letters patent for the purpose of trading with it, and with others founded upon it, and not for any purpose by means of which any benefit can be derived by the original inventor. (1 *Moo. P. C. C., N. S.*, 339.)

The Master of the Rolls, in delivering judgment, said: "Under the late statute, 7 & 8 Vict. c. 69, s. 4, a person is not excluded from applying for an extension of a patent upon the ground of his being the assignee of the patent; but it must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use." (*Ib.* 344.)

(v) *In re* NORMAND'S PATENT. [1870]

An assignee of the patentee, who had taken an assignment of four-fifths of the patent within a few months of the expiration of a patent, which had only just been brought into use, for a small consideration, was not entitled to any extension. (6 *Moo. P. C. C., N. S.*, 477.)

(w) *In re* PITMAN'S PATENT. [1871]

Sir J. W. Colville, in delivering judgment, said: "There are, no doubt, cases in which their Lordships have granted applications by the assignees of the patentee for extension of the term, and have also considered, in some respects, the expenses incurred by the assignee in bringing the patent into notice, and for the merit, as it may be said, of the assignee in patronizing the patentee, and in pushing the patent into notice; but the general rule which their Lordships entertain in applications on the part of assignees, is, as was stated by Lord Brougham in *Morgan's Patent*." (8 *Moo. P. C. C., N. S.*, 297.)

(x) *In re* BRANDON'S PATENT. [1884]

The provisions of the Patents Act of 1883 do not affect any patent granted before the commencement of the Act, nor any right or privilege which had accrued to the patentee before or at the commencement of the Act, including the privilege of applying for a renewal. (9 *App. C.* 589; 53 *L. J. P. C.* 84; 1 *O. R.* 154; *Griff.* 255.)

## (y) CHURCH'S PATENT. [1886]

Objection being taken that the mortgagee of the patent was not a petitioner:—*Held*, that the mortgagee as legal owner ought to have been a party, but that the irregularity was not so serious as to be fatal at the further hearing, since if it had been discovered before the hearing it might have been set right. (*Griff.* 256; 3 *O. R.* 95.)

## (z) WILLACY'S PATENT. [1888]

The petition having been presented by the son of the patentee who had acquired an interest in the patent from L. who had worked the patent under a verbal agreement with the patentee up to his death:—*Held*, that the personal representative of the patentee and L. ought to be made parties. (5 *O. R.* 690.)

*The Petition.*(a) *In re* HUTCHINSON'S PATENT. [1861]

Material facts, showing the title of the petitioner, were disclosed in evidence, which were omitted to be stated in the petition for prolongation. In such circumstances the hearing was postponed, and the petition directed to be amended by stating those facts. (14 *Moo. P. C. C.* 364.)

(b) *In re* PITMAN'S PATENT. [1871]

As the recommendation to the Crown for the prolongation of the term of letters patent is a matter of discretion in the Judicial Committee, it is imperatively necessary that the petition for such prolongation should state fairly and fully everything relating to the patent: an omission to do so is fatal to the application.

Where the petition omitted to state that the patent was, in fact, a communication from a foreigner living abroad, who had previously to the English patent patented the same invention in *America*, and that the American patent had expired, though afterwards renewed in *America*, the Judicial Committee, in the circumstances, refused the application. (8 *Moo. P. C. C., N. S.*, 393.)

(c) *In re* JOHNSON'S PATENT. [1871]

A clear statement should be made, in the petition, of every matter applicable to the patent, the term of which it is desired should be extended. (*L. R.*, 4 *P. C.* 83.)

*Time to present Petition.*(d) *In re* MACKINTOSH'S PATENT. [1836]

A petition was lodged in January, 1836, for the prolongation of a patent which expired in June, 1837. Application postponed on the ground that the profits accruing in the meantime might materially affect the question of extension. (1 *Web. P. C.* 739.)

(e) *In re* BODMER'S PATENT. [1838—1840]

The original petition was dismissed, because it had not been prosecuted in time according to 5 & 6 Will. 4, c. 83, sect. 4; but the 5 & 6 Will. 4, c. 83, sect. 4, having been amended by the 2 & 3 Vict. sect. 67, their Lordships, upon a fresh petition, granted an extension of the letters patent for seven years, under that Act, on the ground that the invention was an ingenious one, and that it did not appear that the patentee had received any remuneration until within the three years previous to the expiration of the patent. (2 *Moo. P. C. C.* 471; 1 *Web. P. C.* 740.)

(f) *In re* KAY'S PATENT. [1839]

Letters patent being about to expire, an application for an extension will be heard during the pendency of legal proceedings as to the validity of the patent. (3 *Moo. P. C. C.* 24.)

(g) LEDSHAM *v.* RUSSELL. [1848] (H. L.)

An application for prolongation was "prosecuted with effect" within the terms of the statute if the applicant obtained the report of the Judicial Committee before the original patent expired. (1 *H. L. C.* 687.)

(h) *In re* HUTCHINSON'S PATENT. [1861]

Rule 3 of the Privy Council, made pursuant to the statute, 5 & 6 Will. 4, c. 83, relating to letters patent for inventions, provides that a petition under sections 2 and 4 of that statute, must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

A petitioner inserted the last advertisement of his intention to petition for a prolongation on the 24th of *May*, but did not present his petition until the 5th of *June* following. The registrar refused to receive the petition as being too late. Upon a special application for that purpose, it appearing that the delay arose from a mistake of the petitioner's agent, an order was made admitting the petition. (14 *Moo. P. C. C.* 364.)

*Jurisdiction of the Judicial Committee of the Privy Council.*(i) *In re* SCHLUMBERGER'S PATENT. [1853]

The Judicial Committee had, under the 4th sect. of 3 & 4 Will. 4, c. 41, jurisdiction to entertain a petition, referred to them by the Crown, seeking to revoke an order in council, made upon

their recommendation, upon an application by patentees for an extension of letters patent under the statute 5 & 6 Will. 4, c. 83, and to recall the warrant for sealing such letters patent. (9 *Moo. P. C. C.* 1.)

(j) *In re HONIBALL'S PATENT.* [1855]

The authority conferred upon the Crown, by 5 & 6 Will. 4, c. 83, s. 2, to confirm letters patent, was discretionary in the Judicial Committee, to recommend or not a confirmation. (9 *Moo. P. C. C.* 378.)

(k) *In re BETT'S PATENT.* [1862]

When a foreign and an English patent had been obtained for the same invention, and the foreign patent expired first, the Judicial Committee of the Privy Council had no jurisdiction to entertain an application of prolongation. See sect. 25 of 15 & 16 Vict. c. 83. (1 *Moo. P. C. C., N. S.*, 49; 9 *Jur., N. S.*, 137; 61 *W. R.* 221; 7 *L. T. Rep., N. S.*, 577.) (15 & 16 *Vict. ch.* 33, sect. 25 is now repealed by 46 & 47 *Vict., ch.* 57, sect. 113.)

(l) *In re GOUCHER'S PATENT.* [1865]

The power given to the Judicial Committee by statute 7 & 8 Vict. c. 69, s. 2 (enlarging statute 5 & 6 Will. 4, c. 83, s. 4), to recommend an extension of the term of letters patent for an invention, is exhausted, when an extension has been once recommended and new letters patent granted; and the Judicial Committee have no jurisdiction to entertain a petition for a further prolongation of the new letters patent. (2 *Moo. P. C. C., N. S.*, 532.)

*Advertisements.*

(m) *In re DEROSNE'S PATENT.* [1844]

When the patentee resides abroad, and the invention is carried on under licensees, the advertisements should be inserted in papers circulating in the places where the manufacture is actually carried on. (2 *Web. P. C.* 2; 4 *Moo. P. C. C.* 416.)

(n) *In re PERKIN'S PATENT.* [1845]

The advertisements should be proved before the case is heard. The advertisements having been inserted in London papers only, a witness was allowed to be called to prove that the patent apparatus was manufactured in London and not elsewhere. (2 *Web. P. C.* 8.)

(o) *In re NOBLE'S PATENT.* [1850]

To entitle an equitable assignee to appear with the legal assignee of a patent on a petition for a prolongation of the letters patent, the name of such equitable assignee must appear, with the other petitioner, in advertisements required by sect. 4 of the statute 5 & 6 Will. 4, c. 83, and Rule 2, made in pursuance thereof. (7 *Moo. P. C. C.* 191.)



Per Lord Brougham: If the statute requires anything to be done which is not done, the Crown has no power to grant a prolongation. (*Ib.* 194.)

*Caveats.*

PATENTS ACT, 1883, s. 25. (2). Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension.

(p) *In re* SMITH'S PATENT. [1850]

An application by the Lords of the Admiralty to enter a caveat and be heard against a petition for extension, such caveat not having been filed in proper time, refused; as the Attorney-General watches the interests of the government. (7 *Moo. P. C. C.* 133.)

(q) *In re* LOWE'S PATENT. [1852]

The Judicial Committee will not permit a party to be heard in opposition to an application for a prolongation of the term of letters patent, unless a caveat has been entered in his own name. Where a patent agent had entered a caveat in his own name, but in reality as the agent of several other persons as well as on his own behalf, it was held that his counsel could only be heard for him, and could only ask such questions as respected his interest. Any one of the public has a right to enter a caveat and be heard in opposition at the hearing. (8 *Moo. P. C. C.* 1.)

(r) *In re* SCHLUMBERGER'S PATENT. [1853]

An alien, residing abroad, who presents a petition to oppose the extension of a patent under which he, as a licensee, had had considerable dealings in this country, need not prove in a formal manner what his interest in the letters patent is. Whether an alien, living abroad, has a right, as such, to inform the Crown, by petition, as to any matters touching letters patent, *quære*. (2 *Eq. R.* 1.)

(s) *In re* HUTCHINSON'S PATENT. [1861]

Where the Judicial Committee made an order to receive a petition which had not been presented in accordance with Rule 3 of the Privy Council, made pursuant to the statute 5 & 6 Will. 4, c. 83, and a caveat had been entered:—*Held*, that as the party filing the caveat was interested in sustaining the objection to the reception of the petition, notice of the application must be served on him. (14 *Moo. P. C. C.* 364.)

*Considerations for and against.*

PATENTS ACT, 1883, sect. 25. (3.) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a *caveat* shall be entitled to be heard by himself or by counsel on the petition.

(4.) The Judicial Committee shall, in considering their decision, have

regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

*Grounds of Extension generally.*

(t) *In re ERARD'S PATENT.* [1835]

Lord Lyndhurst: "In cases of this kind (extension) we expect a very strong case of hardship to be made out, as well as a strong case upon the utility of the invention." (1 *Web. P. C.* 559; 5 *Rep. Art.*, N. S., 58.)

(u) *In re SWAINE'S PATENT.* [1837]

The invention being very meritorious, the result of a great deal of labour, care and science, and extremely useful in its effects, and the party having sustained considerable loss, the patent was extended. (1 *Web. P. C.* 559.)

(v) *In re SOUTHWORTH'S PATENT.* [1837]

The misfortunes of the patentee and those connected with him in the management of the patent, together with the nature of the invention being such that it would not be likely to come into immediate use, are grounds for an extension of the term for the patent. (1 *Web. P. C.* 486.)

(w) *In re WHITEHOUSE'S PATENT.* [1838]

The term of letters patent for improvements in manufacturing gas tubes, extended by the Judicial Committee, under the 5 & 6 Will. 4, c. 83, for six years, on the ground of the great merit and utility of the invention, the merit of the petitioner in patronising an ingenious inventor, and liberally expending money to introduce the invention (the amount of profit not being greater than the ordinary profit on capital employed on similar trades), and the annoyance, anxiety, and cost of litigation. (2 *Moo. P. C. C.* 496; 1 *Web. P. C.* 473.)

(x) *In re STAFFORD'S PATENT.* [1838]

Extension of term recommended, the patentee having experienced great opposition from the existing interests, and being a loser by the invention. (1 *Web. P. C.* 563.)

(y) *In re KOLLMAN'S PATENT.* [1839]

The invention being meritorious, but from circumstances beyond the control of the patentee, not sufficiently appreciated, and unproductive of reward, an extension recommended. (1 *Web. P. C.* 564.)

(z) *In re ROBERT'S PATENT.* [1839]

The violent resistance and opposition to the introduction of a meritorious invention, which has prevented the patentee from realizing a profit, is a ground for the extension of the terms of letters patent. (1 *Web. P. C.* 573.)

(a) *In re DOWNTON'S PATENT.* [1839]

"The questions are, is it a useful invention? is it beneficial to the public? is it an invention of that character which would lead us to interpose? is there ingenuity in the invention, and has the party been remunerated?" (1 *Web. P. C.* 567.)

(b) *In re JONES' PATENT.* [1840]

Lord Brougham: "It is perfectly true, as has been stated, not only upon this but upon former occasions, that these applications are anything rather than matters of course. This is a very extraordinary jurisdiction which has been conferred on the Judicial Committee by the legislature, and it is to be exercised only on the most special grounds alleged and proved in reference to each case." (1 *Web. P. C.* 579.)

(c) *In re MORGAN'S PATENT.* [1843]

Lord Brougham, in delivering judgment, said: "It is by no means the course of their lordships to put themselves precisely in the situation of the legislature, and never to grant an extension in a case where an Act of Parliament would not have been obtained. At the same time there are some limits to this. They are to look to a certain degree at the position in which they are placed, and to consider that they here represent the legislature, and that they are invested with somewhat similar powers of discretion to those exercised formerly by the whole three branches of Parliament." (1 *Web. P. C.* 739.)

(d) *In re SOAMES' PATENT.* [1843]

Lord Brougham, in delivering judgment, said: "If this case were to be disposed of upon the ground which in arguing such cases has sometimes been assumed to be the fit one, that there must not only be merit and benefit to the public, and (which is essential) a want of sufficient remuneration in the course of using the patent, but that, moreover, the case is to be tried here as on a Bill in Parliament introduced to prolong the patent; then, I apprehend, there can really be no doubt whatever that in this case no Bill would ever have passed through the two Houses of Parliament; but their lordships have always considered that it was with the view of affording a better remedy, not only cheaper and easier, but better in this respect, that there might be cases which never would have prevailed on the legislature to make a new personal law prolonging a monopoly, which, nevertheless, might seem meritorious enough in respect of the individual, beneficial enough in respect of the public, and deficient enough in remuneration to justify interference, which, nevertheless, had they been presented in the form of a petition to Parliament, would have failed to procure an act." The patent was extended for three years. (1 *Web. P. C.* 733.)

(e) *WRIGHT'S PATENT.* [1843]

Extension for seven years granted of a patent for manufacturing

ornamental tiles, regard being had to the benefit the public were likely to receive, and to the fact that the tiles were being used for the flooring of the Temple Church, and that this was the first time the invention had come into notice. (1 *Web. P. C.* 736.)

(f) DEROSNE'S PATENT. [1844]

It is anything rather than a matter of course to grant an extension, under the powers of the Act, of these patent rights; the parties must show, in the first place, some invention; in the next place, a benefit to the public; and in the third place, that they have not had an adequate remuneration." (2 *Web. P. C.* 4; 4 *Moo. P. C. C.* 418.)

(g) *In re* PERKIN'S CASE. [1845]

Lord Brougham, in delivering judgment, said: "It is by no means a matter of course that an application of this sort, *even when it is not opposed*, should be granted. We are here by the authority of the legislature, given to us to advise the Queen, to protect her from rashly and inexpediently for the public granting an extension, which formerly used to require a solemn and deliberate act of all the three branches of the legislature, involving a double inquiry, together with an opinion of the Government itself. Now, it becomes our duty to examine minutely, and very often to examine minutely, where there is no party to oppose except the Crown counsel, before we report or advise for any certain period of extension, or for any extension at all." (2 *Web. P. C.* 18.)

(h) *In re* PINKUS' PATENT. [1848]

Lord Langdale, M.R. : "What is usually taken into consideration as forming the ground of the species of indulgence here asked for is, first, the merit of the invention; secondly, the utility of the machinery which has been invented; and, lastly, the question has been raised, whether the patentee, who has enjoyed the benefit of the patent, has received a sufficient remuneration for the merit which he has displayed." (12 *Jur.* 234.)

(i) *In re* PETTIT SMITH'S PATENT. [1850]

Extension of letters patent granted for five years; the invention being of great merit and public utility, but the patentee and his grantees having received no remuneration, in consequence of the originality of the patent being disputed at law. (7 *Moo. P. C. C.* 133.)

(j) *In re* HEATH'S PATENT. [1853]

Term of letters patent extended for seven years, on the ground of the meritorious nature of the invention, and the extensive litigation the patentee had been put to in protecting his patent rights, which had prevented any remuneration. (8 *Moo. P. C. C.* 217; 2 *Web. R.* 247.)

(k) *In re PAYNE'S PATENT.* [1854]

Patent for preserved meats extended for five years, on the grounds that the patentee had used every exertion in his power to introduce the invention, and had expended large sums in so doing; but, by reason of the distrust with which the public viewed preparations of that nature, the inadequacy of the patentee's means, and his want of influence with public boards, he had been prevented from obtaining such a fair trial as would lead to the adoption by the public of his invention. (*Cit. Coryton's Laws of Letters Patent*, p. 220.)

(l) *In re HONIBALL'S PATENT.* [1855]

The Right Hon. Pemberton Leigh: "It has been again and again stated in this place that the grant of an extended term is anything but a matter of course; that, in order to obtain it, a very special case must be made; that the novelty, merit, and utility of the invention must be proved, and it must be shown that all reasonable means have been used in order to make the invention productive; but that, in spite of such exertions, the remuneration obtained by the inventor has either entirely failed, or has been quite disproportionate to his merits, and to the benefit conferred upon the public." (9 *Moo. P. C. C.* 393.)

(m) *In re CARDWELL'S PATENT.* [1856]

The Judicial Committee of the Privy Council will not, as a matter of course, extend letters patent, even when there is no opposition, and the Crown, through the Attorney-General, does not object. (10 *Moo. P. C. C.* 490.)

(n) *In re MARKWICK'S PATENT.* [1860]

The Right Hon. Lord Kingsdown, in delivering judgment said: "The petitioner is bound to prove three points—first, the merits of the invention; secondly, that the party interested has done all in his power to bring out the invention, and to turn it to advantage; and thirdly, that, owing to circumstances beyond his control, he has been unable to obtain an adequate remuneration." (13 *Moo. P. C. C.* 313.)

(o) *In re NAPIER'S PATENT.* [1861]

Prolongation of the term of letters patented granted to assignees, where the patentee has ceased to have any connection with the working of the patent, and the assignees were prevented from working it at a profit by reason of the discovery of the gold fields in Southern Australia, which caused a derangement and scarcity in the labour market. (13 *Moo. P. C. C.* 543.)

(p) *In re BOVILL'S PATENT.* [1863].

The patentee's invention consisted of improvements upon a former patent, taken out by him in consequence of a communication by a foreigner:—*Held*, that as the improvements were novel

and of public utility, the patentee was, in absence of adequate remuneration, entitled to an extension. (1 *Moo. P. C. C., N. S.*, 348.)

(q) *In re* NORTON'S PATENT. [1863]

The Master of the Rolls, in delivering judgment, said: "The grounds upon which their lordships grant extensions of patents all have reference to the inventor himself. They are, in the first place, to reward the inventor for the peculiar ability and industry he has exercised in making the discovery; in the second place, to reward him because some great benefit of an unusual description has by him been conferred upon the public through the invention itself; or, lastly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions to make the invention profitable. All these grounds proceed upon the supposition that the invention is a new and useful invention. But where the inventor intentionally delays for a great length of time attempting to put it into practice, the grounds for prolongation of the patent, which I have already mentioned, cannot be relied on by him unless it be possible for him to show some reasonable excuse for the delay. In some circumstances there might be a considerable ground of excuse arising from want of funds." (1 *Moo. P. C. C., N. S.*, 343; 9 *Jur., N. S.*, 420; 11 *W. R.* 721.)

(r) *In re* M'DOUGAL'S PATENT. [1867]

Extension ought not to be granted unless the invention is of considerable merit and of public utility, and the patentee has not received adequate remuneration. (5 *Moo. P. C. C., N. S.*, 1; *L. R.*, 2 *P. C.* 1.)

(s) *In re* PITMAN'S PATENT. [1871]

Sir J. W. Colville, in delivering judgment, said: "The general object of the statutory jurisdiction of this committee, in respect to advising an extension of the term of the letters patent, it is hardly necessary to state, is the reward to the inventor, in cases where there has been extraordinary merit in the invention, but where, from circumstances, he has failed to reap any adequate remuneration for his invention during the currency of the term of the letters patent." (*L. R.*, 4 *P. C.* 87.)

(t) *In re* HOUGHTON'S PATENT. [1871]

Prolongation of term of letters patent for seven years, the invention being a meritorious one, and of great value as a raw material for the manufacture of paper; no profits having been made either by the inventor or his assignees. (7 *Moo. P. C. C., N. S.* 309.)

(u) *In re* ADAIR'S PATENT. [1881]

Where a patentee, whether English or foreign, has obtained foreign patents they should be stated and the fullest information afforded as to the profits. An English patent may be renewed

though a foreign one has been taken out and allowed to expire. (6 *App. C.* 176.)

(v) *In re* NEWTON'S PATENTS. [1884]

Sect. 25, Clause 4, does not alter the rules adopted by the Judicial Committee. It is still the duty of a patentee applying for an extension to produce accounts of all profits received under foreign patents in respect of his invention. (9 *App. C.* 592.)

(w) STEWART'S PATENT. [1885]

Evidence of prior publication tendered by the Attorney-General without notice was admitted to show that there was not such novelty in the invention as would justify a prolongation. (*Griff.* 264; 3 *O. R.* 7.)

(x) ROPER'S PATENT. [1887]

When the invention was of a meritorious nature (viz., for a captain's bridge constructed as a self-launching raft):—*Held*, that having regard to that and to the difficulty of bringing it into use, and the patentee's illness, and the fact that no opposition was offered on behalf of the Crown an extension for seven years should be granted. (4 *O. R.* 201.)

Merit of Inventor.

(y) *In re* SOAMES' PATENT. [1843]

Lord Brougham: "The merit of an importer is less than of an inventor. We are now sitting judicially, and it is an argument against the patent, that it was imported and not invented. I do not say it takes away the merit, but it makes it much smaller." (1 *Web. P. C.* 733.) "It is very fit their lordships should guard against the inference being drawn, from the small amount of any step made in improvement, that they are disposed to undervalue that in importance; if a new process is invented, if new machinery is invented, if a new principle is found out and applied so as to become the subject of a patent right, embodied in a manufacture, then, however small it may be in advance of the state of science or of art previous to the period of that step being made, that is no reason whatever for undervaluing the merits of the person who makes a discovery in science or an invention in art, because the whole history of science is one continued illustration of the slow progress by which the human mind makes its advance in discovery. (*Ib.* 735.)

The publication of a patented invention in a foreign work is to be considered on an application for an extension of the patent, but not in an inquiry as to the validity of the patent. (*Ib.* 733.)

(z) *In re* DEROSNE'S PATENT. [1844]

Extension granted for six years of a patent for an invention, which was "very small in point of discovery," but useful, and of great benefit to the public. (4 *Moo. P. C.* 418.)

(a) *In re* WOODCROFT'S PATENT. [1846]

Reference to a suggestion, previously published, of the principle upon which an invention is based does not prove want of originality unless it is shown that the invention could be easily made by it. (2 *Web. P. C.* 23.)

Lord Brougham : " I may invent a thing this year, and I may say there are various ways of exercising my invention, to no one of which I give a preference over the others. There are A., B. and C., different ways of exercising it. Ten years after that another man may, by an invention, and by experiments made under it, point out to me and the public, who have the benefit of my invention, that one of those three ways, B. rather than A. and C., is the best mode of exercising it ; but that cannot take away the merit of the inventor who invented A., B. and C., altogether. Nay, I may go further, the circumstances may arise of a new invention giving for the first time a particular use to another. For example, no one denies to Watt the great merit of the steam engine, because steam navigation was applied subsequently to his time to the use of propelling ships. I quite agree that if another man's invention is necessary in order to make the first invention useful, no doubt that takes away the merit of the first invention ; but if the first invention contained in its own bosom a new mode, as well as the other two modes which are found out to be useful, it is in vain to say there is no value in the original invention." (*Ib.* 27.)

(a\*) *In re* MUNTZ'S PATENT. [1846]

The simplicity of an invention is an element of its value. (2 *Web. P. C.* 119.)

## (b) ELECTRIC TELEGRAPH COMPANY'S PATENT.

A company which buys a patent for a commercial purpose, although by so doing it does incidentally encourage inventors, does not stand in the same position as an inventor who, himself struggling with difficulty for want of capital, has been obliged to obtain the assistance of persons who have capital. Cited *Norton's Patent*. (1 *Moor. P. C.*, N. S., 339 ; 1 *Good. P. C.* 554.)

(c) *In re* LEE'S PATENT. [1856]

Letters patent comprised three separate subjects. Upon an application for an extension of the term of the patent, one only of the three subjects (that relating to railway breaks) appeared to the Judicial Committee to be deserving of a renewed grant. Prolongation granted under statute 15 & 16 Vict. c. 83, s. 40, for such part only of the letters patent as related to railway breaks, and not to the other subject-matters of the patent. (10 *Moo. P. C. C.* 226.)

(d) *In re* BETTS' PATENT. [1862]

Utility in the practical working of an invention, and not ingenuity in throwing out the idea of the possibility of doing a thing, is that description of merit which constitutes one of the grounds for extending the term of a patent. (1 *Moo. P. C. C.* 49.)



Lord Chelmsford, in delivering judgment, said : “Dobbs’ specification may have given the petitioner the idea of the possibility of uniting the two metals of tin and lead, and may thus have deprived him of the merit of originality. But in Dobbs’ hands the discovery was barren ; the petitioner, however, who followed out his suggestion, and after repeated experiments gave it a practical application, is the real benefactor to the public, and is entitled to claim that description of merit which constitutes one of the grounds for extending the term of a patent.” (*Ib.* 61.)

(e) *In re HILL’S PATENT.* [1863]

Sir J. T. Coleridge, in delivering judgment, said : “In determining whether to recommend the prolongation of a patent or not, even when the claim to a first discovery, and the beneficial nature of that discovery, are both conceded, it will be still proper to consider both the degree of merit as inventor and the amount of benefit to the public flowing directly from the invention. A monopoly limited to a certain time is properly the reward which the law assigns to the patentee for the invention and disclosure to the public of his mode of proceeding. Whether that term shall be extended, in effect whether a second patent shall be granted for the same consideration, and the enjoyment by the public of its vested right be postponed, is to depend on the exercise of a discretion, judicial indeed, yet to be influenced by every such circumstance as would properly weigh on a sensible and considerate person in determining whether an extraordinary privilege, not of strict right, but rather of equitable reward, should be conferred. Now, one may be strictly an inventor within the legal meaning of the term—no one before him may have made and disclosed the discovery in all its terms as described in his specification—but this may have been the successful result of long and patient labour, and of great and unaided ingenuity, without which, for all that appears, the public would never have had the benefit of the discovery ; or it may have been but a happy accident or a fortunate guess ; or it may have been very closely led up to by earlier, and in a true sense, more meritorious, but still incomplete experiments. Different degrees of merit must surely be attributed to an inventor under these different circumstances. The moral claim to an extension of time may in this way be indefinitely varied, according as the circumstances approach nearer to the one or the other of the above suppositions. The same principle will apply to the consideration of benefit conferred upon the public. The extent of the benefit conferred must vary in each case with the circumstances. The principal question always is, has the individual patentee, under all the circumstances, received what in equity and good sense may be considered a sufficient remuneration ? On his own part, of course, there must have been no want of good faith or prudent exertion ; and further, as the loss to the public may be important in the consideration, it may be necessary in some cases not to confine the inquiry to the state of things at the date of the patent, but to regard also the circumstances existing

at the time when the application is made." (1 *Moo. P. C. C., N. S.*, 265.)

(f) SILLAR'S PATENT. [1882]

In this case, the facts of which are set out at p. 130, Sir Barnes Peacock said : " It appeared that the three patentees had received altogether for their patent over £27,000 ; that being divided among the three patentees would be £9000 for each, which their lordships think an ample remuneration for the patentees themselves for the invention. But then the application is not made by the patentees, it is made by the Native Guano Company, who are the assignees of the patentees, and the question is whether their meritoriousness is such as entitles them to have the patent extended, looking to the benefits they have conferred upon the public by carrying on the invention assigned to them. (His lordship then referred to Norton's case and the Electric Company's case.) Did they form themselves into a company with the object of remunerating the inventors and enabling them to carry on this patent? . . . There has been no case cited, and I do not think any case could have been cited in which their lordships have recommended an extension for the benefit of a joint stock company who have floated their shares in the market, and made considerable sums by doing so. This company, by merely selling shares at a premium, appears to have realised a sum of £44,000, and that has been obtained not by selling the shares at par to persons willing to come in and work the patent, but by selling to stock-brokers, who bought them not for the benefit of the public but for the purpose of selling them again on the Stock Exchange. It appears to their Lordships that this company took over this invention as a speculative undertaking, and the mode in which the company have dealt with their shares shows that they were carrying on their operations for the purposes of speculating rather than for the purpose of benefiting the public. No doubt in all the cases in which they have endeavoured to carry out the patent they have been losers ; they have lost to the extent of £138,707." (1 *Good. P. C.* 581.)

(g) STONEY'S PATENT. [1888]

To obtain prolongation there must be in the invention greater merit than would support the patent in the first instance, or against a plea of inutility, and to obtain prolongation beyond seven years there must be special merit. When a patent is from its nature, *e.g.* for improvements in sluices and floodgates, only capable of being employed to an occasional or limited extent, that is a special circumstance to be considered. (5 *O. R.* 518.)

*Utility of Invention.*

(h) *In re* WRIGHT'S PATENT. [1839]

The fact of the invention not having been brought into use, unless explained, is an objection to the extension of the term.

But, being explained by the pecuniary difficulties and embarrassments of the patentee, extension recommended. (1 *Web. P. C.* 575.)

(i) *In re DOWNTON'S PATENT.* [1839]

The sale of a patented article in considerable numbers, when its cost is three or four times as great as the common article, is strong evidence of utility. (1 *Web. P. C.* 565.)

(j) *In re JONES' PATENT.* [1840]

The presumption arising from the non-user of an invention may be rebutted by showing that the nature of an invention is such that it would not be likely to come into immediate use. (1 *Web. P. C.* 577.)

(k) *In re SIMISTER'S PATENT.* [1842]

The extension of the term of letters patent refused, although the profit derived from the patent article was less than the expenditure incurred upon the patent, the utility of the invention being small.

The fact of an invention, when known, not getting into general use, is a presumption against its utility. (4 *Moo. P. C.* 164; 1 *Web. R.* 721.)

(l) *In re SOAMES' PATENT.* [1843]

The fact of further improvements upon the patented invention having been made, though not themselves patented, is an argument in favour of an extension of the original patent. (1 *Web. P. C.* 734.)

(m) *In re WOODCROFT'S PATENT.* [1846]

No extension will be granted if want of success be owing to inutility, or unless the circumstances have ceased which prevented it being lucrative, and it is really coming into use. (2 *Web. P. C.* 29.) Lord Brougham, in the course of his judgment, said: "We cannot here weigh degrees of merit in golden scales. If there is considerable merit, with originality and some considerable usefulness to the public, that is sufficient." (*Ib.* 31.)

(n) *In re BERRINGTON'S PATENT.* [1852]

An application on behalf of a patented knapsack was supported by very favourable reports from officers who had examined it. It was deposed that the fact of nine out of ten men in our infantry becoming flat-chested was to be attributed to the one in ordinary use. Some hundreds had been expended on it by the patentee, but hitherto without return. The committee, allowing their doubt as to its utility (arising from its not having been adopted by the government) to be slightly founded, in the absence of evidence of its failure, recommended its extension for five years. (*Coryton's Law of Letters Patent*, p. 225.)

(o) *In re* HEATH'S PATENT. [1853]

An alteration in the mode of manufacture will not prevent extension being granted, if it does not materially detract from the merit of the original invention. (8 *Moo. P. C. C.* 223.)

(p) *In re* BAKEWELL'S PATENT. [1862]

A patent, well known, had never been brought into public use during the period of fourteen years. The patentee accounted for the non-user, on the ground that the invention was of such a nature that it could only be carried out by a company, which he had failed to form :—*Held*, not sufficient to rebut the presumption against the practical utility of the patent, and an extension of the term refused. (15 *Moo. P. C. C.* 385.)

## (q) RUTHVEN'S PATENT.

Their lordships cannot disregard the manner in which the Admiralty and those who represent the will of the Crown and the inclination of the Crown in cases of this nature view this matter (*i.e.* utility). (*Cited Hughes' Patent*, *L. R.* 4 *App.* 179; 1 *Good. P. C.* 578.)

(r) *In re* ALLAN'S PATENT. [1867]

Application for a prolongation of the term, in the circumstances of non-user, refused by the Judicial Committee.

Where the utility of a patent has not been tested by actual employment, for a period of fourteen years, although efforts have been made by the patentee to bring it into use, it raises a very strong presumption against its practical utility, which presumption can only be rebutted by the strongest evidence. (4 *Moo. P. C. C.*, *N. S.* 443; *L. R.*, 1 *P. C.* 507.)

(s) *In re* M'DOUGAL'S PATENT. [1867]

Petition for the prolongation of a patent for "improvements in treating, deodorizing and disinfecting sewage and other offensive matter, which said improvements are also applicable in deodorizing and disinfecting in general." The improvement consisted in the use of a substance described in the specification as composed of sulphurous and carbolic acids, in combination with magnesia and lime, such acids being in common use by the public for disinfecting purposes before and after the letters patent :—*Held*, not to be an invention of such merit and utility as to justify an extension, to the detriment of the public in the use of known sanitary agents. (5 *Moo. P. C. C.*, *N. S.* 1; *L. R.* 2 *P. C.* 1; 37 *L. J.*, *P. C.* 17.)

(t) *In re* HERBERT'S PATENT. [1867]

If an invention has not been brought into practical use during the term of the letters patent, it raises a strong, though not conclusive, presumption against its utility; and unless there are circumstances to rebut such presumption, an extension of the term of letters patent will not be granted.

The fact of a patent of a valuable nature having a limited market, and therefore not having been so generally used as to remunerate the inventor, is sufficient to remove the presumption against the utility of the invention. (4 *Moo. P. C. C.*, *N. S.* 300; *L. R.*, 1 *P. C.* 399.)

(u) CLIFFORD'S PATENT. [1867]

If a patent invention has been brought fully before the attention of those who are interested in its use and application, and for fourteen years the patentee has had the exclusive right to the patent, at the end of that term (the privilege being somewhat in the nature of a contract with the public) they should have the power to use the patent. (*Cited Herbert's Patent*, *L. R.* 1 *P. C.* 399; 1 *Good. P. C.* 560.)

(v) *In re* SAXBY'S PATENT. [1870]

Lord Cairns, in delivering judgment, said: "It is not the practice of this tribunal to decide upon the novelty or utility of a patent; and although they would of course abstain in any case from prolonging a patent which was materially bad, yet, in one point of view, they are in the habit, in taking into account that which may be termed the question of utility, to consider not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit. Upon that question, it is the habit of this tribunal to consider whether the invention brought before them is one of that high degree of merit which, if everything else were satisfactory, would entitle the patentee to a prolongation." (7 *Moo. P. C. C.*, *N. S.* 84.)

(v\*) *In re* HUGHES'S PATENT. [1879]

In all cases where the utility of a patented invention has not been tested by actual employment, the question to be considered is, whether the evidence is sufficient to rebut the presumption that the invention is one of no practical utility which arises from its non-user.

Application for prolongation of the term granted, after strong and unanswered evidence of utility, the patent not having been used in England, though it had been used abroad, during any part of the time. (*L. R.*, 4 *App. Cas.* 174.)

(w) *In re* NAPIER'S PATENTS. [1881]

When it was shown that part of what was claimed in the specification was useful in its application to certain machines, an extension was granted limited to that part and to the application thereof to those particular machines. (6 *App. C.* 174.)

(x) WILLACY'S PATENT. [1888]

When the utility of the third claim alone was shown, and the accounts did not specifically deal with that claim, the petition was refused. (5 *O. R.* 690.)

*Remuneration.**(y) In re BATE'S PATENT.* [1836]

A large sum of money and much time being expended on *experiment* to perfect the invention, without any return, the patent extended. (1 *Web. P. C.* 739 (n).)

*(z) In re ROBERTS' PATENT.* [1839]

A patentee is entitled to deduct the expenses of taking and defending a patent, and the value of his time devoted to the invention, in estimating the profits derived from the patent. (1 *Web. P. C.* 575.)

*(a) In re KAY'S PATENT.* [1839]

In estimating profits the expense of taking and defending the patent and of making experiments are to be deducted. (1 *Web. P. C.* 572.)

*(b) In re DOWNTON'S PATENT.* [1839]

On application by the widow of the patentee, who died in 1839, to extend a patent granted in 1825, on the ground of inadequate remuneration having been received by him in his lifetime, owing to want of capital, an extension was granted for five years, and the petitioner's costs were ordered to be paid, the opposing party having shown no good ground for their opposition, the Attorney-General appearing for the Crown. (1 *Web. P. C.* 565.)

A Lord: "When a party has shown great ingenuity in an invention, and, from want of capital and means, has not been able to obtain an adequate return, we have over and over again extended the patent under such circumstances. . . . We generally want this proof—that they made nothing for the first seven or eight years, and it only began to be profitable during the latter years. It is no case for an extension only to show that you made £200 a year for the first fourteen years, and you want to make £200 a year for seven years more." (*Ib.* 566.)

*(c) In re QUARRILL'S PATENT.* [1840]

The petitioner having purchased the letters patent and stock in trade at a fair price of the patentee, and sustained no loss, the application for an extension of the term refused. (1 *Web. P. C.* 740.)

The actual expenses and receipts must be shown: it is not sufficient to show generally that there has been no profit. (*Ib.*)

*(d) In re JONES' PATENT.* [1840]

The insufficiency of the usual term to afford remuneration, regard being had to the nature of the invention, is a ground for the extension of the term, provided the invention be meritorious and useful to the public. *Semble*, that it is not necessary to show a probable ground for supposing that the petitioners

would be remunerated by the extension prayed. (1 *Web. P. C.* 577.)

(e) *In re GALLOWAY'S PATENT.* [1843]

The expense of litigation, the cost of the patents, the expense of bringing the invention into use, and a manufacturer's fair profit, must be deducted in estimating the profit derived by the monopoly. (1 *Web. P. C.* 729.)

(f) *In re DEROSNE'S PATENT.* [1844]

The term of letters patent, for refining sugar by filtration through beds of granulated animal charcoal, extended for six years, on the ground that, although the patentee had realized a very reasonable profit, he had not derived a benefit to the same extent as that derived by the public from the invention. (2 *Web. P. C.* 1; 4 *Moo. P. C. C.* 416.)

(g) *In re PERKINS' PATENT.* [1845]

Lord Langdale: "The question is what remuneration has been received under the patent, as a whole, not for any particular branch of it. . . . It is not intended that a patent should be divided and subdivided, and that you are to see whether he has received compensation upon one part and not upon another. The question is, whether the patent is to be renewed, which depends, amongst other things, upon this, whether he has received reasonable compensation during the first term for which it was granted. If there were ten branches of the patent, if he had received £10,000 under one of them, although he had received nothing under the other nine, it would be very questionable whether the Judicial Committee ought to grant an extension of the patent." (2 *Web. P. C.* 9.)

Per Lord Campbell: It is desirable, before applications for extension are heard, that the balance sheet should be handed over to the Solicitor for the Treasury, to examine it beforehand. (*Ib.* 14.)

It is material to consider, on applications for extension, in what ratio the profits have increased, if they have increased from year to year. (*Ib.* 16.)

(h) *In re LOWE'S PATENT.* [1846]

The patentee was unable to show, in the usual way, from his books, that he had not derived from the sale of his invention an adequate remuneration. The patentee not having sold any of his patented machines had kept no books, but he had allowed a gas company, in numerous instances, to apply his invention, for the purpose of making its utility known. The manager of the gas company deposed that he was not aware of the patentee having ever derived any benefit from his invention, and that they had not paid him anything in respect of it.

Sir S. Lushington said: "Although there has been no direct evidence given of want of profit, which is a very important part

of the petitioner's case, yet the evidence does show a *prima facie* case of no profit; and their Lordships are inclined to come to the conclusion that they are satisfied with the evidence, unless the Crown has reason to be dissatisfied with it. In these applications we have never permitted the petitioner to give evidence in his own case; but, if the Crown does not intend to raise the objection, that there is no proof of want of remuneration, then their Lordships are content with the evidence as it is." Patent extended. (10 *Jur.* 363.)

(i) *In re MUNTZ'S PATENT.* [1846]

Where a patentee has obtained his remuneration by the manufacture of the patented article during the existence of the patent, it is impossible to sever the profits realized as a manufacturer from those realized as a patentee. (2 *Web. P. C.* 121.)

The patentee having made 55,000*l.* by the manufacture, extension refused, on the ground that he had been sufficiently remunerated.

(j) *In re HARDY'S PATENT.* [1849]

In estimating the profits made under a patent, the profits arising from the sale of the patented article for exportation must be added. (6 *Moo. P. C. C.* 441.)

(k) *In re BRIDSON'S PATENT.* [1852]

Application, under statute 14 & 15 Vict. c. 99, s. 6, by parties who opposed an extension of letters patent, for production and inspection of the petitioner's accounts previous to the hearing of the petition, refused, with costs. (7 *Moo. P. C. C.* 499.)

(l) *In re HEATH'S PATENT.* [1853]

Where the estate of a deceased patentee was of little value, and no accounts had ever been kept, the petitioner, the administratrix and widow of the patentee, was examined to prove an allegation in the petition, to the effect that not only had there been no profits but a considerable loss. (8 *Moo. P. C. C.* 222.)

(l\*) *In re RYDER'S PATENT.* [1855]

The fact that the profits (which were £7000) had all been made in the last four years, is no ground for an extension where the sum realised is large. (*John.* 213.)

(m) *In re MARKWICK'S PATENT.* [1860]

The accounts produced at the hearing were unsatisfactory, owing to the non-production of the books. The Judicial Committee, in recommending a prolongation of the term of the letters patent, directed a proper account of the profits and losses of the patent, to be verified by affidavit, with an explanation accounting for the non-production of the books, to be laid before the Attorney-General, subject to which they extended the term. (13 *Moo. P. C. C.* 310.)



(n) *In re* NEWTON'S PATENT. [1861]

Letters patent for an invention communicated by a foreigner resident abroad, extended for five years. The invention (machinery for letter-press printing) was of a meritorious and useful character, but of an expensive nature, and only at the latter end of the term of the letters patent brought into public use; and, although the patent had been worked at a profit, it was not, in the opinion of the Judicial Committee, sufficiently remunerative, considering the value of the invention. (14 *Moo. P. C. C.* 156; 10 *W. R.* 731.)

In taking an account of the profits and loss of the working of a patent, the patentee is entitled to charge, as part of his expenses, for loss of time in endeavouring to bring the invention into general use. (*Ib.*)

(o) *In re* HUTCHINSON'S PATENT. [1861]

The books of the petitioner in respect to profits arising from his patent having been lost during his bankruptcy, the account of profit and loss was taken upon his own evidence. (14 *Moo. P. C. C.* 364.)

(p) *In re* BETTS' PATENT. [1862]

The account of profit and loss of the patentee in working a patent ought to be clear and precise; and it is the duty of a patentee, if engaged in any other business, or as a manufacturer of his own invention, to keep the accounts of the patent and the manufacture separately.

If a patentee is also manufacturer of his patent article, in taking account of the profits of the patent, he is entitled to deduct his profits as a manufacturer, as also the expenses caused by litigation in protecting his patent right. (1 *Moo. P. C. C., N. S.* 49; 9 *Jur., N. S.* 137; 11 *W. R.* 221; 7 *L. T. Rep., N. S.* 577.)

(q) *In re* HILL'S PATENT. [1863]

The most unreserved and clear statement of the patentee's remuneration is an indispensable condition in an application for an extension.

The patentee was also manufacturer and sold the patented article. In his accounts he deducted two-thirds as profits from the manufacture and sale, and only credited the patent with one-third:—*Held*, to be an unreasonable deduction.

Although law expenses incurred by the patentee in maintaining his patent rights are allowed in deduction of his profits, yet, where the patentee compromised suits and gave up costs to which he had an apparent title, a deduction on that head will not be allowed. (1 *Moo. P. C. C., N. S.* 258; 9 *Jur., N. S.* 1209; 12 *W. R.* 25; 9 *L. T. Rep., N. S.* 101.)

(r) *In re* TROTMAN'S PATENT. [1866]

To entitle a patentee to a prolongation of the term of letters patent, he must satisfactorily establish the amount of his profits.

Licensees stand, with respect to the profits, in the same position as assignees of the patent.

A patentee did not manufacture or sell the patented article (ship anchors), but granted licences to ironsmiths to manufacture, from whom he received royalties. On an application by him for an extension of the term of the letters patent, on the ground of inadequate remuneration, the accounts produced of his own expenditure in carrying on the patent being unsatisfactory, and no accounts given of the profits derived by the licensees, a prolongation of the letters patent was refused, first, as the patentee's accounts were unsatisfactory, and secondly, from the patentee's having so dealt with his patent rights as to deprive him of the power of showing the amount of profit derived from the working of the patent. (3 *Moo. P. C. C.*, *N. S.* 488; *L. R.*, 1 *P. C.* 118.)

(s) *In re POOLE'S PATENT.* [1867]

A patentee residing in America, for the purpose of getting the patented article into general use in England, arranged with an agent in England, and in consideration gave him a moiety of the royalties:—*Held*, that in estimating the profits of the patentee derived from the patent, such moiety was to be deducted. (4 *Moo. P. C. C.*, *N. S.* 452; *L. R.*, 1 *P. C.* 514.)

Lord Romilly, in delivering judgment, said: "There is no account of what profits he (the patentee) made in the United States, nor do their Lordships think it material for this purpose, because the question before them is, what profits were made and what benefits were sustained by the introduction of the invention into this country." (4 *Moo. P. C. C.*, *N. S.* 456.) See *in re JOHNSON'S PATENT*, p. 125 (x).

(t) *In re SAXBY'S PATENT.* [1870]

Where the patentee is also the manufacturer, the profits which he makes as manufacturer, although not strictly profits of the patent, must yet be taken into consideration in estimating the amount of his remuneration. Therefore, where, on a petition for prolongation, it appeared that the patentee was at the same time the manufacturer of the patented article, and was himself necessarily engaged in fixing and putting up the patented apparatus, and that the accounts for such services were so intermixed as to render it impossible on their face to separate the items of profit received from the patent, it appearing that, on the whole, the receipts had been very large, and that even on the balance alleged there had been considerable gain to the patentee, the Judicial Committee held that such accounts were unsatisfactory, and refused the application, but without costs. (7 *Moo. P. C. C.*, *N. S.* 82.)

Lord Cairns, in delivering judgment, said: "It is not for this committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what may be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the committee in a shape

which will leave no doubt as to what the remuneration has been that he has received." (*Ib.* 85.)

(u) *In re* CLARK'S PATENT. [1870]

A petitioner, seeking the grace and favour of the Crown, in applying for an extension of the term of letters patent, is bound to bring his accounts before the committee in such a shape as to leave no doubt what the remuneration has been that he has received from the patent.

The petition for extension, and the accounts furnished by the petitioner (the patentee) not containing sufficiently full and accurate information in respect to the patent, or the remuneration received by him, the Judicial Committee declined to recommend a prolongation of the term.

The principle, where the statement of the remuneration received by the patentee, is on the face of the petition and accounts filed unsatisfactory, of adjudicating without reference to the merits of the invention, as acted on in Saxby's Patent, recognised. (7 *Moo. P. C. C., N. S.* 255.)

(v) *In re* HOUGHTON'S PATENT. [1871]

The statement of accounts furnished being *prima facie* satisfactory, the petitioners were allowed to prove the merits of the invention before going into the accounts. (7 *Moo. P. C. C., N. S.* 309.)

Lord Justice James: "Their Lordships think that the cases of Saxby's Patent and Clark's Patent only go to this extent, that where there are special statements which show upon the face of the accounts, that the petitioners have, in fact, made very large profits by their invention, as was the fact in both those cases, such circumstance is sufficient for their Lordships at once to determine the application without going into the question of the merits of the invention." (*Ib.* 311.)

(w) *In re* WIELD'S PATENT. [1871]

Accounts of profits and loss filed by a patentee on his application for a prolongation of the term of letters patent being *prima facie* unsatisfactory, the Judicial Committee directed the question of accounts to be taken before considering the merits of the invention. As the accounts were not satisfactorily explained, the application for a prolongation was refused.

The difference between the sum for which a patentee has sold his patent and that which he has paid in buying it again cannot be allowed in the accounts as one of loss, but must be regarded as a mere commercial speculation. (8 *Moo. P. C. C., N. S.* 300; *L. R., 4 P. C.* 89.)

(x) *In re* JOHNSON'S PATENT. [1871]

When the possession of the patent has brought to the patentee the power of commanding orders as a manufacturer, it is to be

taken into consideration in estimating the profits derived from the patent. (8 *Moo. P. C. C.*, N. S. 291.)

James, L.J., said: "It was suggested to their Lordships that they ought not to take into consideration any of the profits made in America, and reference was made to Poole's Patent. Their Lordships desire it to be understood that that case is not to be considered as laying down any general rule of law. Where the question to be considered is, whether an invention has been sufficiently remunerated or not, their Lordships must have regard to the remuneration which the invention has brought in to the patentee, or the person who claims the right of the patentee, whether it be in one country or another." (*Ib.*)

(y) *In re CARR'S PATENT.* [1873]

Circumstances showing a want of adequate remuneration, an extension of the term of letters patent granted for six years.

In estimating the profits derived from the patent, the Judicial Committee will take into consideration a deduction from the profits of the patent for the personal expenses of the patentee for the exclusive devotion of his time in bringing the patent into practical operation and public notice. (*L. R.*, 4 *P. C.* 539; 9 *Moo. P. C. C.*, N. S. 379.)

(z) *In re JOHNSON'S AND ATKINSON'S PATENTS.* [1873]

The Judicial Committee will not enter upon the accounts, in a case for extension, unless they have been filed in accordance with the rules. (*L. R.*, 5 *P. C.* 87.) In Chatwood's patent the same course was followed. (*Ib.* 89 (*n.*))

(a) *In re ADAIR'S PATENT.* [1881]

Where a patentee, whether English or foreign, has obtained foreign patents they should be stated, and the fullest information afforded as to the profits. A patentee applying for extension must be prepared, with the clearest evidence, of everything paid and received on account of the patent. (6 *App. C.* 176.)

(a\*) *CHILD'S PATENT.* [1883]

Child obtained a patent in 1869 for improvements in the manufacture of bread, and in 1873 he assigned it to the Aerated Bread Company, of which he was chairman. In 1883 a central factory was started in London, and the inventor made a large profit by the rise in value of the shares of the company. *Held*, nevertheless, that he had not been sufficiently remunerated, and an extension for five years granted. (*John.* 214.)

(b) *BAILEY'S PATENT.* [1884]

The patentee wished to deduct £400 from the net receipts for his own remuneration, and a further sum as profits made by him as salesman; but as neither of these items appeared either on the accounts, or in the petition, their lordships refused to hear evidence about them. (*Griff.* 253; 1 *O. R.* 1.)

## (c) BISCHOF'S PATENT. [1884.]

The patent being a meritorious one, for improvements in the means for the purification of water, and the accounts showing that the patentees had sustained a loss, extension was granted; and following the precedent of Spencer's Case, where the patent was also for purifying water, the period of extension was fixed at seven years. (1 O. R. 162.)

## (d) DUNCAN AND WILSON'S PATENT. [1884]

A company, who have for a considerable time been assignees of the patent, and have also carried on a general business, are bound to keep their accounts so as to show, on an application for extension, what is to be applied to the patent business. There is no specific rule as to what proportion of the nett profits is to be attributed to general manufacturing profit, but two-thirds is too large a proportion. (*Griff.* 258; 1 O. R. 257; 1 T. L. R. 59.)

## (e) HORSEY'S PATENT. [1884]

Where the petition was presented by a company, and it was alleged that neither Horsey nor the company had been adequately remunerated, but it appeared that, although the Companies Act had been literally complied with, no *bonâ fide* company in any commercial sense had been formed:—*Held*, that *uberrima fides* had not been maintained, and the petition was dismissed. (*Griff.* 261; 1 O. R. 225.)

## (f) FURNESS'S PATENT. [1885]

Their lordships being unable to say "that the patentee had been inadequately remunerated," refused the extension. (*Griff.* 260; 2 O. R. 175.)

## (g) DEACON'S PATENT. [1887]

In a petition for prolongation of a patent, where the patent rights have been transferred either in whole or in part to a company, it is essential that there should be deposited, not only the patentee's accounts of his profits, but, in order to test them, the account also of the company; but:—*Held*, that in this case, having regard to the great merit and usefulness and advantage to the public of the patentee's discovery (which was for an improved apparatus for measuring the flow of water in pipes), prolongation for three years should be granted. (4 O. R. 119; 3 T. L. R. 349.)

## (h) BEANLAND'S PATENT. [1887]

No exceptional merit or utility being proved:—*Held* that, under all the circumstances, the remuneration was adequate. (4 L. T. R. 30; 4 O. R. 489.)

## (i) NUSSEY AND LEACHMAN'S PATENT. [1889]

The net profit from a patent dated 1876 had been £4000, and in 1886 the patentees had obtained a patent for an improved machine, which had practically superseded the old machine.

*Held*, that in all the circumstances the remuneration was sufficient. (7 O. R. 22.)

*Objections to Extension.*

(i) *In re* WOODCROFT'S PATENT. [1841]

An invention as described in the specification, having succeeded at first to a limited extent for certain patterns and colours, but being inapplicable for the more elaborate patterns and brighter colours, until rendered so by means of certain improvements introduced from abroad, whereby it had become of great value, an application for the extension of the patent was refused. (1 *Web. R.* 740; 3 *Moo. P. C. C.* 171.)

(j) *In re* SIMISTER'S PATENT. [1842]

*Semble*, that negligence on the part of the patentee in restraining infringement is a ground of opposition. (1 *Web. P. C. C.* 724; 4 *Moo. P. C. C.* 164.)

(k) *In re* GALLOWAY'S PATENT. [1843]

The fact of great improvements having been made on the original invention, affords no objection to the extension of the term. (1 *Web. P. C. C.* 727.)

(l) *In re* BELL'S PATENT. [1846]

Application for the extension of a patent for manufacturing lucifer matches and boxes. The want of profit arose from two circumstances: first, a defect in the composition with which the match was loaded, which was not rectified until ten years after the date of the patent; secondly, great loss had resulted from a fire which occurred on the premises, and, when the premises were rebuilt, the petitioner discovered that no insurance office would insure the premises, and that the terms of his lease obliged him to insure, and that, consequently, he was obliged to build other premises. The profits did not commence till three years before the expiration of the patent, and at the time of petition were under £700. Extension refused. (10 *Jur.* 363.)

(m) *In re* PINKUS' PATENT. [1848]

The non-reduction of an invention to practical operation in such a manner as to contribute to the public service, and the absence of evidence to prove the probability of its being so reduced into practice in the future, coupled with the fact that the patentee has allowed his patent to be infringed without any assertion of his right at law, is a sufficient ground for refusing to prolong a patent. Lord Langdale, M.R., said: "Upon the effect, the utility and the merit of the patentee's contrivance, there has been considerable evidence, and also upon the supposed futility of that contrivance. What is perhaps the strongest evidence, or the evidence upon which the best reliance can be placed, is this: that, from the time when the patent was granted up to this present time, this plan has

not been reduced to practical operation in any way which has been at all calculated to contribute to the public service; at this time it does not appear, at least there is no evidence whatever to show, that, as to this plan—the plan which is described in the first specification—there is now any, even the least, prospect of reducing it to practical operation.” (12 *Jur.* 234.)

(n) *In re PATTERSON'S PATENT.* [1849]

A patentee entered into an agreement with certain parties to work his patent, but, owing to disputes between them, the invention was not prosecuted until a short time before the expiration of the term of the letters patent. In such circumstances, an extension was refused. (6 *Moo. P. C. C.* 469; 13 *Jur.* 593.)

(o) *In re FOARDE'S PATENT.* [1855]

After an assignee of a patentee had incurred considerable loss in carrying out a patent for a smoke prevention apparatus, an Act of Parliament passed to compel the owners of furnaces in the metropolis to construct some form of apparatus so as to consume their own smoke:—*Held*, on an application for a prolongation of the letters patent, that though the Act of Parliament might, in effect, compel the use of the petitioner's patent, yet that such circumstance formed no objection to a renewal of the term of the letters patent, the merits of the invention and loss incurred in carrying it out being established. (9 *Moo. P. C. C.* 376.)

(p) *In re CARDWELL'S PATENT.* [1856]

A patentee agreed by deed with a public company to grant them exclusive licence to use his patented machine, and also covenanted with them to obtain, at the expiration of the term, a renewal of the patent for the same purpose. Under this deed the company alone used the patent. An application by the patentee for a prolongation refused, on the ground that the agreement was contrary to public policy, and repugnant to the provisions of the statute 5 & 6 Will. 4, c. 83, relating to prolongations of letters patent. (10 *Moo. P. C. C.* 488.)

(q) *In re NORTON'S PATENT.* [1863]

Where a patentee has intentionally delayed for a length of time attempting to put his invention into practice, an extension will not be recommended, unless he can show some reasonable excuse, such as want of funds, for the delay. (1 *Moo. P. C. C., N. S.* 339.)

(r) *In re GOUCHER'S PATENT.* [1865]

In the objections filed by the objectors, the point was not taken, that the power given by 7 & 8 Vict. c. 69, s. 2, to recommend an extension of the term of letters patent for an invention, is exhausted when an extension has been once recommended, and new letters patent granted:—*Held*, that the objection could be raised on the application to fix a day for hearing of the petition. (2 *Moo. P. C. C.* 532.)

(r<sup>1</sup>) SILLAR'S PATENT. [1882]

The petitioners were assignees of the patent and trustees for the Native Guano Company who held other patents relating to the invention. The patented process, called the A. B. C. process, was as follows:—liquid sewage was mixed in an open channel, with liquid containing in suspension finely ground charcoal and clay, mixed with a small percentage of blood. The sewage was thereby deodorized and the solution was then treated with alum, whereby the liquid became clear and the suspended matter was deposited. The deposit was pressed and dried and sold as manure under the name of native guano. Extension refused.

Sir Barnes Peacock said: "Any member of the public would be prevented from using alum, clay, and charcoal for the purpose of deodorizing sewage manure, using those ingredients in the proportions stated, whether with blood or without, by adding blood they would clearly infringe the patent. The question is whether this patent is of such utility as to justify the renewal of the patent, excluding the public upon this general specification, from the use of those ingredients for the purpose, the use of two of those ingredients, namely, alum and charcoal, being well known." His Lordship referred to M'Dougal's case, and said, "so in this case, it might and would be a detriment to the public to prevent them from using those well-known substances, alum and charcoal, in combination with clay with the proportion of blood given." (*Good P. C.* 581.)

*Questions of Validity.*(s) *In re* ERARD'S PATENT. [1835]

A patent will not be extended which is palpably bad, but their Lordships only require a *primâ facie* case to be made as to the validity of the patent. (1 *Web. P. C.* 557, note (a).)

(t) *In re* KAY'S PATENT. [1839]

Extension of letters patent about to expire granted, pending a suit involving the question of their validity, where the judgment of the court cannot be obtained before the expiration of the patent. It is sufficient to establish a *primâ facie* case of the validity of a patent on an application for an extension. (1 *Web. R.* 568; 3 *Moo. P. C. C.* 24.)

(u) *In re* GALLOWAY'S PATENT. [1843]

The new letters patent are granted subject to the same objections as the old, and the questions of novelty and utility will not be minutely entered on. (1 *Web. P. C.* 725.)

(v) *In re* ROBINSON'S PATENT. [1845]

The use of an invention in England prior to the date of letters patent granted for Scotland will invalidate the Scotch patent; and the Judicial Committee accordingly refused to *confirm* a Scotch patent, the invention being used in England before the date of the Scotch patent. (5 *Moo. P. C. C.* 65.)



(w) *In re* WOODCROFT'S PATENT. [1846]

Lord Brougham, in delivering judgment, said: "In all cases where there is a disputed right as to the validity of the patent, and where the validity of the patent itself must come in question, two things are to be considered. First, is the case to prove the invalidity of the patent, to prove the patent void, clear, past all ordinary and reasonable doubt; or, secondly, does the case hang so doubtful, that their Lordships would retire from its consideration, and not, because it is not necessary, decide the question here. In the former instance, namely, where it is a clear case, or nearly a clear case, their Lordships will not grant an extension; first, because they do not see merits, and, secondly, because they will not put the parties against whom the patent right is granted and is sought to be extended, to the vexation and trouble and expense either of bringing a *scire facias* to repeal the letters patent, or of sustaining an action for infringement. But where the matter hangs very doubtful, where there is conflicting evidence, where upon the construction of the specification or the patent, or in any other way, questions of law or questions of fact, as it may be, shall arise, their Lordships have not been used to refuse to exercise their discretionary powers, vested in them by the legislature, of recommending an extension, merely because elsewhere the validity of the patent may reasonably be contested. . . . Nothing is decided here in granting the extension as to the validity of the patent. All objections to it are saved, of course." (2 *Web. P. C.* 30.)

(x) *In re* PINKUS' PATENT. [1848]

Lord Langdale, M.R.: "On an occasion of this kind, this court has, in no very direct way, occasion to consider whether the patent is or is not valid at law. Unless the patent be very clearly invalid, so that it would be altogether nugatory to prolong that patent, the court usually has been rather inclined to assume that the patent may be a good patent, and so leave the question to any legal consideration that may arise in a contest between the parties who are interested in it." (12 *Jur.* 234.)

(y) *In re* HEATH'S PATENT. [1853]

The circumstance of there being *lis pendens*, respecting the validity of the letters patent, is no objection to the grant of an extension of the original letters patent. (8 *Moo. P. C. C.* 217; 2 *Web. P. C.* 247.)

(z) *In re* BETT'S PATENT. [1862]

If it can be clearly shown that the patent sought to be extended is bad for want of originality, the Judicial Committee will not entertain the application. *Aliter*, if at most, a doubtful question as to the validity of the letters patent can be raised. (1 *Moo. P. C. C., N. S.* 49.)

Lord Justice Turner, in the course of the argument, said: "A

sufficient *prima facie* case has been shown by the judgment of the House of Lords, in favour of the validity of this patent. It is not the practice of this tribunal, in applications of this kind, to go into the question of the validity or invalidity of the letters patent." (*Ib.* 52.)

(a) *In re HILLS' PATENT.* [1863]

Sir J. T. Coleridge, in delivering judgment, said: "Their Lordships have not in these cases been in the habit of trying the validity of patents. They will not, of course, recommend the extension of a patent which is manifestly bad; but, on the other hand, they will not generally enter into questions of doubtful validity. They lay aside, therefore, the questions of want of novelty and want of utility, so far as they affect the validity of this patent. Indeed, the learned counsel for the opponents disclaimed, and very properly, any intention of impeaching its validity directly; but they contended that, both with respect to the novelty and the utility of the invention, the degree of merit to be attributed to the petitioner ought to be taken into account; and in their Lordship's judgment they are right in that contention." (1 *Moo. P. C. C., N. S.* 262.)

(b) *In re M'DOUGAL'S PATENT.* [1867]

Sir W. Erle: "It is not the duty of the Judicial Committee upon such an application (extension) to adjudicate upon the validity or invalidity of the patent itself, but they must, in deciding whether the above conditions have been established, ascertain the meaning of the specification." (5 *Moo. P. C. C., N. S.* 4.)

(d) *In re M'INNES' PATENT.* [1868]

The subject-matter of an invention was the employment of a metallic soap, composed of well known chemical substances in common use, which the specification described as applicable for coating of iron and wood to prevent the fouling of ships' bottoms, and for other useful purposes. Prolongation of the term of such letters patent refused on the ground, first, that it would be detrimental to the public interest; secondly, that adequate remuneration (£2835) had been received. (5 *Moo. P. C. C., N. S.* 72.)

Sir W. Erle said: "Although this tribunal does not adjudicate upon the validity of a patent, yet in a case where the validity is doubtful, their lordships exercise a discretion in recommending, or otherwise, the Crown to prolong the term." (*Ib.* 76.) "Their lordships taking into consideration, with reference to the public interest, that the individual substance, for the application of which the patent is sought to be prolonged, is not specially defined, every kind of metallic soap being within the limits of the specification, are of opinion, that many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of the specification being as wide as it is.

On the whole, therefore, their lordships are of opinion, that they ought not to recommend Her Majesty, under such circumstances, to grant a prolongation." (*Ib.* 78.)

The following cases which had reference to the extension of a patent for an invention, also patented abroad, are omitted here, as the 15 & 16 Vict. ch. 83, sect. 25, having been repealed by 46 & 47 Vict. ch. 57, sect. 113, the duration of a patent for such an invention is no longer affected by the duration of the foreign patent:—

BODMER'S PATENT. (8 *Moo. P. C. C.* 282).

AUBE'S PATENT. (9 *Moo. P. C. C.* 43).

NEWTON'S PATENT. (15 *Moo. P. C. C.* 180).

HILL'S PATENT. (1 *Moo. P. C. C., N. S.*, 258).

POOLE'S PATENT. (4 *Moo. P. C. C., N. S.*, 452; *L. R.* 1 *P. C.* 514.)

NORMAND'S PATENT. (6 *Moo. P. C. C., N. S.*, 477).

WINAN'S PATENT. (8 *Moo. P. C. C., N. S.*, 306).

JOHNSON'S PATENT. (*L. R.* 4 *P. C.* 79).

BLAKE'S PATENT. (*L. R.* 4 *P. C.* 537).

*The Grant of Extension and Terms imposed.*

PATENT ACT, 1883, Sect. 25. (5.) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for Her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

*The Grant.*

(e) *In re KAY'S PATENT.* [1839]

The renewal grant of letters patent becomes invalid, if, after extension, the original patent is held to be bad. (1 *Web. P. C.* 571.)

(f) *RUSSELL v. LEDSAM.* [1845]

Original letters patent, for a term of fourteen years, were dated on the 26th of February, 1825, and renewed letters patent were dated on the 26th of February, 1839:—*Held*: that the day of the date must be reckoned inclusively, and that the former term expired on the 25th of February, 1839, and consequently the renewed letters patent were granted after the original letters patent had expired. Renewed letters patent, granted under 5 & 6 Will. 4, c. 83, s. 4, are not void if dated after the expiration of the term for which the original letters patent were granted, but may be granted by the Crown after the expiration of that term, provided the preliminary steps which the fourth section of the act requires to be taken by the patentee were

complied with before that term ended. See 2 & 3 Vict. c. 67. (14 *M. & W.* 574; 14 *L. J., Exch.* 353; affirmed in *Exch. Ch.* 16 *M. & W.* 633; and in House of Lords, 1 *H. L. Cas.* 687.)

(g) *In re SMITH'S PATENT.* [1847]

An application for renewed letters patent, to combine the substance of two patents, held by the petitioner, refused. (30 *Lond. Jour.* 451.)

(h) *In re PORTER'S PATENT.* [1853]

Improvements effected upon the invention, for which the original patent was granted, by the nephew of the applicant for extension, were amalgamated with the original patent for the extended term. (*Coryton's Law of Letters Patent*, p. 217.)

(i) *In re HEATH'S PATENT.* [1853]

Term of letters patent extended for seven years, in preference to a shorter period, on the ground of there being *lis pendens* respecting the validity of the patent, which would probably delay the enjoyment of the term of extension. (8 *Moo. P. C. C.* 217; 2 *Web. R.* 247.)

(j) *In re BODMER'S PATENT.* [1853]

Where letters patent comprised several subjects, one only of which had been worked out, and this part of the patent was affected by subsequent patented improvements by the same patentee; this portion of the patent only was extended, and the grant was restricted to the unexpired term of the subsequent patents. (8 *Moo. P. C. C.* 282.)

(k) *In re SCHLUMBERGER'S PATENT.* [1853]

Patentees applied under the statute 5 & 6 Will. 4, c. 83, for an extension of the term of letters patent, and the Judicial Committee recommended a prolongation for six years, which recommendation was confirmed by the Crown by an Order in Council, and a warrant issued for sealing the letters patent. No step was taken by the patentees to procure the sealing of the new letters patent, and, after a delay of nearly three years, a party interested in opposing the renewal petitioned the Crown to revoke the Order in Council and the warrant to seal. It did not appear that the petitioner, or the public, had suffered any loss by the laches of the patentees. The Judicial Committee, to whom the petition was referred, considered the laches not of sufficient magnitude to deprive the patentees of all benefit of the renewed patent; but made it a condition, before dismissing the petition, that the patentees should pay the petitioner a gross sum for costs and give an undertaking not to prosecute for any infringement which might have occurred from the date of the Order in Council to the date of dismissal of the petition. (9 *Moo. P. C. C.* 1.)

*(l) In re HONIBALL'S PATENT.* [1855]

The statute 5 & 6 Will. 4, c. 83, s. 2, applied to confirmation of letters patent for an extended term, as the grant of such extended term is a grant of new letters patent, which are subject to the same conditions, and open to the same objections, and entitled to the same advantages as original letters patent. (9 *Moo. P. C. C.* 378; 2 *Web. P. C.* 201.)

*(m) In re BETTS' PATENT.* [1862]

The prolongation of a patent is, by 5 & 6 Will. 4, c. 86, and 16 & 17 Vict. c. 115, the same as a new grant. (1 *Moo. P. C. C.*, *N. S.* 49; 9 *Jur.*, *N. S.* 137; 11 *W. R.* 221; 7 *L. T. Rep.*, *N. S.* 577.)

*(n) In re BOVILL'S PATENT.* [1863]

Letters patent were granted in 1849 for a patent for England, and in the year 1853 for Ireland and Scotland. Upon an application for a prolongation of the three patents, it was objected that the prior use of the English patent rendered the Scotch and Irish patents void. Such objection overruled, on the ground, that the statute 15 and 16 Vict. c. 83, s. 18, providing for a single patent for the United Kingdom, applied in the circumstances to this case, and was not affected by the 53rd section of that act. (1 *Moo. P. C. C.*, *N. S.* 348.)

*(o) BOVILL v. FINCH.* [1870]

Three separate original letters patent were granted to the inventor for England, Scotland and Ireland respectively. The Scotch patent was void for want of novelty, and afterwards a prolongation of the terms of the three original patents was granted by one and the same letters patent under the great seal of the United Kingdom, pursuant to 15 & 16 Vict. c. 83:—*Held*, that the grant of prolongation was divisible, and operated as if there had been separate grants by separate instruments for the three countries, so that the prolongation of the English patent was not rendered void by the invalidity of the Scotch patent. (39 *L. J.*, *C. P.*, 277; *L. R.*, 5 *C. P.* 523.)

*(p) In re JOHNSON'S & ATKINSON'S PATENTS.* [1873.]

Two cognate patents, having different terms to run, extended so that both should expire on the same day. (*L. R.*, 5 *P. C.* 87)

*(q) COCKING'S PATENT.* [1885]

Extension is granted in the form of a new patent for the prolonged term, so that section 22 of the Act of 1883 applies to it. (*Griff.* 258 2 *O. R.* 151.)

*(r) SMITH'S PATENT.* [1885]

Extension granted in the form of a new patent is subject to the provisions of sect. 22 and sect. 27 of the Act of 1883. (*Griff.* 263, 2 *O. R.* 14.)

*Conditions imposed.**(s) In re WHITEHOUSE'S PATENT. [1838]*

The inventor, a mechanic, having assigned his interest to the petitioner, his master, the Judicial Committee, under the circumstances, made it a condition to their recommendation to the Crown to prolong the term of the patent, that the assignee of the patent should secure the inventor an annuity during the period of extension. (2 *Moo. P. C. C.* 496; 1 *Web. P. C.* 473.)

*(t) RUSSELL v. LEDSAM. [1845—1848]*

Renewed letters patent were granted to the plaintiff "upon his securing to C. W. (the original inventor) an annuity of 500*l.* so long as the letters patent should last"—*Held*, that the meaning of this condition was, that a security should be given to C. W. for the annuity, but that whether it was given before or after the letters patent was immaterial; and that an averment, that the annuity was at the date of the new letters patent *secured*, was supported by proof of a deed to secure the annuity, executed before the new letters patent were granted. (14 *M. & W.* 574; affirmed in *Exch. Ch.*, 16 *M. & W.* 633; and in House of Lords, 1 *H. L. Cas.* 687.)

*(u) In re BODMER'S PATENT. [1849]*

Where the executor of the surviving assignee of a patentee petitioned for an extension of the term of the letters patent, and it was established that a valuable consideration had been given for the assignment, and that the assignee had sustained considerable loss, the Judicial Committee, in granting an extension of the term, refused to impose terms upon the petitioners in favour of the patentee. (6 *Moo. P. C. C.* 468.)

Lord Brougham: "Terms are only imposed on the assignee where the inventors and patentees have made nothing by their invention." (*Ib.* 469.)

*(v) In re BAXTER'S PATENT. [1849]*

Application for the extension of a patent for an improved method of printing in colours. The petition was opposed by the apprentices of the patentee, on the ground that they had served their time with the petitioner under the expectation that, on the expiration of the patent, they would be able to exercise the trade themselves; and that they had not been properly taught any other trade by the patentee, and, therefore, that they would be unable to gain their livelihood:—*Held*, that, if this defence had been founded in fact, the Judicial Committee would have put the petitioner under terms; but, as it was proved that the apprentices had received such instruction as to enable them to get employment in another branch of the trade, no condition was imposed on the patentee. (3 *Jur.* 593.)

(w) *In re HARDY'S PATENT.* [1849]

The inventor and patentee of improvements in manufacturing iron axletrees for railway carriages had lost largely by the patent, but his assignees had lately made considerable profits, and from their position in the trade, were likely to command a very large sale of the patented article. The invention was of high merit, and of great service to the public safety. In such circumstances, a prolongation of the term was granted to the assignees for four years, upon condition, first, that the assignees secured to the patentee half the profits derived from the sale; and, secondly, that the patented article should be sold by the assignees to the public, at a certain fixed price. (6 *Moo. P. C. C.* 441; 13 *Jur.* 177.)

(x) *In re PETTIT SMITH'S PATENT.* [1850]

In granting prolongation, the Judicial Committee imposed a condition, that the Commissioners for executing the office of High Admiral should have the right of manufacturing such invention, for the service of her Majesty, without any licence from the patentee. (7 *Moo. P. C. C.* 133.)

(y) *In re BODMER'S PATENT.* [1853]

Where letters patent (for improvements in machinery, tools or apparatus for cutting, planing, turning, drilling, and rolling metals) embraced several subjects, one only of which, namely, the rolling of metals, had been worked out, and that part of the patent was affected by subsequent patented improvements by the same patentee, and could not be effectually used without such subsequent improvements; the Judicial Committee, before recommending an extension of the term of the first patent, put the petitioner upon terms of disclaiming all the parts of the original patent not worked out, and restricted the prolongation to the unexpired term of the subsequent patents. (8 *Moo. P. C. C.* 282.)

(z) *In re SCHLUMBERGER'S PATENT.* [1853]

A patentee having obtained an extension warrant neglected to get the patent sealed. A subsequent petition to the Crown, by a foreigner, to revoke this warrant was dismissed on condition of the payment by the patentee of the petitioner's costs, and that no action should be brought for any infringements between the date of the warrant and the subsequent petition. (9 *Moo. P. C. C.* 1.)

(a) *In re CARPENTER'S PATENT.* [1854]

The Judicial Committee, in granting an extension of the patent, which was extensively used in the Royal Navy, refused to annex a condition allowing the Crown the use of the patent, for the public service, without licence from the patentee. (2 *Moo. P. C. C.*, *N. S.* 191 (n).)

(b) *In re NORMANDY'S PATENT.* [1855]

Patentee, formerly in partnership with J. & W., by a deed of dissolution stipulated that J. & W. should have the exclusive

right of granting, in certain cases there provided, licences for manufacturing the patent article. In recommending an extension of the term of the letters patent, the Judicial Committee imposed a condition upon the patentee to secure to J., in whom the interest under the deed of dissolution then vested, the same interest in the new letters patent as related to the granting of licences as was provided by the deed of dissolution, but refused to allow J. to substitute new licences for those granted under the original letters patent, in the event of the original licensees declining to renew their licences from him under the new grant. (9 *Moo. P. C. C.* 452.)

(c) *In re* MARKWICK'S PATENT. [1860]

An extension granted to the assignee, upon condition of an annuity being secured to the patentee. (13 *Moo. P. C. C.* 310.)

(d) *In re* LANCASTER'S PATENT. [1864]

Patent for improvements in the manufacture of fire-arms. The patentee had received large sums of money from government, for expenses of experiments, and by way of bounty and reward, but from the nature of the patent had not, in the opinion of the Judicial Committee, received sufficient remuneration for his invention, and in granting an extension, their Lordships refused to impose a condition in the new grant, that the Crown should be at liberty to use the invention for the public service without licence from the patentee. (2 *Moo. P. C. C., N. S.* 189.)

(e) *In re* MALLET'S PATENT. [1866]

A patentee, who was not a manufacturer, granted a licence to a manufacturing firm to manufacture the patented article, which, by agreement between them, was of an almost exclusive character. In granting a prolongation of the term of the letters patent, the new letters patent were directed to be made upon condition that licences should be granted by the patentee to the public upon terms similar to the one already granted. (4 *Moo. P. C. C., N. S.* 175; *L. R.*, 1 *P. C.* 308.)

(f) *In re* HERBERT'S PATENT. [1867]

Petition for prolongation of term of letters patent by patentee, together with the assignees of a moiety of the patent. After the presentation of the petition, and before the hearing, the patentee died, having by his will appointed his widow executrix and residuary legatee. Extension granted to the assignees, on condition that they held the moiety of the patent in trust for the widow of the patentee. (4 *Moo. P. C. C., N. S.* 300; *L. R.*, 1 *P. C.* 399.)

(g) *In re* PITMAN'S PATENT. [1871]

Sir J. W. Colville, in delivering judgment, said: "It has been the practice of this tribunal, in cases in which an application of this kind (extension) on the part of the assignee has been granted,



to impose conditions, whereby a proportion, at least, of the benefits to be derived from the patent should go to the original inventor: *In re Russell's Patent*." (L. R., 4 P. C. 87.)

(h) *In re NAPIER'S PATENT*. [1881]

When a patent is prolonged, if the invention is likely to be used by the government, it is usual to insert a condition that the government and its contractors should be entitled to use the invention. (6 *App. C.* 174.)

*Procedure.*

PATENTS ACT, 1883, sect. 25. (6) It shall be lawful for Her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

For the existing rules, see *ante*, pp. 98, 99.

(i) *In re ERARD'S PATENT*. [1835]

In all unopposed petitions for the extension of letters patent the Attorney-General should attend on behalf of the Crown. (1 *Web. P. C.* 557.)

(j) *In re WOODCROFT'S PATENT*. [1840]

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard to oppose. (3 *Moo. P. C. C.* 172 (n).)

(k) *In re SMITH'S PATENT*. [1850]

The Attorney-General represents the government and the public. (7 *Moo. P. C. C.* 133.)

(l) *In re BRIDSON'S PATENT*. [1851]

Application, under 14 & 15 Vict. c. 99, s. 6, by parties who opposed an extension, for production and inspection of the petitioner's accounts previously to the hearing of the petition, refused, with costs. (7 *Moo. P. C. C.* 499.)

(m) *In re HUTCHINSON'S PATENT*. [1861]

Rule 3 of the Privy Council, made pursuant to the statute, 5 & 6 Will. 4, c. 83, relating to letters patent for inventions, provides that a petition under sections 2 and 4 of that statute, must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette*.

A petitioner inserted the last advertisement of his intention to petition for a prolongation on the 24th of May, but did not present his petition until the 5th of June following. The registrar refused to receive the petition as being too late. Upon a special application for that purpose, it appearing that the delay arose from a mistake

of the petitioner's agent, an order was made admitting the petition. (14 *Moo. P. C. C.* 364.)

(n) *In re BALL'S PATENT.* [1879]

In the Privy Council the notice of objections is filed under the 6th rule of the Orders of the Privy Council, dated the 18th of November, 1835, which requires parties served with the petition to lodge at the Council Office, within a fortnight after such service, notice of the *grounds of their objections* to the granting of the prayer of the petition. This order is unaffected by the provision contained in the 41st section of the 15 & 16 Vict. c. 83, and it is sufficient under the rule to state the *grounds* of the objections without stating the *particulars* of those objections. Consequently, where the opponents state as one of their grounds of objection that the patent has been anticipated, and give some instances of such anticipation, evidence of other instances of anticipation not mentioned in the objection may still be given in evidence. (*L. R.*, 4 *App. Cas.* 171.)

(o) *In re NEWTON'S PATENT.* [1884]

Sub-s. (4) of sect. 25, does not alter the rules adopted by the Judicial Committee, and it is still the duty of a patentee to produce accounts of profits received under foreign patents. (9 *App. Cas.* 592.)

(p) *YATES & KELLETT'S PATENT.* [1887]

No accounts having been filed within the proper time, accounts were subsequently filed which were insufficient in the details given. The petitioners applied for an adjournment to amend, but the Crown opposing, the adjournment was refused and the petition dismissed. (3 *T. L. R.*, 353; 4 *O. R.* 150.)

*Costs.*

PATENTS ACT, 1883, Sect. 25. (7) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a Division of the High Court of Justice.

(q) *In re WESTRUPP & GIBBIN'S PATENT.* [1836]

Lord Lyndhurst: "My opinion on the subject of costs is this: if a party entitled to oppose does come and oppose, and opposes successfully, if we do not give costs we shall discourage persons coming to protect the interests of the public. We have the power to give costs in any matter referred to us, and, sitting here as a Judicial Committee, we can give costs under the general Act, not under the Patent Act." (1 *Web. P. C.* 556.)

(r) *In re MACINTOSH'S PATENT.* [1837]

The Judicial Committee give costs of opposition when the petitioner abandons his application for extension. (1 *Web. P. C.* 739.)

*(s) In re DOWNTON'S PATENT.* [1839]

Costs will be given to the petitioner where there is no ground for the opposition. (1 *Web. P. C.* 567.)

*(t) In re MUNTZ'S PATENT.* [1846]

Where the petitioner had fairly and honestly stated his case, both the things against and the things for him, in his petition, and the inquiry had been prolonged by the opposition, the costs of the opposition refused, although the petition had been dismissed on the ground of sufficient remuneration. (2 *Web. P. C.* 122.)

*(u) In re BRIDSON'S PATENT.* [1852]

Costs given to all the opposers upon petitioners abandoning petition before hearing. When the petition is abandoned, it is not necessary that the opposers should serve the petitioners with notice of their intended application to the court for costs of opposition. (7 *Moo. P. C. C.* 499.)

*(v) In re HORNBY'S PATENT.* [1853.]

On a petition for prolongation of letters patent, a day was fixed for hearing. Objections were lodged against an extension. Before the hearing the petitioners abandoned the prosecution of the petition. In such circumstances costs of opposition allowed to opposer. (7 *Moo. P. C. C.* 503.)

*(w) In re MILNER'S PATENT.* [1854.]

The Judicial Committee will exercise a discretion as to the allowance of an opposer's costs upon an abandoned petition for extension of letters patent.

A gross sum allowed for costs of opposers, instead of referring their costs to taxation.

An affidavit of merits by the petitioner upon the question of costs, rejected, as no copy had been served upon the opposers. (9 *Moo. P. C. C.* 39.)

*(x) In re JONES' PATENT.* [1854]

Where there were two opponents to an application for a prolongation of a patent upon substantially the same grounds of objection, the Judicial Committee, upon a successful opposition, allowed a gross sum for the costs of both parties. Opponents' costs directed to be taxed at 100*l.*, and divided between the opponents. (9 *Moo. P. C. C.* 41.)

*(y) In re HONIBALL'S PATENT.* [1855]

The Right Hon. Pemberton Leigh : "It is of great importance that parties should not be discouraged from bringing important facts to the knowledge of the Court by fear of the costs which they may have to pay, even if their opposition be successful; and upon this ground, in *Westrupp & Gibbins' Patent*, the parties opposing

were allowed their costs. But we are not satisfied with the manner in which this opposition has been conducted. Much expense has been occasioned by relying upon patents for inventions which have really no resemblance to this, and witnesses have been produced to whose testimony, as we have already intimated, we cannot give the smallest credit." No costs allowed to the opponents. (9 *Moo. P. C. C.* 394.)

(z) *In re HILLS' PATENT.* [1863]

Upon the dismissal of a petition for prolongation, the Judicial Committee, to avoid the expense of a formal taxation, allowed the petitioner the option of paying a gross sum of 1,000*l.* to the opponents for the costs of their successful opposition; such sum to be apportioned by the Registrar of the Privy Council among the several opponents, or in the alternative, dismissed the petition with costs generally. (1 *Moo. P. C. C., N. S.* 258.)

(a) *In re WIELD'S PATENT.* [1871]

When two sets of opponents really represent the same kind of opposition, one set of costs, to be apportioned between them, will be allowed, unless the petitioner should prefer to tax the costs of all parties. (8 *Moo. P. C. C., N. S.* 300.)

Sir J. W. Colvile: "Their lordships have considered the question of costs, and they are inclined to adhere to the rule that has been laid down, almost from the first application under the Act giving them jurisdiction in patent cases, that in the exercise of their power to grant costs it is certainly not desirable to refuse the costs of a fair opposition, since it is rather in the interest of this tribunal to encourage *bonâ fide* oppositions, in order that the Court may be put into possession of all that can be alleged against the continuance of the patent." (*Ib.* 304.)

(b) *In re JOHNSON'S PATENT.* [1871]

Where there were several opponents; on dismissing the petition a lump sum was awarded the opponents, to be divided *pro ratâ* for costs. (8 *Moo. P. C. C., N. S.* 282.)

MORGAN BROWN'S PATENT. [1886]

The petition being withdrawn, costs were given to the opponents. (3 *O. R.* 212.)

**Failure of Consideration.** See Grant, p. 149 (*u*).

**Fees.**

PATENTS ACT, 1883, sect. 24. (1.) There shall be paid in respect of the several instruments described in the Second Schedule to this Act, the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

(2.) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

## LIST OF FEES PAYABLE ON AND IN CONNECTION WITH LETTERS PATENT.

*Up to Sealing.*

	£	s.	d.	£	s.	d.
1. On application for provisional protection . . . . .	1	0	0			
2. On filing complete specification . . . . .	3	0	0			
				4	0	0
or						
3. On filing complete specification with first application . . . . .	4	0	0			
4. On appeal from Comptroller to Law Officer. By appellant. . . . .	3	0	0			
5. On notice of opposition to grant of patent. By opponent . . . . .	0	10	0			
6. On hearing by Comptroller. By applicant and by opponent respectively . . . . .	1	0	0			
7. On application to amend specification :—						
Up to sealing. By applicant . . . . .	1	10	0			
8.    After sealing. By patentee . . . . .	3	0	0			
9. On notice of opposition to amendment. By opponent . . . . .	0	10	0			
10. On hearing by Comptroller. By applicant and by opponent respectively . . . . .	1	0	0			
11. On application to amend specification during action or proceeding. By patentee . . . . .	3	0	0			
12. On application to the Board of Trade for a compulsory licence. By person applying . . . . .	5	0	0			
13. On opposition to grant of compulsory licence. By patentee. . . . .	5	0	0			
14. On certificate of renewal :—						
Before end of 4 years from date of patent . . . . .	50	0	0			
15.    Before end of 7 years, or in the case of patents granted under the "Patents, Designs, and Trade Marks Act, 1883," before the end of 8 years from date of patent . . . . .	100	0	0			
or in lieu of the fees of £50 and £100, the following annual fees :—						
16. Before the expiration of the 4th year from the date of the patent . . . . .	10	0	0			
17.    "    "    5th    "    "    "    . . . . .	10	0	0			
18.    "    "    6th    "    "    "    . . . . .	10	0	0			
19.    "    "    7th    "    "    "    . . . . .	10	0	0			
20.    "    "    8th    "    "    "    . . . . .	15	0	0			
21.    "    "    9th    "    "    "    . . . . .	15	0	0			
22.    "    "    10th   "    "    "    . . . . .	20	0	0			
23.    "    "    11th   "    "    "    . . . . .	20	0	0			
24.    "    "    12th   "    "    "    . . . . .	20	0	0			
25.    "    "    13th   "    "    "    . . . . .	20	0	0			
On enlargement of time for payment of renewal fees :—						
26. Not exceeding 1 month . . . . .	3	0	0			
27.    "    2 months . . . . .	7	0	0			
28.    "    3 months . . . . .	10	0	0			
29. For every entry of an assignment, transmission, agreement, licence, or extension of patent . . . . .	0	10	0			
30. For duplicate of letters patent . . . . . each	2	0	0			
31. On notice to Comptroller of intended exhibition of a patent under section 39 . . . . .	0	10	0			
32. Search or inspection fee . . . . . each	0	1	0			
33. For office copies . . . . . every 100 words (but never less than one shilling)	0	0	4			
34.    "    of drawings, cost according to agreement.						
35. For certifying office copies MSS. or printed . . . . . each	0	1	0			
36. On request to Comptroller to correct a clerical error up to sealing . . . . .	0	5	0			
"    "    "    after sealing . . . . .	1	0	0			

	£	s.	d.
37. For certificate of Comptroller under section 96 . . . . .	0	5	0
38. For altering address in register . . . . .	0	5	0
39. For enlargement of time for filing complete specification not exceeding one month . . . . .	2	0	0
40. For enlargement of time for acceptance of complete specification—			
Not exceeding one month . . . . .	2	0	0
,, two months . . . . .	4	0	0
,, three months . . . . .	6	0	0

**First Inventor.** See under Patentee, pp. 272 to 278.

### Foreign Invention,

importer of, may obtain patent, pp. 144, 278

communicated, to be distinguished from what is new, p. 145 (*l*).

#### *Importer of Foreign Invention.*

#### (*d*) HASTINGS' PATENT. [1567]

A patent was granted to Mr. Hastings in consideration that he brought in the skill of making frisadoes as they were made in Harlem and Amsterdam, beyond the seas, being not used in England. (*Noy. R.* 182; 1 *Web. P. C.* 6.)

#### (*e*) MATTHEY'S PATENT. [Eliz.]

By patent was granted unto him the sole making of knives with bone hafts and plates of latten, because, as the patent suggested, he brought the first use thereof from beyond seas. (*Noy. R.* 178; 1 *Web. P. C.* 6.)

#### (*f*) DARCY *v.* ALLIN. [1602]

When any man doth bring any new trade into the realm or any engine tending to the furtherance of a trade that never was used before the king may grant him a monopoly patent. (*Noy. R.* 182, 1 *Web. P. C.* 6.)

#### (*g*) EDGEBERRY *v.* STEPHENS. [1691]

If an invention be new in England, a patent may be granted, though the thing was practised beyond sea before, for the Statute 21 Jac. 1, speaks of new manufactures within this realm, so that if it be new here it is within the Statute. (2 *Salk.* 447; *Comb.* 84; *Dav. P. C.* 36; 1 *Web. P. C.* 35.)

#### (*h*) NICKELS *v.* ROSS. [1841]

A party availing himself of information from abroad is an inventor within 21 Jac. 1 ch. 3, sect. 6. (8 *C. B.* 679.)

#### (*i*) WALTON *v.* BATEMAN. [1842]

The party obtaining the patent must be the true and first inventor in this country. If he import from a foreign country that which others at the time of the making of such letters patent and grants did not use it will suffice. (1 *Web. P. C.* 615.)

*(j) STEAD v. WILLIAMS.* [1844]

If the patentee derived his information from a foreign country, that would still leave him the true and first inventor in this country, provided he did not derive his information from any person here. (See under Novelty, p. 245 (*q*)), (13 *L. J. C. P.* 220.)

*(k) In re LAMENEAUDE'S PATENT.* [1850]

Lord Brougham: "I am not aware that it has been held to negative the right of an importer of a foreign invention that a book had stated it before." (2 *Web. P. C.* 169.)

*(l) RENARD v. LEVINSTEIN.* [1864]

Semle: It is incumbent on a patentee to distinguish that part of an invention which is communicated from abroad from that which is new. (10 *L. T., N. S.*, 177.)

**Foreign Vessels**, use of patented article in, Patents Act, 1883, sect. 43, p. 145.

Sect. 43. (1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2.) But this section shall not extend to vessels of any foreign state of which the laws authorise subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.

*(m) CALDWELL v. VANVLISSENGEN.*

Formerly the use of an invention, patented in the United Kingdom, for the purposes of navigation of a foreign vessel, was prevented within the jurisdiction. (16 *Jur.* 115; 21 *L. J., Ch.* 97.)

**Foreigner.**

may apply for patent, Patents Act, 1883, sect. 4, (1), p. 145  
liable in this country for infringement, p. 287 (*q*)  
trustee of, may obtain patent, p. 145 (*n*)  
and petition for extension, p. 102 (*s*).

PATENTS ACT, 1883. Sect. 4. (1.) Any person, whether a British subject or not, may make an application for a patent.

*(n) BEARD v. EGERTON.* [1846]

A patent granted to a British subject in his own name for an invention communicated to him by a foreigner was not void, although in truth taken out and held by the grantee in trust for the foreigner. (3 *C. B.* 97.)

**Forfeiture for non-payment** of prescribed fees within prescribed times, Patents Act, 1883, sec. 17, p. 559.

**Forms.**

- of application prescribed by Patents Act, 1883, sect. 5, (1), p. 146
- of provisional specification, p. 147
- of complete specification, p. 147
- of patent, permitted by Patents Act, 1883, sect. 33, p. 270.

**PATENTS ACT, 1883.** Sect. 5. (1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at or sent by post, to the Patent Office in the prescribed manner.

[For the remainder of the section, see p. 34.]

Sect. 33. Every patent may be in the form in the first schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

**PATENT RULES, 1890, 5.** The Forms A, B, and C in the First Schedule to the Act of 1883 shall be altered or amended by the substitution therefor respectively of the Forms A, A1, A2, B, and C in the Second Schedule to these Rules.

[The following Forms A, B, C, are those which are set forth in the Statute; they are inserted here *only* for the sake of their bearing on the interpretation of the Statute. The prescribed forms, which are slightly different, must be used by applicants. They are set out in the Second Schedule to the Rules of 1890, and may be obtained at the Patent Office.]

**THE FIRST SCHEDULE.**

FORM OF APPLICATION, &C.

**FORM A.**

FORM OF APPLICATION FOR PATENT.

Section 5.

£1

Stamp.

(a) Here insert name, address and calling of inventor.

(b) Here insert title of invention.

I, (a) *John Smith*, of 29, *Perry Street*, *Birmingham*, in the county of *Warwick*, *Engineer*, do solemnly and sincerely declare that I am in possession of an invention for (b) "*Improvements in Sewing Machines*"; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

And I make the above solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(c) Signature of inventor.

(c) *John Smith.*

Declared at *Birmingham*, in the county of *Warwick*, this day of 18 .

(d) Signature and title of the officer before whom the declaration is made.

Before me,

(d) *James Adams*,  
*Justice of the Peace.*

**NOTE.**—Where the above declaration is made out of the United Kingdom, the words "and by virtue of the Statutory Declarations Act, 1835," must be omitted; and the declaration must be made before a British consular officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorised in that behalf.



**FORM B.****FORM OF PROVISIONAL SPECIFICATION.**

(a) Here insert title as in declaration.

(b) Here insert name, address, and calling of inventor as in declaration.

(c) Here insert short description of invention.

(d) Signature of inventor.

*Improvements in Sewing Machines. (a)*

I, (b) *John Smith*, of 29, *Perry Street, Birmingham*, in the county of *Warwick, Engineer*, do hereby declare the nature of my invention for "*Improvements in Sewing Machines*," to be as follows (c):—

\* \* \* \*

(d) *John Smith.*

Dated this            day of            18 .

NOTE.—No stamp is required on this document.

**FORM C.****FORM OF COMPLETE SPECIFICATION.**

£3

Stamp.

*Improvements in Sewing Machines. (a)*

(a) Here insert title, as in declaration.

(b) Here insert name, address, and calling of inventor, as in declaration.

(c) Here insert full description of invention.

I, (b) *John Smith*, of 29, *Perry Street, Birmingham*, in the county of *Warwick, Engineer*, do hereby declare the nature of my invention for "*Improvements in Sewing Machines*," and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement (c):

\* \* \* \*

Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed, I declare that what I claim is (d):

- 1.
- 2.
3. &c.

(d) Here state distinctly the features of novelty claimed.

(e) Signature of inventor.

(e) *John Smith.*

Dated this            day of            18 .

For form of patent, see under patent, p. 270.

The following additional forms are set out in the second schedule to the Patent Rules of 1890:—A. Application for Patent. A. 1. Application for Patent for Inventions communicated from abroad. A. 2. Application for Patent under International and Colonial Arrangements. B. Provisional Specification. C. Complete. D. Opposition to Grant of Patent. E. Application for Hearing by Comptroller. F. Application to amend Specification or Drawings. G. Opposition to amendment of Specification or Drawings. H. Application for Compulsory Grant of Licence. H. 1. Petition for Compulsory Grant of Licences. I. Opposition to Compulsory Grant of Licence. J. Application for Certificate of Payment or Renewal. K. Application for Enlargement of Time for Payment of Renewal Fee. L. Request to enter Name upon the Register of Patents. M. Request to enter Notification of Licence in Register. N. Application for Duplicate of Letters Patent. O. Notice of Intended Exhibition of Unpatented Invention. P. Request for Correction of Clerical Error. Q. Certificate of Comptroller. R. Notice for Alteration of an Address in Register. S. Application for Entry of Order of Privy Council in Register. T. Appeal to Law Officer. U. Application for Extension of Time for leaving Complete Specification. V. Application for Extension of Time for Acceptance.

**Fraud.**

on the Crown, p. 564 (*w*)  
 public user obtained by, p. 41 (*r*)  
 purchase money for patent obtained by, recovered, p. 67 (*i*)  
 in passing off goods, p. 148 (*o*)  
 in obtaining patent in breach of confidence, p. 84.

**(o) LAWRIE v. BAKER. [1885]**

In an action for infringement and for an injunction to restrain the defendant from fraudulently passing off his goods as the plaintiffs:—*Held*, that there was no infringement, but that as the defendant had sold cups for birdcages as “patent cups,” knowing that the trade understood that to mean the plaintiff’s cup, he had fraudulently passed off his goods as the plaintiff’s, and must be restrained. (2 *O. R.* 213.)

**Grant of Letters Patent.**

Patents Act, 1883, sect. 12, p. 148.

*The Date of*,  
 to be date of application, sect. 13, p. 80  
 how reckoned, pp. 58 (*g*), 59 (*l*)  
 of rival patents, p. 81 (*r*).

*Conditions and Terms of*,  
 to supply her Majesty’s service, p. 148 (*p*)  
 to grant licences, p. 149 (*q*)  
 to assign, p. 149 (*q*), (*r*)  
 in cases of joint inventors, p. 149 (*r*).

*Consideration for*, p. 149.

*Limited*, p. 150.

*Cancelling*, p. 151.

PATENTS ACT, 1883. Sect. 12. (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the patent office.

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned, that is to say—

(a.) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b.) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

***Conditions and Terms of Grant.*****(p) Ex parte PERING. [1836]**

A patent for the exclusive use of an improvement in the invention of anchors, contained a proviso for avoiding the patent, if the patentee should not supply for his Majesty’s service all

such articles of the invention as should be required, on such reasonable terms as should be settled by the Lords of the Admiralty. The latter used the invention, but did not take the articles from the patentee. The Court refused to issue a mandamus to them, to settle the terms according to the patent. (4 *A. & E.* 949; 6 *N. & M.* 472.)

(q) *In re DAINÉ'S PATENT.* [1856]

B. had obtained letters patent at the cost of D., which had been at D.'s request assigned to H. Subsequently D. applied for the grant of letters patent for an improvement in B.'s process. The Lord Chancellor being satisfied that D. had arrived at his knowledge on the improvement whilst working B.'s patent, ordered the patent to be sealed on certain terms as to assignment and licence to H. if he required them. (26 *L. J., Ch.* 298.)

(r) *In re RUSSELL'S PATENT.* [1857]

Where it appeared that a master and his foreman had both invented certain improvements, for which the master sought letters patent:—*Held*, that they ought only to be granted on the terms of their being vested in trustees for the master and the foreman. (2 *De G. & J.* 130.)

(s) *FEATHER v. THE QUEEN.* [1865]

The Crown might formerly use a patented invention without the assent or remuneration of the patentee. If the law were otherwise, the remedy of the patentee would not be by petition of right, but by action against the officers of the Crown using the patented invention. (6 *B. & S.* 257.) But now see Patents Act, 1883, sect. 27, p. 79.

(t) *DIXON v. LONDON SMALL ARMS CO.* [1877]

*Feather v. The Queen* was rightly decided, but the principle was one which ought not to be extended. (*L. R.* 1 *App. C.* 632.) But now see Patents Act, 1883, sect. 27, p. 79.

*Consideration for Grant.*

(u) *R. v. MUSSARY.* [1738]

Failure of consideration is a ground for avoiding the grant. (*Bull. N. P.* 76 a; 1 *Web. P. C.* 41.)

(v) *JESSOP'S CASE.* [Before 1795]

Where letters patent were taken out for a watch, and the invention was only of a part of a watch, they were held void for false suggestion. (2 *H. Bl.* 490; 1 *Web. P. C.* 42, n.)

(w) *BRUNTON v. HAWKES.* [1821]

Abbott, C.J.: "It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The King could not, in consideration of a new invention in one

article, grant a patent for that article and another." (4 B. & Ald. 551.) Bayley, J.: "If a patent is taken out for many different things, the entire discovery of all those things is the consideration upon which the King is induced to make the grant. That consideration is entire, and if it fails in any part it fails *in toto*. Upon an application for a patent, although the thing may be new in every particular, it is in the judgment of the Crown, whether it will or will not, as a matter of favour, make the grant to the person who has made the discovery. And when an application is made for a patent, for three different things, it may be considered by the persons who are to advise the Crown as to the propriety of the grant, that the discovery as to the three things together may form the proper subject of a patent although each, *per se*, would not induce them to recommend the grant." (*Ib.* 552.)

(x) *FEATHER v. THE QUEEN.* [1865]

A patent is not based upon a contract between the patentee and the Crown, in which the patentee, by communicating the secret of the invention to the public, gives a valuable consideration for the grant; but is simply an exercise of the royal prerogative. (6 B. & S. 285.)

(y) *PATTERSON v. GAS LIGHT AND COKE COMPANY.* [1877]

The Board of Trade under the City of London Gas Act, appointed three gas referees, whose duties were to inspect the works of the gas companies, with the view of ascertaining the means adopted therein for purifying gas, and to test the gas and prescribe the maximum of impurity to be allowed. The companies were required by the Act to give to the referees all facilities for the performance of their duties. The referees made experiments at the respondents' works, with a view to improvements in the purification of gas, and, in January, 1872, drew up a report thereon, which, three months afterwards, they submitted to the Board of Trade. Shortly before the report was submitted, one of the referees took out a patent for improvements, the principle of which had been indicated in the report. *Held*, that the contents were public property, so that there was no consideration for the patent. (*L. R.*, 2 Ch. D. 812. Affirmed in H. L., *L. R.*, 3 App. Cas. 239.)

*Limited Grant.*

(z) *Ex parte BATES AND REDGATE.* Ch. [1869]

Where a provisional specification is filed, but, pending the six months' provisional protection, and before obtaining letters patent, a second inventor files a provisional specification, and obtains letters patent for an invention, partly covered by the first provisional specification, letters patent will not, in the absence of fraud, be granted to the first applicant, for any part of his invention which is covered by the letters patent already obtained by the second applicant. (*L. R.*, 4 Ch. 577; 38 L. J., Ch. 501.)

*Cancelling.***(a) R. v. NEWTON.** [1845]

This was an application heard before the Lord Chancellor, assisted by the Master of the Rolls, to compel the defendant to bring into court a certain patent, to have the same cancelled, and the seal cut therefrom. It appeared that the patent had been obtained by the defendant for a foreigner resident abroad, and that he had forwarded the patent to him. It was ordered that the enrolment of the patent should be cancelled; and, that a *vocator* should be entered on the roll; and, that the defendant should undertake to bring no writ of error, or make any assignment of the patent. (26 *Lon. Jour.*, C. S. 361.)

**Grantee**, see Patentee.

**Great Seal.**

A patent sealed with the Seal of the Patent Office is, by Patents Act, 1883, sec. 12, to have the same effect as if it was sealed with the Great Seal of the United Kingdom. (See p. 148.)

**Ignorance** is no answer to action for infringement, pp. 202, 203 of previous invention, when wilful on part of patentee, p. 151 (b).

**(b) In re HONIBALL'S PATENT.** [1855]

According to the doctrine laid down by Lord Lyndhurst in Westrupp and Gibbin's patent, a party cannot be permitted to shelter himself under wilful ignorance, but must be fixed with knowledge not only of what he did know, but of that which he would have known if he had made the inquiries which it was incumbent upon him to make. (9 *Moo. P. C. C.* 378; 2 *Web. P. C.* 201.)

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**Illustrated Journal.**

PATENTS ACT, 1883, sec. 40. (1.) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

**Importation and Sale**, infringement by, p. 151 (c).

**(c) ELMSLIE v. BOURSIER.**

The importation into this country and sale here of goods manufactured abroad, by a process patented in this country, is an infringement of the patent. (39 *L. J. Ch.* 328; *L. R.* 9 *Eq.* 217.)

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**PATENTS ACT, 1883, 40, (3.)** The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.

**Industrial Exhibition.** See Exhibition, p. 93.

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*Generally.*

PATENTS ACT, 1883, sect. 13. Every patent shall be dated and sealed as of the day of the application: provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

17 (4) (b). If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

[For the remainder of the section, see p. 559.]

(c) *BANCROFT v. WARDEN*. Ch. [1773]

Demurrer to a bill stating that defendants imported barks and sold them to dyers, who used them in infringement of the plaintiff's patent, overruled. (*Romilly's Notes to Cases*, 103.)

(d) *GALLOWAY v. BLEADEN*. N. P. [1839]

Tindal, C.J.: An infringement is "a copy made after and agreeing with the principle laid down in the patent." (1 *Web. P. C.* 523.)

(e) *WALTON v. BATEMAN*. N. P. [1842]

The doing any of the acts specified in the prohibitory clauses of the letters patent is an infringement. (1 *Web. P. C.* 616.)

(f) *MUNTZ v. FOSTER*. N. P. [1844]

Tindal, C.J., told the jury, that, "for the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection arises either to the nature of the grant or the specification, which has been enrolled by the plaintiff." (2 *Web. P. C.* 99.)

(g) *RUSSELL v. LEDSAM*. Ex. Ch. [1845]

Parties who use an invention, letters patent for which have expired, before such letters patent have been renewed, are not guilty of infringement. (14 *M. & W.* 574; affirmed in Exch. Ch., 16 *M. & W.* 641.)

(h) *STEAD v. ANDERSON*. [1847]

To prove infringement, it must be shown, that there is a substantial resemblance to the plaintiff's invention, in particulars to which his exclusive right extends. (2 *Web. P. C.* 155.)

(i) *CROWL v. EDGE*. [1850]

Where the enrolled specification of a patent was not identical with the invention for which the patent had been granted, but of a more extensive nature, in an action on the case for infringing the plaintiff's patent in a particular not included in the patent but in the specification, a verdict for the defendant was held right, and the rule for a new trial discharged. (39 *L. O.* 443; *M. Dig.* 194.)

(j) *CALDWELL v. VANVLISSENGEN*. Ch. [1851]

Turner, V.-C., in the course of his judgment, said: "What previous user will invalidate a patent, and what user (if any) can be permitted in contravention of the patent right, are different



questions, depending on wholly different considerations; the one upon the extent of previous knowledge, the other upon the effect of the grant. (9 *Hare*, 428.)

(k) *UNWIN v. HEATH*. H. L. [1855]

Crowder, J.: "For the purpose of considering the question of infringement, the invention must be assumed to be new, and well described in the specification." (25 *L. J.*, C. P. 10.)

(l) *In re BAKEWELL'S PATENT*. [1862]

This was an application by the patentee for a prolongation of the term of letters patent. Lord Chelmsford, in delivering judgment, said: "There was a patent granted to Mr. Bonelli, which the petitioner asserts to have been an infringement of his patent. Mr. Bonelli, it appears, has obtained a private Act of Parliament, incorporating a company, which has been established for the purpose of carrying out his invention. Their Lordships do not mean to say that this private Act of Parliament would be actually a bar to any proceedings on the part of Mr. Bakewell, supposing the term of the patent were enlarged, for an infringement of the patent by Bonelli, but it certainly would interpose very considerable difficulty in the way of such action, and I am not at all aware of any such action in which a party has obtained a verdict for the infringement of a patent where the party proceeded against has been working that which is said to be an infringement under the authority of an Act of Parliament." (15 *Moo. P. C. C.* 388.)

(m) *BETTS v. WILLMOTT*. Ch. [1871]

Where a patentee in England has an agency abroad, the sale of the article patented, either abroad or in this country, carries with it the right to use it everywhere, unless such use has been limited by agreement. (*L. R.*, 6 Ch. 239.)

(n) *SAXBY v. HENNETT*. [1873]

Two patents for the same inventions were applied for on the 20th and 23rd July, 1867, respectively. The patent applied for on the 23rd July was sealed before that applied for on the 20th July, but each patent was dated as of the day of application:—*Held*, that, under the 15 & 16 Vict. c. 83, s. 24, the patents took effect as upon the days on which they were applied for respectively, and therefore acts done by virtue of the patent applied for on the 23rd July were infringements of the patent applied for on the 20th July. (*L. Rep.*, 8 Ex. 210; 42 *L. J.*, Ex. 137; 28 *L. T. Rep.*, N. S. 639.)

(p) *CLARK v. ADIE* (First App.). H. L. [1877]

A patent for a combination may be infringed in three ways:

- (1) By using the whole combination.
- (2) By using in substance the pith and marrow of the

invention, omitting part to give colour to that adopted.

- (3) By using a subordinate integer, which is itself a minor invention, but in this case the specification must make it plain that the patentee intended to claim such subordinate integer. (*L. R.*, 2 *App. Cas.* 315.)

(q) *RICHARDSON v. CASTREY.* [1887]

The patent was for an apparatus to be used in manufacturing wine glasses, and was held to be for a particular combination, and as the defendants had not used this combination they were held not to have infringed. (4 *O. R.* 265.)

(r) *SIDDELL v. VICKERS.* [1888]

In an infringement case the Court will not allow the decision of a law officer to be read as an authority. (5 *O. R.* 436.)

(s) *MASON v. GOODWIN.* [1889]

Chitty, J., held that the patent (which was for improvements in stone-breaking machines) was for a combination, and that the defendant's machine was not an infringement. (6 *O. R.* 235.)

*By Working and Making.*

(t) *JONES v. PEARCE.* N. P. [1832]

Action for the infringement of a patent for an improved method of making carriage wheels on the principle of suspension. A wheel upon the same principle, but of different construction, had been made by Mr. Strutt prior to the date of the patent. Patteson, J., in summing up the case to the jury, said: "The defendant has constructed a wheel, whose construction is on the suspension principle. That alone would not make it an infringement of the plaintiff's patent, because the suspension principle might be applied in various ways; but if you think it is applied in the same way as according to the plaintiff's patent it is applied, then the want of two or three circumstances in the defendant's wheel, which are contained in the plaintiff's specification, would not prevent the plaintiff's recovering. It would be quite a different thing if it was shown that the defendant had his communication long before with Mr. Strutt, and had constructed something like Mr. Strutt's invention without any knowledge of the plaintiff's patent—it would be the hardest possible thing to say that this was an infringement of the plaintiff's patent." (1 *Web. P. C.* 124.) The defendant would be liable for infringement unless he made the wheels for amusement or as a model. (*Ib.* 125.)

(u) *MACNAMARA v. HULSE.* N. P. [1842]

If an invention, for which a patent is granted, would, if put into practice, be useful, an action for the infringement of the patent may be maintained, although the plaintiff's invention has never been put into actual use, except by the defendant, when he infringed the patent. (*Car. & M.* 471.)

(v) *GIBSON v. BRAND.* [1842]

Tindal, C.J., in delivering judgment, said: "The breach alleged in the declaration is that the defendant infringed the patent, by making and putting in practice the plaintiff's invention; and the evidence is, that he gave an order in England, which order was executed in England, for making articles by the same mode for which the plaintiffs had obtained their patent, which articles were afterwards received by the defendant. This is quite sufficient to satisfy an allegation that he made those articles; for he that causes and procures to be made, may be well said to have made them himself." (11 *L. J., C. P.* 183; 4 *M. & G.* 196; 1 *Web. P. C.* 631.)

(w) *MUNTZ v. FOSTER.* N. P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships." The patentee described his invention as consisting in making the said plates of an "alloy of foreign zinc," and of "best selected copper;" the metals being melted together in certain stated proportions. Tindal, C.J., told the jury that if the defendant had "actually made any small experiment for the purpose of ascertaining what the proportions or properties of the different alloys would come to, that would scarcely have been said to be a making in violation of the patent." (2 *Web. P. C.* 101.)

(x) *CALDWELL v. VANVLISSENGEN.* Ch. [1851]

The exclusive rights under an English patent will be enforced against foreigners while in England, in the same way and to the same extent as it would against British subjects. Therefore, in a case in which the foreign owners of a ship caused to be made in their own country, and attached to their vessel, a steam screw propeller, the manufacture and user of which was unrestrained by law there, but restricted in England by a patent, and afterwards sent the vessel with a cargo for the purpose of trade to England, the use of the steam propeller was restrained by injunction while the vessel should be within the waters covered by the English patent. (16 *Jur.* 115; 21 *L. J., Ch.* 97.) [But see now sect. 43 of the Patents Act of 1883, p. 145.]

(y) *SMITH v. DAVIDSON.* [1857]

The Lord President said: "This is a case not very common,—one of contemporaneous invention. The jury have found in effect that the pursuer and defenders were each of them original inventors of improvements in their department of trade—that their inventions were substantially the same—and that they were contemporaneous inventors. The pursuer obtained a provisional specification on 14th Nov. 1853, before which time the defender, Davidson, acting independently, had perfected his invention. He used his own invention from and after that day. The provisional protection did not, during its currency, disable

him or disentitle him from using his own invention, and the question is, whether the giving out of letters patent disentitles him to continue the use of it under pain of being liable as an infringer of the patent . . . . It is contended that the patent could not prevent him doing what he was doing before it was granted, and at most could only prevent him using the pursuer's invention, but not his own. The first of these grounds admits of two answers—First, if the 14th Nov. 1853 be taken to be the true and legal date of the letters patent, as I think it must, there was nothing done by Davidson before that date which amounted to use of his invention, and therefore it cannot be a hardship to prevent him doing what he was not doing before that date, and before the date of the letters patent he was not using the invention for the purpose of trade. Second, although the use of the invention during the subsistence of the provisional protection does not expose the user to prosecution as an infringer, there is nothing in the statute from which we can infer that it enables him to continue such user after the letters patent are given out. The case of the defenders, therefore, must rest on the other ground, that Davidson was using, not the pursuer's invention, but truly his own invention; supported by the fact found by the jury, that he was an original inventor, that this machine was made by him, and that he was using that machine till the 1st February, 1854. He also founds on an inference to be deduced from the terms of the letters patent, which limit the monopoly of the pursuer to the use of his own invention. That raises a question of novelty and importance. I am of opinion that the argument so maintained on the part of Davidson is not sound in law. When a patent is validly granted, then I think that the party who obtains the patent is held to be the owner of that invention described in the letters patent. A monopoly of it is given to him as being his invention, because he is the party who has given to the public that invention. A party may live and die, taking the knowledge of his invention with him, but the disclosure of the invention and the means by which it shall be put in use, are the conditions on which he obtains a monopoly of it from the public, and the party who comes forward and complies with that condition, being himself the true inventor, gets the right to the monopoly of that invention. . . . A separate inventor who comes after him does not borrow the invention if he is truly original in his invention. But if this defender, who was an inventor before the date of the patent, but had not then brought his invention to perfection or made it public, is entitled to use it merely because he can say he did not take it from the patent, may not any person take the invention from the defender, using his invention, and not the invention of the patentee, and so the patent may be altogether destroyed. To allow this, therefore, would be to destroy the validity of the monopoly. I see no ground for the defender's doctrine, from the policy of the statute, from the history of this monopoly, or from the terms of the letters patent. On the contrary, I think that the true reading of all is,

that by giving the public the benefit of the invention, that invention, and everything that is substantially the same with it, and which was not public before the date of the patent, is the invention of the patentee, and that no person has a right to destroy his monopoly by using machinery or improvements substantially the same with his." (19 C. S. 697.)

(z) *LISTER v. LEATHER.* [1857]

Lord Campbell, C.J., in delivering the judgment of the Court, said: "The patent for an improvement on an invention already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention, during the existence of the former patent, without licence, would be an infringement; but, with licence, that also would be lawful." (8 *Ell. & B.* 1017.)

(a) *HILLS v. THE LIVERPOOL UNITED GASLIGHT COMPANY.* Ch. [1862]

A patent was granted for an invention for the purification of gas by means of precipitated or hydrated oxides of iron. The specification was held to include such precipitated or hydrated oxides only as were obtained by artificial means. The use of a natural substance, such as bog ochre, containing precipitated oxide of iron, so long as it was used in its native condition, was held not to be an infringement of the patent; but upon this substance being re-oxidised or renovated in the manner described in the specification, or in any other manner, it was brought into the condition of being one of the patented purifying materials, that is, a hydrated or precipitated oxide artificially obtained, the use of which became an infringement. (32 *L. J., Ch.* 28; 9 *Jur., N. S.* 140; 7 *L. T. Rep., N. S.* 537.)

(b) *NEWALL v. ELLIOTT.* [1864]

The plaintiff's patent was for "improvements in apparatus employed in laying down submarine electric telegraph wires." The specification claimed: "First, coiling the wire or cable round a cone; secondly, the supports placed cylindrically outside the coil round the cone; thirdly, the use of rings in combination with the cone, as described." The defendants put up on board a ship, in this country, an apparatus consisting of an external cylinder round a coil, and an internal cylinder capable of being so altered as to form a mechanical equivalent to a cone. There was also a ring on board similar to the plaintiff's rings. In this the defendants did no more than they had done before the patent for the purpose of safe carriage; and there was no further evidence that they did it now for any other purpose:—*Held*, first, that this was no infringement of the patent; secondly, that the patent, being limited to the United Kingdom, the Channel Islands, and the Isle of Man, could not be infringed by any act done on board an English vessel at Malta, or on the high seas. (10 *Jur., N. S.* 954; 13 *W. R.* 11; 10 *L. T. Rep., N. S.* 792.)

Martin, B.: "A patent for a combination may be a good patent, but if there has been used before any portion of that which constitutes the combination, the public have a perfect right to use it." (10 *Jur.*, N. S. 957.)

Bramwell, B.: "If a man fits up on board a ship a part of a machine, and he has the other part there, so that he may apply the whole of the patented machine when he gets out of England, he may infringe the invention." (*Id.* 958.)

(c) *GOUCHER v. CLAYTON*. Ch. [1865]

Though the manufacture in this country of the several parts of a patented machine, and the exportation of those parts, may not be an infringement of a patent for a new combination of machinery, when the parts exported are old, it is otherwise where the parts exported are new, and are claimed as new. (11 *Jur.*, N. S. 462; 13 *L. T. Rep.*, N. S. 115.)

(d) *BETTS v. NEILSON*. H. L. [1865-71]

The plaintiff was patentee of a substance for making capsules to cover the mouths of bottles so as to render them air-tight. A brewer in Scotland, to which country the patent did not extend, sent to an English port for shipment to his foreign customers bottles of beer covered with similar capsules made abroad:—*Held*, that since the capsules, during the time of the bottles being in England, were answering the purpose for which they were intended, of preserving the liquor, there was a user of the invention in England which ought to be restrained by injunction. (6 *N. R.* 221; 11 *Jur.*, N. S. 679; 34 *L. J.*, Ch. 537; 13 *W. R.* 1028; 3 *De G., J. & S.* 82; 12 *L. T. Rep.*, N. S. 719; *L. Rep.*, 3 Ch. 429; 37 *L. J.*, Ch. 321; 18 *L. T. Rep.*, N. S. 159; affirmed on appeal to the House of Lords, *L. R.*, 5 H. L. 1; 40 *L. J.*, Ch. 317; 19 *W. R.* 1121.) Wood, V.-C., said he could well conceive a case in which there would be no user in England, as for instance, foreign tools, infringing an English patent, packed up in boxes and lying inert, or transhipped in course of transit in an English harbour. (6 *N. R.* 222.) Turner, L.J., in the course of his judgment, said: "The case of *Caldwell v. Vanvliссengen* may be in some respects distinguishable from the present, but I think that it disposes of the present question. . . . Now, the distinction attempted to be drawn between that case and the present is this, that in that case there was an active use of the patented article, and here it is said, and I have no doubt truly said, that the use of the patented article is passive and not active. But it does not appear to me that the question whether the user is active or passive can have any bearing on the question whether the patented article is used or not." (3 *De G., J. & S.* 87.)

(e) *FREARSON v. LOE*. M. R. [1879]

Jessel, M.R.: "If a man makes things merely by way of *bond fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has

been granted, but with the view of improving upon the invention the subject of the patent, or with the view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment, and not for a fraudulent purpose, ought not to be considered within the meaning of the prohibition, and, if it were, it is certainly not the subject for an injunction. But where you see a man using a machine, as this defendant has done, under claim of a right to use it, and under that claim of right he makes a quantity of goods, even though a small quantity, I cannot call that an experiment within the meaning of the rule as to experiments. He has made a machine, and, knowing it to be an infringement of a patent, he claims the right to make and use it, and his experiment is made to see how his machine works." (*L. R.*, 9 *Ch. D.* 66.)

(f) *SYKES v. HOWARTH.* Fry, J. [1879]

In an action for infringement of a patent for improvements in fancy rollers by the introduction of wide spaces between the cards in machines for carding wool, the defendant, a card-maker, contracted for a lump sum to clothe certain machines with cards so arranged as to infringe the patent. The "nailer" who fixed the cards, which is a separate business from card-making, was nominated by the owner of the machine, but paid by the defendant.

Fry, J., in delivering judgment, said: "The prohibiting part of the letters patent directs that no person, except the patentee and those who derive title under him, shall, during the period of the existence of the patent, 'either directly or indirectly, do, use, or put in practice the said invention.' 'Putting in practice' is evidently in the mind of the Crown something different from user, and I really do not know what could be 'putting in practice' as contrasted with 'using,' if what the defendant did in this case was not putting in practice the plaintiff's invention." (*L. R.*, 12 *Ch. D.* 832.)

(g) *ADAIR v. YOUNG.* C. A. [1879]

An action was brought against the master of a ship to restrain him from using pumps proved to be an infringement of the plaintiff's patent. The ship had been exclusively fitted up with such pumps before the defendant, who was not a part owner, had taken command; he had nothing to do with putting them on board, and they had never been worked in British waters. An injunction was granted. (*L. R.*, 12 *Ch. D.* 13.)

Brett, L. J., in delivering judgment, said: "A distinction has been attempted to be made between using the pumps and using the invention, but I cannot see any such distinction. It is said that he was bound to have pumps on board, and would be liable if he put to sea without them; that they were necessary to

make the equipment of the ship complete, and that, therefore, the having them on board was using them. Since the master had no power to say whether he would have them on board or not, he cannot, in my opinion, be said to use them unless he used them as pumps. If they are so used, that is a user by him, but in this case he never did so use them within British waters, and, in my opinion, therefore, he never did infringe the patent. . . . Whether there was a user by the owners is a different question, on which I give no opinion." (*Ib.* 19.)

Cotton, L. J., said: "I do not give any opinion whether there has been such a user as would subject the master to an action for damages; but I think we must come to the conclusion that there has been such an intention to use the pumps as to lay sufficient ground for an injunction to restrain the infringement of the plaintiff's patent rights." (*Ib.* 19.)

(h) NOBEL'S EXPLOSIVES COMPANY v. JONES, SCOTT AND CO. H. L. [1883]

Patent for an invention rendering nitro-glycerine less dangerous. Foreigners manufactured abroad an article compounded of nitro-glycerine and other substances according to the patented process, and imported it into England. The defendants, acting as Custom-house agents for the importers, passed the article through the Custom-house, and obtained permission (as required by the Explosives Act, 1875) for landing and storing it in magazines belonging to the importers:—*Held*, that the defendants being only Custom-house agents and not themselves importers, and having neither possession of nor control over the goods, their acts did not amount to an exercise or user of the patent such as to be an infringement. (8 *App. C.* 5; 17 *Ch. D.* 721.)

(i) UNITED TELEPHONE COMPANY v. LONDON AND GLOBE TELEPHONE AND MAINTENANCE COMPANY. [1884]

The defendant company contracted with an American agent for the purchase of 800 Blake transmitters, royalty paid. On the same day, the plaintiff company, who already owned an Edison patent for the same object, became assignees of Blake's patent, and proceeded to disclaim certain parts of the Edison patent, which they were allowed to do on terms that no proceedings for infringement should be taken in respect of (*inter alia*) any instruments manufactured in pursuance of any contract already *bonâ fide* entered into by the defendants. Any question of *bonâ fides* was to be referred to the Attorney-General, who found, as a fact, that the contract in question was made *bonâ fide*. Subsequently, the 800 Blake transmitters, which had not paid royalty, arrived in England, and were placed by the defendants unused in a warehouse, and were afterwards dismantled:—*Held*, that the possession of the machines was an infringement of the plaintiffs' patent rights, and an injunction granted:—*Held* also, that the decision of the Attorney-General in no way affected an action for infringement of the Blake patent. The Court refused to order the destruction or delivery up of the machines. (26 *Ch. D.* 766.)



## (i) UNITED TELEPHONE COMPANY v. SHARPLES. [1885]

The defendant bought telephones abroad, and imported them for the purpose of allowing his pupils to experiment upon them, in order to avoid using similar, but more costly, instruments which had paid royalty:—*Held*, that this was a user for the purpose of advantage, and was an infringement. (29 *Ch. D.* 164; *Griff.* 232.)

## (j) EDISON AND SWAN ELECTRIC LIGHT COMPANY v. HOLLAND. [1888]

The user of an invention for a different purpose may still be an infringement. (5 *O. R.* 483.)

(j<sup>1</sup>) DOWLING v. BILLINGTON. [1890]

The defendants had opposed the plaintiff's application for a patent, and had infringed it both before the acceptance of the specification and after this action was commenced:—*Held*, that although there was no actionable infringement, there was evidence of an intention to infringe, and an injunction was granted with costs. (7 *O. R.* 191.)

## By Vending.

## (k) MINTER v. WILLIAMS. [1835]

*Semble*, the mere exposing an article manufactured by a patent process for sale is not an infringement of the letters patent. (1 *Web. P. C.* 135; 5 *Nev. & M.* 647; 4 *Ad. & Ell.* 251; 1 *H. & W.* 585.)

## (l) GIBSON v. BRAND. N. P. [1841]

The declaration assigned as a breach "that the defendant directly or indirectly made, used, and put in practice the said invention." Tindal, C.J., said to the jury: "If they (the defendants) have themselves sold an article of exactly the same fabric, made in the same manner as that for which the patent was taken out, such sale may be considered as a using of the invention within the terms of the declaration." (1 *Web. P. C.* 630.)

## (m) MUNTZ v. FOSTER. N. P. [1844]

The making of a patent article for sale, although it was in fact never sold or even offered for sale, is an infringement. (2 *Web. P. C.* 101.)

## (n) HIGGS v. GOODWIN. [1858]

The invention for which the patent was granted was "treating chemically the collected contents of sewers and drains in cities, towns, and villages, so that the same may be applicable to agricultural and other useful purpose." The patentee claimed "the precipitation of animal and vegetable matter from sewage water by means of the chemical agent hereinbefore described:—" *Held*, that the defendant, by using the patented process, not with the object of making a saleable mercantile article, but merely to purify the water, did not infringe the plaintiff's patent. (*Ell. Bl. & Ell.* 529; 5 *Jur., N. S.* 97; 27 *L. J., Q. B.* 421.)

(o) *WALTON v. LAVATER.* [1860]

The importation and sale of a patented article is evidence of an infringement. Erle, C.J.: "The next point contended for is, that there has been no infringement by the defendant, because he had only sold the articles, the sale, moreover, being only a sale of articles imported from abroad. I have heard the arguments of the learned counsel on both sides, derived from the original statute, which uses the words 'working and making,' and from the form of the expression in the letters patent prohibiting the making, using, or putting in practice the invention, and the words granting to the patentee the privilege to 'make, use, exercise and vend.' All these words are capable of some of the constructions which have been contended for; but it appears to me that the main purpose of the patent is to give the profit to the patentee, and that the main mode of defeating that purpose would be by selling the patented article; and it seems to me that without proof of the making of the article by the infringer, evidence that he sold the patented article for profit would be good evidence upon which a jury might find that he had infringed the patent. With respect to the defendant not being liable, because the articles were imported from abroad, I should say that, even if it was a simple case of importation, without any proof of knowledge of the article being patented, or of the infringement, it would be sufficient evidence of infringement that the defendant had imported and sold." (29 *L. J., C. P.* 279.) See also *Betts v. Neilson*, p. 160 (*d.*)

(p) *OXLEY v. HOLDEN.* [1860]

The manufacture of a patent article for the purpose of sale, and offering it for sale, although no sale is actually effected, is a user of the invention. (8 *C. B., N. S.* 666; 30 *L. J., C. P.* 68; 8 *W. R.* 626; 2 *L. T. Rep., N. S.* 464.)

(q) *THOMAS v. HUNT.* [1864]

A licence to A. to manufacture a patent article is an authority to his vendees to sell it without the consent of the patentee. (17 *C. B., N. S.* 183.)

(r) *ELMSLIE v. BOURSIER.* Ch. [1869]

The importation into this country and sale here, of goods manufactured abroad, by a process patented in this country, is an infringement of the patent. (39 *L. J., Ch.* 328; *L. Rep.*, 9 *Eq.* 217.)

(s) *BETTS v. WILLMOTT.* Ch. [1870]

A patentee cannot maintain a suit against a retail dealer who unwittingly sells articles which are an infringement of his patent, provided such retail dealer gives full information as to the persons from whom he obtained the articles complained of, and promises not to retail any more. (18 *W. R.* 946; affirmed on appeal, *L. Rep.*, 6 *Ch.* 239; 19 *W. R.* 369.)

(t) *WRIGHT v. HITCHCOCK.* [1870]

*Held*, that the defendants had infringed the plaintiff's patent, by buying and selling in large quantities, articles manufactured by a process which was an infringement of the plaintiff's patent. Upon this point Kelly, C.B., said: "Undoubtedly the statute (21 Jac. 1, c. 3) only authorises the grant of patents for the exclusive 'working or making' of articles of new manufacture. . . . Now, in the first place, although the statute does not contain the word 'vend,' we may naturally look at the construction put upon the statute by the language of the patents which have been granted for more than two centuries, and which we find expressly give to the patentee the exclusive right of, among other things, using and *vending* the article patented. . . . If it is necessary to decide the point, I am clearly of opinion that if a man takes out a patent for a new manufacture, by means of which an article can be made for a price considerably less than by any means theretofore employed, and another buys and sells that article, I do not say upon a single occasion, because each case ought to be determined with reference to its own circumstances, but in the way of his trade, buying and selling the article in large quantities, knowing it to have been manufactured by means of certain machinery, which machinery is *de facto*, though he may not know it, the same as that of the patentee, such buying and selling is an infringement of the patent rights of the patentee." (39 *L. J., Exch.* 103.) Martin, B., said: "I can understand that if a man took out a patent for the manufacture of flour by means of a new apparatus, and the flour produced was the identical thing produced by another mill, then there would be great difficulty in holding a sale of the flour to be an infringement of the patent. But there is here a great improvement in the article manufactured by the machinery; and it was made more quickly and cheaper than before." (*Ib.* 104.) Pigott, B.: "If he merely bought a small quantity, not knowing where it came from, for his own use, that might not be infringing the patent." (*Ib.* 106.)

(u) *TOWNSEND v. HAWORTH.* M. R. & C. A. [1875]

Bill to restrain A. and B. from infringing a patent for the use of well-known chemical substances, in a specified manner, to obtain a particular result:—*Held*, by Master of the Rolls, and judgment affirmed by Lords Justices, that:—

- (1) A. does not infringe the patent by selling the known chemical substances to B., with knowledge that B. intends to use them in infringement of the patent, the validity of which he disputes.
- (2) If A. sells the known chemical substances to B., not only with knowledge that B. intends to use them in infringement of the patent, but also, in consideration of such purchase, indemnifies B. from all consequences of such purchase and use, both A. and B. knowing the patent to be *valid*, the agreement for indemnity is invalid as against public policy, and A. is not guilty of an infringement.

- (3) If, under the same circumstances, the patent is disputed or likely to be disputed, the indemnity is valid, but A. is not guilty of an infringement.

(Affirmed on appeal to Court of Appeal. Not reported—for imperfect note of judgment see *L. R.*, 12 *Ch. D.* 831 (*n.*). As this case is an important one, and is not to be found in the books, the judgment of the Master of the Rolls is given at length.)

Jessel, M.R.: “The plaintiffs have a patent for preserving certain vegetable substances, take cotton, for instance. They say you preserve cotton from mildew by dipping it into a solution of certain chemical substances. That is a broad way of putting it. Chief of those chemical substances are substances which are perfectly well known, and most of them are common substances; they are all old chemical compounds, and there is no claim in the patent at all, except for the peculiar use of these chemical compounds for the purpose of preserving the cloth from mildew. No one has contended, and no one can contend, I should think, with any chance of success in a court of justice, that the vendors of those chemicals may not continue to pursue their trade as heretofore, and supply the chemicals to any one who chooses to buy them. No one has said, as far as I am aware—when I say ‘no one,’ I mean no judge has said—that the vendor of an ordinary ingredient commits a crime or an offence, or does even a wrong, if the purchaser, coming to him, says, ‘I want your compound because I want to preserve my cloth from mildew, and you and I know there is a patent, but still I wish to try the question with the patentee.’ No one would doubt that the sale would be perfectly legal, and would not enable the patentee to complain, with effect, of the conduct of the vendor of the chemical compound in a court of justice.

“But it is said that if the person who sells the compound goes a step further, and not only supplies it with the knowledge that it is to be used in the infringement of a patent, but says: ‘If you buy my compound of me I will indemnify you from all consequences,’ that makes him an actual infringer of the patent. Now that must be put in one of two ways. Either he knows the patent to be valid, or he believes it to be invalid or capable of being disputed, and I asked the counsel for the bill whether, in the first case, both the purchaser and the vendor being perfectly aware that the patent was a valid patent, and that the infringement therefore was a wrongful act, the agreement for indemnity would not be against public policy, and therefore invalid. Now it does appear to me that there is a great deal to be said for that proposition, and in the absence of authority I should have thought that an agreement to induce another to commit a wrongful act of that character, as a rule using the word ‘wrongful’ in its natural sense, that which is prohibited by law, was invalid as being against public policy. In fact, our law has gone a great deal further, because it has held that contracts to supply goods for immoral purposes are invalid, not merely prohibited directly by law, but things to which the common law did not reach by direct

prohibition, and I confess I should have thought such a contract was not enforceable—when I say ‘enforceable,’ I do not mean really not enforceable in the Court, but was a contract upon which an action at law could not be maintained. If, therefore, the meaning of the allegation in the bill is this, that both parties were thoroughly well aware that the patent was valid, but that the defendants, the company, with the view of making a profit on the sale of the chemical compounds, agree to indemnify the purchaser, Mr. Haworth, from all actions to which he would become liable, as a matter of course, at the suit of the owners of the patent, it does appear to me that such an agreement would not be binding. On the other hand, if the patent were doubtful, as every man has a right to dispute a patent, and as every man has a right to say that ‘the existence of this patent shall not interfere with carrying on my business as usual,’ as every man must have a right to say to the purchaser of his goods, ‘there is no valid prohibition against my selling them, the alleged patent is invalid, and I will indemnify you from the consequences.’

“The notion of any other doctrine being upheld seems to me fraught with the most tremendous consequences. You would not only give patentees who have good patents a monopoly, but you would also give patentees with bad patents a monopoly, because they would be enabled to say, no man shall supply goods which are not protected by the patent, with a guarantee to the purchaser to save him harmless from the hands of the patentee, and we know what the effect of a threat of attack, even by the holder of an invalid patent has, as a general rule, in deterring persons from purchasing the goods so alleged to be protected. Therefore, I am of opinion that if the patent were disputed, or likely to be disputed, this indemnity would be valid, and could not be attacked in any shape or in any way. Now, taking the second case, if that were the view of the defendants, I am satisfied that it was no harm if they sold the goods for the express purpose of their being used in the infringement of the patent, or thought the patent fairly open to dispute. Therefore, if that is the true construction of the bill, I think they did nothing wrong whatever, and in no way could they be said to be direct infringers of the patent. They sold the goods for the purpose of being used, no doubt, for the infringement of the patent, but the indemnity they gave does not appear to add to the case at all, unless you can make out the broad proposition, which I think was not contended for, that any person selling any article, either organic or inorganic, either produced by nature or produced by art, which could in any way be used in the making of a patented article, can be sued as an infringer, if he knows that the purchaser intends to make use of it for that purpose. I do not think that broad proposition was attempted to be supported, and if that cannot be supported, as it appears to me it cannot, then in the second case it seems to me to be perfectly plain that the company in question could not be sued as infringers.

“I now come to the first case, that they both knew at the time that the patent was valid. Now, the whole of the case, if it can be supported at all, depends on the knowledge of the validity, because the *bonâ fides* of the transaction depends entirely on that knowledge. Now the rule is, that allegations should be taken against the pleader if there is any doubt about them, and of all allegations in the world, allegations which impute fraud, or intent to commit a wrong, must be plain, clear and indubitable. Now, I must say I cannot find any such allegations in this bill. I cannot find, though it may have been present to the mind of the draftsman, the allegation, and I am not sure that the defendants, the company, being well aware that the patent was valid, supplied these goods with intent to enable Mr. Haworth to infringe it. I am by no means of opinion that the allegation was left out accidentally. I think it will probably turn out that there was a contention or intended contention as to the validity of the letters patent. But, supposing it had been in, then comes the much more difficult question, as to whether a person who so acts can be treated by the inventor as an infringer of the letters patent. Now, what is he prohibited from doing? He is prohibited from making, using or vending the patented article, and that, of course, includes, in the case of machinery, the product, if I may say so, of the machinery which is the subject of the patent. It is that which is produced by the patent. To that extent I entirely concur with what has been said as to the exposition of the law. But has any one ever dreamt, before this case, that that extends to the component articles which enter into the patent? So far from that being the law, it has been decided that, in cases of what they call combination patents, it is only the combination claimed that may not be used; the other elementary combinations may be used. No doubt there has been a great deal of litigation on the question as to what were the combinations claimed, that is, whether in claiming the entire combinations you claim the subsidiary combinations or not. But the whole of the arguments have proceeded on the assumption, that you could not even complain of the use of subsidiary combinations, unless they were within the purview of your claim. The lines of cases seem to me to show conclusively that the mere making, using or vending of the elements, if I may say so, which afterwards enter into the combination is not prohibited by the patent, and, if not prohibited, I do not see how I am to extend the patent laws to make a new prohibition. But it is said, and the way it has been put does great credit to the ingenuity of counsel, that, although that may be very good law, if you show the vendor was merely using the infringer as his agent, or partner, he will be an infringer; or, to put it into common language, if the infringer were the mere cat's-paw of the vendor, that would raise a totally different question. That would raise this question, who was the actual infringer? It is not the man who puts his hand to the machine who is the infringer. The mere workman employed is not the infringer. Of course, I agree that you may pass over the mere mechanic, who puts the machine

together, and get at his employer, and if it could be shown, or if it were shown, by sufficient allegation, that the company intended to carry on the business of making these cloths, knowing that the patent was valid, but being unwilling to incur the risk of actions for infringement, set up Mr. Haworth to carry on the trade, supplied him with the material on which they got the real profit, which arose from the patented article, and that he did not carry on the trade *bonâ fide* for himself, but on their behalf, a totally different set of considerations would arise, and it might well be they would be treated in this Court as the actual infringers, and not Mr. Haworth. When that case is made out, it will be time enough to consider it. But this bill does not make that case. This bill treats the company as proper defendants, solely and simply on the ground of their *bonâ fides* in endeavouring to sell for their own profit, not as selling to a person who would not have bought of them without an indemnity, and, therefore, would not have infringed in that way without they had given him an indemnity. I think that is not only a novel case, but it is an attempt to extend the patent laws beyond their purport that such permission ought to be granted now by me, at all events for the first time, and, therefore, I allow the demurrer."

(v) *DIXON v. THE LONDON SMALL ARMS COMPANY LIMITED.* H. L. [1877]

A patent in the usual terms was granted for an improvement in the manufacture of fire-arms. The Secretary at War issued a notice for a tender for the supply of 13,875 rifles of the description known as that patented. The price was settled, minus the cost of the steel barrels and the stocks, which the War Office was to supply. The rifles were to be delivered within a certain time, the manufacture of them might be inspected at any time, and they might be rejected by officers at the War Office, if not made according to pattern, or not delivered in time. The persons who took the contract employed the patented process in the formation and insertion of the lock:—*Held*, by the House of Lords (*L. R.*, 1 *App. Cas.* 632), reversing the Court of Appeal (*L. R.*, 1 *Q. B. D.* 384), and affirming the Queen's Bench Division (*L. R.*, 10 *Q. B.* 130), that they were liable to the patentee for an infringement of the patent, for that they were not servants or agents of the Crown doing the work of the Crown, but were private contractors with the Crown to supply a certain manufactured article, and were, therefore, not protected in what they did by any particular privilege attaching to the Crown.

Lord Cairns, L.C., said: "If they (respondents) were the servants and the agents of the Crown, acting on behalf of and for the use of the Crown, then it may be that they would have the privileges with reference to the patent which the case of *Feather v. The Queen* (6 *B. & S.* 257) decided to remain in the Crown, even although there is nothing whatever in the contract expressly taking notice of those privileges, or autho-

rizing the respondents to exercise them. . . . Is it the case that the respondents in the appeal before your lordships fill the position of officers, agents or servants of the Crown, acting on behalf of and for the use of the Crown? Now, my lords, in order to answer that question you must turn to the contract itself. . . ." The person who is called the contractor is "a tradesman, and not the less a tradesman because he is engaged in works of a very large and extensive character; he is a tradesman manufacturing certain goods for the purpose of supplying them according to a certain standard which is laid before him as a condition on which the goods will be accepted." (*L. R.*, 1 *App. Cas.* 641, 642, 644.)

Lord Penzance: "I think the true distinction in this case is between an authority or mandate to do a thing for a money reward, in the doing of which, whether the individual is a servant or only a contractor, he is all along acting as an agent, and a contract for the supply and acceptance, if approved, when completed, of an article to be made by the contractor, in the making of which the contractor, though working under inspection, is *all along acting on his own behalf* and at his own risk." (*Ib.* 654.)

(w) *SYKES v. HOWARTH.* [1879]

Fry, J.: "Selling articles to persons to be used for the purpose of infringing a patent is not an infringement of the patent." (*L. R.*, 12 *Ch. D.* 833.)

(x) *VON HEYDEN v. NEUSTADT.* C. A. [1880]

A person who makes, or procures to be made, abroad a product according to a patented process for sale in this country, and sells the product here, does indirectly make, use, and put in practice the patented invention. When a patent has been granted in England for a new process for producing more cheaply a chemical product previously known, the importation and sale of this product made abroad according to the patented process is an infringement of the patent. (14 *Ch. D.* 230.)

(y) *SOCIÉTÉ ANONYME DES MANUFACTURES DE GLACES v. TILGHMANS PATENT SAND BLAST COMPANY.* C. A. [1883]

The defendants, who were the owners of patents in Belgium and England for making globes, by deed executed in Belgium, granted a license to the plaintiffs for the term of twenty years to use and employ the invention at their manufactory of Val St. Lambert and not elsewhere. The plaintiffs under the license manufactured the articles in Belgium and sold them in England:—*Held*, that this was an infringement of the English patent and was not covered by the license. (25 *Ch. D.* 1.)

(z) *UNITED TELEPHONE COMPANY v. HENRY.* [1884]

Where a workman of the defendant obtained two instruments, constructed in accordance with the specification, on loan from the



defendant, but at the time signed a memorandum that the defendant refused to sell them to him:—*Held*, that there was no intention to sell and no infringement. (*Griff.* p. 228; 2 *O. R.* 11.)

(a) *CARTSBURN COMPANY v. SHARPE.* [1884]

In proceedings against the respondents for infringing a patent by selling cubes of sugar, manufactured by means of apparatus substantially the same as that described in the specification, it was proved that the cubes sold were manufactured in America by a machine very similar to the complainer's machine, but there was no evidence that the machine so used possessed any of the characteristic features by which the complainer's specification was distinguished from previous patents. It also appeared that the articles sold might have been produced by machinery which involved no infringement of the complainer's patent:—*Held*, that it did not lie on the respondents to prove that the articles were not manufactured according to the specified process, and that the complainers had failed to prove their case." (1 *O. R.* 181.)

(b) *GWYNNE v. DRYSDALE.* [1886]

In an action for infringement of a patent for arranging a pump case with the suction and discharge pipes to swivel so as to be set at any angle without interfering with the driving engine, it was proved that the defendants had sold three pump cases in which the pipes were capable of being moved round, but only to definite angles determined by bolt holes through which the bolts passed:—*Held*, that the important points in the plaintiff's patent were that the rotation might be made without disengaging the screws, and that the screws might be clamped in any position without interfering with the engine, and consequently that there was no infringement. The defendants had also offered in answer to enquiries instigated by the plaintiffs to supply a swivelling pump:—*Held*, that as the plaintiff's patent did not embrace every arrangement of swivelling, the defendants must be presumed to have meant to supply something which was not an infringement. (2 *O. R.* 160.) On appeal to the Court of Sessions these findings were upheld. (3 *O. R.* 65.)

*By working or making a new and material part of an Invention.*

(c) *HILL v. THOMPSON.* [1818]

In a patent for a combination of processes altogether new, leading to one end, any use made of any of the ingredients singly, or any use made of such ingredients in partial combination, some of them being omitted, or any use of all or some of such ingredients in proportions essentially different from those specified, and yet producing a result equally beneficial with the result obtained by the proportions specified, will not constitute an infringement. (8 *Taunt.* 391; 2 *B. Moo.* 448; 1 *Web. P. C.* 242.)

(d) *GILLET v. WILBEY.* N. P. [1839]

Coltman, J., in summing up the case to the jury, said: "The plaintiffs must make out to your satisfaction that the whole of the improvements were new, and that some of them had been pirated. It is not necessary that they should use them all, but they must be shown to be all new, and if they are all new, and the defendant has infringed any one of them, it will be sufficient to support the action, and it is not necessary that he should have infringed them all." (9 *Car. & P.* 336.)

(e) *MUNTZ v. VIVIAN AND WALKER.* [1840]

In a suit to restrain infringement it appeared that the patentee claimed "The manufacture of metal plates of an alloy of copper and zinc in such proportions as will enable the manufacturer to roll the said alloy while at a red-heat into sheets fit for the sheathing of ships, and will be sufficiently ductile to dress close to the bottoms of such vessels, at the same time that it is more durable than copper, and oxidates sufficiently to keep the said bottoms clean." The defendants manufactured sheets of an alloy of copper and zinc within the proportions stated in the specification, but they rolled them cold:—*Held*, by Shadwell, V. C., that the rolling hot was a material feature and an interim injunction refused. (2 *Webs. R.* 87.)

(f) *NEWTON v. GRAND JUNCTION RAILWAY COMPANY.* [1846]

Pollock, C.B.: "It was argued that the same criterion is to be applied to the question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty, you take the entire invention, and if, in all its parts combined together, it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent. But, in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part, for the purposes for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement." (5 *Exch.* 334.) Alderson, B.: "If the invention consists of something new and a combination of that with what is old, then, if an individual takes for his own and uses that which is the new part of the patent, that is an infringement of it." (*Ib.* 335.)

(g) *SELLERS v. DICKINSON.* [1850]

Pollock, C.B.: "There may be an infringement by using so much of a combination as is material, and it would be a question for the jury whether that used was not substantially the same thing." (5 *Exch.* 324.) "I think it may be laid down as a general proposition (if a general proposition can be laid on

a subject applicable to such a variety of matters as patent law—matters, indeed, incommensurable with each other, for the same doctrine which would apply to a medicine would scarcely apply to a new material or a new metal), that if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes, for the other matters combined with it, another mechanical equivalent, that would be an infringement of the patent.” (*Ib.* 326.)

(h) *THE ELECTRIC TELEGRAPH COMPANY v. BRETT.* [1851]

The breaches alleged in the declaration were that the defendant had used and counterfeited the *said invention*; the evidence was, that the defendant had used or counterfeited *part only*. The specification described nine several improvements:—*Held*, that the declaration, in speaking of the *said invention*, was to be understood as charging the using or counterfeiting of the said *nine* improvements, and that it was sufficiently proved by showing that *one* of them had been used. (10 *C. B.* 838; 15 *Jur.* 579; 20 *L. J., C. P.* 123.)

(i) *NEWTON v. VAUCHER.* [1851]

A. obtained a patent for an improvement in packing hydraulic and other machines, by means of a lining of soft metal, and thereby of rendering certain parts of such machines air and fluid tight. B. afterwards discovered that soft metal had the property of diminishing friction, and of preventing the evolution of heat when applied to the surfaces in contact of machines in rapid motion and subject to pressure, and he embodied the application of that discovery to machines in a patent:—*Held*, that the application of the soft metal by B. differed essentially from that of A., and that there was no infringement. (6 *Exch.* 859.)

(j) *SMITH v. THE LONDON AND NORTH WESTERN RAILWAY COMPANY.* [1853]

Action for the infringement of a patent for an improved wheel. In the claim, the patentee stated that the new invention consisted in the circumstance that the centre boss, or nave, arms, and rim of the said wheel were wholly composed of wrought or malleable iron, “welded into one solid mass, *in manner hereinbefore described.*” The defendants used a wheel, made by welding pieces of wrought iron so as to form a single compact piece of wrought iron; the mode of forming the nave was the same as that in the specification; the mode of forming the rim was different:—*Held*, that it appearing that the mode of forming the nave was a material, new, and useful part of the invention, the use of it by the defendant was an infringement of the patent. (2 *Ell. & B.* 69; 17 *Jur.* 1071.) Campbell, C.J., in delivering the judgment of the Court, said: “Where a patent is for a combination of two, three, or more old inventions, a user of any of them would not be an infringement of the patent; but, where there is an invention consisting of several

parts, the imitation or pirating of any part of the invention is an infringement of the patent." (2 *Ell. & B.* 76.)

(k) *MOREWOOD v. TUPPER.* [1855]

A patent was taken out for causing sheets of metal to be passed through molten zinc in such a way as to secure their complete immersion. This was effected by the sheets passing between rollers in contact with metal kept molten in a suitable pot. Another mode was by causing the sheets to be passed under a bar placed below the surface of molten metal, in combination with certain guides. *Quære*, whether a bar alone, when so placed for the purpose of ensuring complete immersion by passing sheets of metal under it, is the proper subject of a patent. *Semble*, per Parke, B., that if the patent is good for the bar alone, the use of the bar by the defendants, though for a purpose different from that of the plaintiff's, is an infringement. (3 *C. L. Rep.* 718.)

(l) *BOVILL v. KEYWORTH.* [1857]

A patent obtained for a new combination of a blast and an exhaust in connection with a mill, in which only the *lower* stone rotates, is infringed by the use of the same combination in connection with a mill in which the *upper* stone rotates. (7 *Ell. & B.* 725.) Campbell, C.J., in delivering the judgment of the Court, said: "Supposing the patent to be for a combination, consisting of several parts, for one process, we are of opinion that the defendants are liable in this action for having used a material part of the process, which was new, for the same purpose as that mentioned in the specification, although they did not at the same time use all the parts of the process as specified." (*Ib.* 737.)

(m) *DE LA RUE v. DICKINSON.* [1857]

The specification of a patent for an invention of "improvements in the manufacture of envelopes" described a machine in which a piece of paper was held upon a platform whilst the flaps of the envelope were folded, and concluded by claiming "the so arranging machinery that the flaps of envelopes may be folded thereby as herein described:"—*Held*, that a machine in which the flaps of an envelope were folded might be an infringement of the patent, although the envelope was not held down during the operation of folding.

The specification of a patent for an invention with a similar title described and claimed "the application of a gum or cement to the flaps of envelopes by apparatus acting in the manner of surface-printing:"—*Held*, that an apparatus for applying the gum might be an infringement, although it acted only in part in the manner of surface-printing according to the description contained in the specification. (7 *Ell. & B.* 738; 3 *Jur., N. S.*, 841.)

(n) *FINLAY v. ALLAN.* [1857]

An inventor patented improvements on fire-grates, of which the principal feature was an overhanging door of novel construction, causing a double draught. In his specification he claimed as part

of the invention secured to him by the patent "the application and use" of a detent link or holder of a peculiar form to retain the door in its position, but which was proved to have been previously used and applied to grates without overhanging doors:—*Held*, that the use of a similar detent link, when applied to an overhanging door, but which did not produce a double draught, was not an infringement of the patent. (19 *Dec. of Crt. of Sess., 2nd Series*, 1087.)

(o) *LISTER v. LEATHER.* Ex. Ch. [1858]

A valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process, without any express claim of particular parts, and notwithstanding that parts of the combination are old. (8 *Ell. & B.* 1004: affirmed in Ex. Ch., *Ib.* 1031.) Williams, J., in delivering the judgment of the Court of Exchequer Chamber, said: "It was argued before us, on behalf of the appellants, that, if a patent be taken out for a combination of *a*, *b* and *c*, it could not be infringed by using a combination of *b* and *c* only. We are of opinion that the answer to this inquiry turns altogether upon what *a*, *b* and *c* are, how they contribute to the object of the invention, and what relation they bear to each other. Cases may possibly be suggested where the use of *b* and *c* might not be an infringement of the patent; but more easily cases may be put where the use of *b* and *c* would be an infringement of the patent. Whether in this case it was so or not would depend upon the facts of the case, and may be more a question of fact for the jury than of law for a court of appeal. But the facts are not before us; and we think the court below was right in deciding that the use of a subordinate part of a combination might be an infringement of the patent if the part so used was new (by which we understand new in itself, or in its effects, not merely in its application) and material." (*Ib.* 1033.) But see *Harrison v. Anderston Foundry Company*, *inf.* p. 180 (*d*).

(p) *THE PATENT BOTTLE ENVELOPE COMPANY v. SEYMOUR.* [1858]

The plaintiff obtained a patent for "improvements in the manufacture of cases or envelopes for covering bottles," and in the specification the invention was stated to consist "in an arrangement of apparatus by which lengths of rush, straw or other suitable material may be readily tied together, so as to form cases or covers to protect bottles from breakage when packed." It then proceeded: "For this purpose I take equal lengths of rush, straw or other suitable material, and confine them at one end within a ring or cap, which I then place over the neck end of a mould or mandril, corresponding in form to the bottle for which the case or cover is intended":—*Held*, that the use of the mandril, which was admitted to have been long commonly used for producing given forms of pliable materials, and the application of which to work previously untried materials or to produce new forms, was held not to be the subject of a patent, was not an infringement of the plaintiff's patent. (5 *C. B., N. S.*, 164; 5 *Jur.*,

*N. S.*, 174; 28 *L. J., C. P.* 22.) Willes, J., in delivering the judgment of the Court, said: "The infringement of any part of a patent process is actionable, if that part is of itself new and useful, so that it might be the subject-matter of a patent, and is used by the infringer to affect the object, or part of the object, proposed by the patentee." (5 *C. B., N. S.*, 172.)

(*q*) *THOMAS v. FOXWELL.* [1858]

Evidence may be admitted of an infringement by an imitation of a material part of a general combination, notwithstanding the disclaimer of the mechanical parts separately, of which the combination consists, and although there be no separate and specific claim in respect of the part imitated, while there are separate and distinct claims in respect of other subordinate combinations. The jury ought not to find for the plaintiff upon the plea of not guilty, unless they are convinced that the defendant has imitated a part of the plaintiff's combination, both substantial and new, and for the same purpose. (5 *Jur., N. S.*, 39.)

(*r*) *SEED v. HIGGINS.* *H. L.* [1860.]

The plaintiff claimed by his specification and disclaimer the application of centrifugal force in the particular manner described in the specification. The particular manner described was by the use of "a weight." The defendant employed a machine similar in many respects, but, though using weight, or pressure occasioned by weight, as a force, did not use "a weight":—*Held*, that this did not amount to an infringement of the plaintiff's patent. (8 *H. L. Cas.* 551.)

(*s*) *M'CORMICK v. GRAY.* [1861]

A patent for a reaping machine, the several parts of which are not claimed, is not infringed by the manufacture of the blade or cutter similar to that described in the specification, which does not of itself constitute a machine; but the patent may be infringed by a person who subsequently makes the cutter into a machine which is identical, or an imitation of the plaintiff's machine. (31 *L. J., Ex.* 42; 7 *H. & N.* 25.) Martin, B. (*dubitante*), said: "I think it a very arguable question whether, if a man has invented a machine consisting of several parts, one of which when in the machine effects a cutting purpose, it would be competent for a manufacturer to manufacture that very part so as to make any person who put it into a machine and sold it, liable to an action for an infringement of the patent." (31 *L. J., Ex.* 47.)

(*t*) *LISTER v. EASTWOOD.* [1864]

Where a patent is for a combination, a person who takes a new and material part of the combination, but does not apply it to a similar or analogous purpose to that to which it was applied in the patent, does not infringe the patent. (9 *L. T. Rep., N. S.*, 766.)

(u) *WHITE v. FENN.* [1867]

If a patent be taken out for an invention by means of a combination, the use of a subordinate part of the combination is no infringement of the patent, unless such part is new and material. (15 *W. R.* 348; 15 *L. T. Rep., N. S.* 505.)

(v) *BOVILL v. CRATE.* [1867]

The plaintiff's patent being for an improved method of exhausting air which accumulated round millstones in grinding, the defendant objected that the plaintiff was limited by his claim to exhaustion by a superadded blast, and that as the defendant did not use a superadded blast there was no infringement:—*Held*, by Wood, V.-C., that as the superadded blast was not brought forward as new, but the removal of the accumulated air, the defendant had no right (even assuming that the patent was for a combination of using the blast with drawing away the air) to take that portion of the invention which would exactly effect the same thing, because he could apply it to another particular form of blast. (2 *Griff.* 46.)

(w) *BOVILL v. SMITH.* [1868]

This was an action for infringement of the same patent as that in the preceding case. The defendant's apparatus could be made if properly used, by means of slides, to keep the machine clear of stive and damp and heat sufficiently to prevent the accumulation of moisture—i.e. to produce the effect which the plaintiff produced:—*Held*, to be an infringement. (2 *Griff.* 49.)

(x) *TATHAM v. DANIA.* [1869]

The plaintiff's patent was for improvements in machinery for teasing and opening textile materials, and showed the ordinary toothed cylinders of a cotton hard-waste breaker machine or devil, and the common feed-rollers, but the cage-roller, which in other machines worked in stationary bearings, was made to rise and fall and to revolve at any required speed. The only part which the defendant had adopted was the mode of retarding the cage. Willes, J.: In such a case, in order to show infringement, "you must show that that which had been infringed and made by the alleged pirate is a use in his machine of such part of that which is described in the specification as could stand by itself in respect of invention and in respect of use as the subject of a distinct patent. . . . I am satisfied that it (the retardation of the cage) could not have been the subject-matter of a patent, because the use of sets of rollers in a series going at different rates of speed for the purpose of making materials not of the same kind, but of a like kind, pass through in a form more convenient, . . . was in use before. I apprehend that is the use of an old process applied to another state of things, . . . different only in the circumstances and not in the species." (*Griff.* 213 at p. 215.)

(y) *PARKES v. STEVENS.* Ch. [1869]

Action for the infringement of a patent for "improvements in

the manufacture of railway station and other lamps." The specification declared the invention to consist in the production of "a glaze lamp, the frames of which shall throw little or no shadow, and yet at the same time possess the requisite strength, and also facilities for lighting and cleaning." The patentee claimed only "the arrangement and combination of parts hereinbefore described and represented in the drawings:"—*Held*, that the use by the defendant of a sliding spherical door, which, although its advantages were altogether collateral to the objects of the invention, was a feature in the plaintiff's lamps, and described in his specification, was no infringement of the plaintiff's patent. (*L. R.*, 8 *Eq.* 358; 38 *L. J.*, *Ch.* 627.) Sir W. M. James, V.-C.: "The patent being for the arrangement and combination of parts so as to form an entire lamp, and not being for, or claiming to be for, any particular part, the last question arises, is the introduction into a lamp, which is not alleged in any other respect to have adopted any part of the plaintiff's arrangement and combination of a sliding door, an infringement? The plaintiff's counsel have contended that it is, on the authority of the case of *Lister v. Leather*. . . . . The authority of that case has been pressed upon me as if it really established this, which would be a most startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was new and material, and that went to make up the combination. The marginal note, if read hastily, is calculated to give some colour to that contention. But if the judgment be read, it will be found to give no warrant whatever for such, I must call it, baseless notion." (*L. R.*, 8 *Eq.* 366.) "To say that a patent for an entire combination is a valid patent for a part, when that part would not have itself been patentable, is, in my judgment, a *reductio ad absurdum* of the supposed principle of *Lister v. Leather*." (*Ib.* 368.) Judgment affirmed on appeal. (*L. Rep.*, 5 *Ch.* 36.)

Hatherley, L. C., however, said: "If this door was plainly and manifestly a new part, forming part of the whole combination, it ought not to be taken." (*Ib.* 39.)

(z) *WRIGHT v. HITCHCOCK*. [1870]

The plaintiff obtained a patent "for the invention of improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The specification described the invention as relating "to a peculiar manufacture of frills, ruffles, or trimmings, and to a peculiar combination of mechanism to be applied to a sewing machine for producing the same." The specification described how the fabric was folded or crimped by a reciprocating knife, and the folds stitched by a sewing machine. The patentee claimed—"First, the general construction, arrangement and combination of machinery, apparatus, or means for producing crimps or plaited frills or trimmings in a sewing machine, as hereinbefore described. Secondly, the application and use of a reciprocating knife for crimping fabrics in a sewing machine, substantially as hereinbefore described. Thirdly, the



peculiar manufacture of crimped or plaited frills or trimmings, as hereinbefore described and illustrated by figure 8 of the drawings:”—*Held*, first, that the essential improvement, introduced by the plaintiff, was the use of a reciprocating knife, and that the patent did not apply simply to its use in combination with a sewing machine, and therefore, that the use of the reciprocating knife, separately from a sewing machine, was an infringement of the patent. (*L. R.*, 5 *Ex.* 37; 39 *L. J.*, *Exch.* 97.)

(a) *CANNINGTON v. NUTTALL.* H. L. [1871]

Per Lord Westbury: If there is a patent for a combination of machinery, originally directed to one purpose, and a person afterwards adopts that combination in order to make it minister to another and additional purpose, his doing so constitutes an infringement of the patent. (*L. Rep.*, 5 H. L. 205.)

(b) *SAXBY v. CLUNES.* [1874]

A patent not only protects the entire apparatus, but also every part of it which is new and material, but if the defendant's apparatus, although for the same object, be a new and different apparatus, not copied from the plaintiff, and there is not used in its construction any part of the plaintiff's apparatus which was new and material, there is no infringement:—*Held*, on the facts, that the apparatus of the defendant for actuating railway points or signals was not an infringement of the plaintiff's patent. (43 *L. J.*, *Exch.* 228.)

A patent for a mechanical arrangement whereby a particular operation may be performed for a particular purpose, the parts of the apparatus not being new in themselves, but thus first combined for that particular purpose, is not infringed by the adoption of the same arrangement or combination of parts for a similar purpose if the mode of operation is sufficiently distinct and different in principle, and the object achieved is also sufficiently distinct or novel, and does not form an essential part of the patent. (*Ib.*)

(c) *BINNEY v. FELDTMAN.* [1875]

A patentee claimed as his invention “A packing (for stuffing boxes) composed of fibrous strands impregnated with powdered mineral lubricant, combined with a cover of braided, woven, or knitted fabric.” The defendant used for the same purpose a woven cover of fibrous material lined with one or more layers of cotton wick, the central space filled with soapstone or lubricating material, either dry or moist. The effect of moving the defendant's packing about was that naturally the lubricant became more or less absorbed into the cotton wick lining, and so produced a packing practically coinciding with the description in the patent:—*Held*, that as the claim in the patent was clearly intended to cover a designed impregnation of fibrous strands before they were enclosed in an outside covering, there was no infringement. The ground was perfectly open and clear to any person who might discover that it was better not to impregnate strands at all, but to

provide a bag with an inside surface of an absorbent description, and then to fill up that bag with powder in bulk. (*Griff.* 49.)

(d) *HARRISON v. ANDERSTON FOUNDRY COMPANY.* H. L. [1876]

Lord Cairns, L.C.: "If it is clear that the claim is for a combination, and nothing but a combination, there is no infringement unless the whole combination is used, and it is in that way immaterial whether any or which of the parts are new. If, indeed, it were left open on the specification to the patentee to claim, not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate and subsidiary parts are new and material, as it was held a patentee might do in *Lister v. Leather* (8 *Ell. & B.* 1004), then it might be necessary to see that the patentee had carefully distinguished those subordinate or subsidiary parts and had not left it *in dubio* what claim to parts, in addition to the claim for combination, he meant to assert. . . . In the present case, however, no question of this kind appears to me to arise. The patentees claim, as I have said, for a combination under their first claim, calling it 'the construction and arrangements of the parts of mechanism herein distinguished, generally,' and in their second, third and fourth claims they have specified the subordinate or subsidiary parts to which they lay claim as novel, and the specification of these subordinate or subsidiary parts appear to me to exclude the possibility of a claim for any other parts as novel." (*L. R.*, 1 *App. Cas.* 578.)

Lord Chelmsford: "It is unnecessary for the determination of this appeal to consider the propriety of this decision (*Lister v. Leather*); but I cannot forbear expressing a doubt whether it can be supported. If a patent is solely for a combination nothing is protected by it, and consequently nothing can be infringed but the use of the entire combination." (*Ib.* 581.)

Lord Penzance: "The case of *Lister v. Leather* has been cited and commented upon as an authority for the proposition that a patent for a combination covers and protects all subordinate combinations, or parts, or at least such of them as are new and material. It is plain, however, that that case did not go this length. . . . It decided nothing more than this, that though the patent is for a combination, it does not follow that there can be no infringement of it unless every part of that combination, without exception, is pirated. What the Court said was, that the taking of a subordinate part or parts of the combination *might* be, not that it necessarily would be, an infringement of the patent; and that, whether it would be so or not depended, as the Court of Error said, 'upon what the parts taken were, how they contributed to the object of the invention, and what relation they bore to each other.' This only amounts to saying that on a question of infringement the essential nature of the invention will be regarded; and that there may be cases in which, though the patent is for an entire combination of numerous parts, a collusive imitation of that invention may be effected though some detail of the combination is omitted

or changed, which is a doctrine familiar enough in patent law.” (*Ib.* 593.)

(e) *CLARK v. ADIE* (First App.) C. A. & H. L. [1875-7]

James, L.J., delivering the judgment of the Court, said: “Upon the authority of *Smith v. London and North Western Railway Company* (4 *Ell. & B.* 69), it has been strongly contended before us, that whenever there is a patent for a combination that patent gives protection, not, indeed, to every distinct thing that enters into the combination, but to every combination, arrangement and aggregate of two or more of those distinct things, even although such subordinate combination is not expressly or impliedly claimed in the specification.

“This, in our opinion, is so startling a violation of every principle of patent law, that we doubt whether we could follow any authority short of the House of Lords in applying such a doctrine. If a patent for a combination of several parts is in reality a patent, and gives really a monopoly for every combination of any two or more of those parts, then it follows, from the first principle of patent law, that if any conceivable combination of any two or more parts was old the patent would be bad. On the other hand, if the patentees say, ‘No, we do not claim to protect every combination of those parts, but only those subordinate combinations or parts of the combination which are new and useful,’ then such a claim would be entirely inconsistent with the leading case of *Foxwell v. Bostock* (12 *W. R.* 723), which, we may be permitted to say, is as good sense as it is sound and intelligible law. . . . I will state what we conceive to be the real principle which underlies the case of *Lister v. Leather* (8 *E. & B.* 1004), and which reconciles it with the other cases and with general principles and common sense. A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact, every, or almost every, patent is a patent for a new combination. The patent is for the entire combination, but there is, or may be, an essence or substance of the invention underlying the mere accident of form; and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination. . . . If a man really wants to patent, not only the whole but something less than the whole of what he calls ‘a new arrangement, construction and combination of parts,’ he must clearly show that he claims that something less—of course periling his patent if that something less is not a novelty.” (*L. R.*, 10 *Ch.* 674.)

On appeal to the House of Lords, Lord Blackburn said: “I incline to agree with what was said by the Exchequer Chamber in the case of *Lister v. Leather*, that you cannot decide in the abstract whether the using of two parts, A and B, of a combination of A, B and C, is or is not using part of that invention, nor can you decide in the abstract the other question which was somewhat

discussed in the case of the sewing-machine (*Foxwell v. Bostock*), whether or no the specification shows that A or B is sufficiently claimed as a part of the invention or not." (*L. R.*, 2 *App. C.* 335.)

(e) *HENDERSON v. CLIPPENS OIL COMPANY.* H. L. [1883]

The specification described an improved apparatus for distillation of shale so as to utilise the spent shale as fuel:—*Held*, that assuming that the use of a common fire chamber was involved in the second claim, yet that it did not form an essential part of the first claim, and that therefore an arrangement of apparatus, which was substantially the same as that patented, except that no common fire chamber was used, was an infringement. (20 *Scott. Law Reporter*, 423.)

(f) *YOUNG v. ROSENTHAL.* [1883–4]

Infringement and novelty are two quite distinct issues; but you must administer the same measure against the plaintiff on the issue of novelty as you do in his favour on that of infringement. Thus, if the patentee alleges that the defendant has "substantially" infringed his patent by using slightly curved instead of straight lines in seams for corsets, then slightly curved lines made and used before the patent would be an anticipation of the invention. (*Griff.* 249, 1 *O. R.* 29.)

(g) *DAVIS v. FELDMAN.* C. A. [1884]

In an action for infringement, if the Court finds that the process which is alleged to be an infringement is substantially similar to a process described in a prior publication, which is alleged to be an anticipation of the plaintiff's patent, the plaintiff is in a dilemma, for if he shows that his patent is wide enough to include the alleged infringement, then the anticipation is established. (*Griff.* 75, 1 *O. R.* 13, 193.)

(h) *DOWNES v. FALCON ENGINE AND CAR WORKS.* C. A. [1886]

In an action for infringement of a patent for improvements in steam engines the patent contained three claims. The first claim might be made to claim the mode of condensing steam by passing it through water in a tank, and if so the patent was held to be invalid for want of novelty, or it might only claim what was in the second and third claims, in which case it was found that there was no infringement. (*Griff.* 77, 2 *O. R.* 197, 3 *O. R.* 70.)

(i) *UNITED TELEPHONE COMPANY v. NELSON.* [1887]

The putting in of new carbons in a tension regulator, which formed an essential part of the combination protected by the plaintiff's patent, is an infringement of the patent. (*W. N.* 1887, 193.)

(j) *ELLINGTON v. CLARK.* C. A. [1888]

In an action for infringement of a hydraulic balance lift, consisting of a combination partly old, but in which the counter-balance was effected in a new way by water pressure, it appeared that the defendants used a similar combination, but the counter-balance was effected, as previously, by gravity:—*Held*, that the

defendants had infringed by taking the essential part of the invention with the mechanical equivalents of the remainder, but on appeal held that there had been no infringement. (5 O. R. 319.)

(k) *HOCKING AND COMP v. HOCKING.* H. L. [1888]

The House of Lords approves the principle that a grantee should not defeat his own grant, but that consideration should not be allowed to alter the construction of the specification. In an action for infringement by assignee against assignor of a patent for an improved apparatus for heating liquids applicable as a condenser:—*Held*, as the patentee disclaimed the annularity of the steam and water spaces, and also their arrangement in an alternate and concentric series; and as it was shown that the opposite motion of steam and water was old, and the original claim so far as relating to it had been deleted, that the invention must be confined to the particular forms shown in the drawings:—*Held*, further, that one of the characteristic features of the patented form was the relative proportions between the cubic areas of the steam and water spaces which enabled the action of the machines to be reversed, and that as that feature was not to be found in the defendant's apparatus there was no infringement. (6 O. R. 69.)

(l) *GARRARD v. EDGE.* C. A. [1889]

The plaintiff's invention, which was for improvements in presses for pressing roof tiles, consisted roughly of three items—the reversibility of the top plate of the press, the reversibility of the bottom plate, and the reversibility of the box. The defendant had manufactured dies with boxes which were reversible, and had also diminished the size of the carrier of the bottom plate for the same purpose and reason as the plaintiff had:—*Held*, that there was not a taking of such a substantial portion of the combination as would amount to an infringement. (6 O. R. 372, 563.)

*Colourable Imitation—Equivalent—Evasion.*

(m) *BOVILL v. MOORE.* N. P. [1816]

A person who uses the same means in substance as a patentee of a machine, though the form of the machine be different, commits an infringement. It will be the same in substance if the principle be the same in effect. Referring to this, Gibb, C.J., said: "I remember that that was the expedient used by a man in Cornwall, who endeavoured to pirate the steam-engine. He produced an engine, which, on the first view of it, had not the least resemblance to Boulton and Watts':—where you looked for the head, you found the feet, and where you looked for the feet, you found the head; but it turned out that he had taken the principle of Boulton and Watts' engine." (*Dav. P. C.* 405.)

(n) *HILL v. THOMPSON.* [1818]

Dallas, J., delivering the judgment of the Court of Common Pleas, said: "A slight departure from the specification for the

purpose of evasion only, would, of course, be a fraud upon the patent; and, therefore, the question will be, whether the mode of working by the defendant has, or has not, been essentially or substantially different." (1 *Web. P. C.* 242; 8 *Taunt.* 391; 2 *B. Moore*, 448.)

(o) *FORSYTH v. RIVIERE.* N. P. [1819]

Action for the infringement of a patent for the application of detonating powder to the discharge of firearms. Drawings were annexed to the specification "exhibiting several constructions (of locks) which may be made and adopted, in conformity to the foregoing plan and principles, out of an endless variety which the subject admits of." The defendant applied the principle of the invention by using a lock of a different construction from any shown in the annexed drawings. Verdict for the plaintiff. (1 *Web. P. C.* 97; 1 *Carp. P. C.* 401.)

(p) *WEBSTER v. UTHUR.* [1824]

Action for the infringement of a patent for an improvement on the patent percussion gun-lock, by the addition of a bolt, sliding or moving in a groove, by which the roller magazine was then fixed, that had formerly been fastened by a screw and washer; the defendant's lock had a spring in the bolt, and the jury, upon the evidence of mechanics that a spring in a bolt was the same thing as a bolt sliding in a groove, found that there had been an infringement. (*Gods. Pat. Law*, 232.)

(q) *R. v. LISTER.* [1826]

The application of steam to heat iron rollers is an infringement of a patent in which hot irons were inserted into hollow rollers, the final process in both being the same, viz., the applying heat to the fibres of wool during the operation of spinning it, by making the slivers pass between the rollers so heated. (*Web. P. L.* 80.)

(r) *COCHRANE v. BRAITHWAITE.* N. P. [1830]

The essential part of an invention being that a necessary degree of compression should be produced in a quantity of air:—*Held*, that if this could be effected by narrowing the outlet as well as by a weighted valve, both were covered by the words "any other known means of producing the required resistance." (3 *Lond. Jour.*, *C. S.* 42.)

(s) *MINTER v. WELLS.* N. P. [1834]

The invention claimed being the application of the self-adjusting leverage to the back and seat of a chair, any application of that to the same subject is an infringement. (1 *Web. P. C.* 130.)

(t) *RUSSELL v. COWLEY.* N. P. [1834]

The specification having described the invention to consist in welding iron in the manufacture of tubes by circular pressure through dies or holes, the welding produced by passing the iron through grooved rollers, though not so perfect, is an infringement. (1 *Web. P. C.* 463.)

(u) *MORGAN v. SEAWARD.* N. P. [1836]

Alderson, B., in summing up the case to the jury, said: "Upon that subject (infringement) the question would be simply, whether the defendant's machine was only colourably different, that is, whether it differed merely in the substitution of what are called mechanical equivalents for the contrivances which are resorted to by the patentee. . . . You are to look to the substance and not to the mere form, and if it is in substance an infringement, you ought to find that it is so. If in principle it is not the same, but really different, then the defendants cannot be said to have infringed the patent." (1 *Web. P. C.* 171.)

(v) *JUPE v. PRATT.* [1837]

Alderson, B.: "You may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention." (1 *Web. P. C.* 146.)

(w) *WALTON v. POTTER.* N. P. [1841]

A specious variation in form, or ingenious alteration in the mode of adaptation, is an infringement of a patent. Tindal, C.J., in summing up the case to the jury, said: "Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, to obtain either a patent for it himself or to use it without the leave of the patentee, because that would be in effect and in substance an invasion of the right; and therefore, what you have to look at upon the present occasion is, not simply whether in form or in circumstances, that may be more or less immaterial, that which has been done by the defendants varies from the specification of the plaintiff's patent, but to see whether in reality, in substance, and in effect, the defendants have availed themselves of the plaintiff's invention in order to make that fabric, or to make that article which they have sold in the way of their trade." (1 *Web. P. C.* 586.)

(x) *NEILSON v. HARFORD.* N. P. [1841]

Action for the infringement of a patent for the improved application of air to produce heat in furnaces. Parke, B., told the jury that if the invention consisted, as claimed by the plaintiff, in applying the air, heated while *in transitu*, then, however great the improvement which the defendant's appa-

ratus for accomplishing that object may be on that described in the specification, it is no less an infringement. (1 *Web. P. C.* 310.)

(x) *NEILSON v. THOMPSON.*

Cottenham, L.C.: "The specification must tell the public for what it is that he (the patentee) claims protection. If it be for a principle, then if that be good it will apply to every mode in which that principle can be carried into operation. If for a machine for a particular mode of carrying into effect an old principle, that does not go beyond the machine." (1 *Web. P. C.* 283.)

(y) *WALTON v. BATEMAN.* N. P. [1842]

Cresswell, J., in speaking of the plaintiff's invention, said: "The defendants are not to resemble or counterfeit; they are not to make any addition to, or any subtraction from, it; availing themselves of that which is in truth the subject-matter of his patent; so as by such alteration to pretend that they are the true inventors of that article." (1 *Web. P. C.* 616.)

(z) *MUNTZ v. FOSTER.* N. P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships." The patentee described his invention as consisting in making the said plates of an alloy of "foreign zinc," and of "best selected copper;" the metals being melted together in certain stated proportions. Tindal, C.J., said to the jury that "although the patent describes the copper must be of the purest quality, yet, if persons could take an inferior kind of copper, and by dressing it up, and by some particular way of melting and refining it, give it exactly the same effect as the best kind of copper would have done, it must be for you to say whether in that case they intended to imitate and to evade the patent which the other party had granted to him." (2 *Web. P. C.* 101.)

Lord Lyndhurst, L.C., upon the same point, said: "The analysis proves that that compound (the metal manufactured by the defendants) consists, not of ordinary copper and zinc, but of those minerals in their greatest purity, and in the proportions recommended in the plaintiff's specification. If they were originally combined in this state the evasion is plain and direct. If they were purified in the course of this process, this, I think, would constitute a colourable evasion of the plaintiff's invention." (*Ib.* 95.)

(a) *HEATH v. UNWIN.* [1845]

Parke, B., in delivering the judgment of the Court, said: "There is no doubt, we think, if a defendant substitutes for a part of a plaintiff's invention some well-known equivalent, whether chemical or mechanical, he would probably be considered as only making a colourable variation." (2 *Web. P. C.* 227.)



(b) *RUSSELL v. LEDSAM.* [1845]

Letters patent may be infringed by a method which is an improvement upon the patentee's invention, provided the two methods are, in a material part, the same. (14 *M. & W.* 580.)

(c) *GAMBLE v. KURTZ.* [1846]

Action for the infringement of a patent for "improvements in apparatus for the manufacture of sulphate of soda," &c. The plaintiff, in his claim, said: "I do not claim the exclusive use of iron retorts, but I do claim, as my invention, iron retorts worked in connection with each other, as above described." The defendant had used two chambers, one of iron, and one of brick, connected by an opening through which the material could be pushed from one into the other:—*Held*, that there was an infringement. (3 *C. B.* 425.) Coltman, J., delivering the judgment of the Court of Common Pleas, said: "The essence of the plaintiff's improvement in making sulphate of soda was the use of two chambers, with separate furnaces, for the two stages of the process; so that both could be kept in action at the same time, at the different temperature required for each stage; and that principle is equally acted upon, and the same advantage gained, whether both chambers are of iron, or one is of iron and one of brick." (*Ib.* 435.)

(d) *STEAD v. ANDERSON.* [1847]

The use of the plaintiff's invention with slight immaterial variations to make a colourable difference, or for any other purpose, is an evasion of the patent. (2 *Web. P. C.* 156.)

(e) *BARBER v. GRACE.* [1847]

The specification of a patent for "improvements in the process of finishing hosiery and other goods manufactured from lamb's wool," &c., stated the invention to consist in submitting hosiery and other similar goods to the finishing process of a *press* heated by steam, &c., *in the manner hereinafter mentioned*. After describing the method of pressing the goods between boxes heated by steam, the specification concluded by confining the inventor's claim to the process *as above described*:—*Held*, that a method of finishing hosiery goods, by passing them through heated *rollers*, was not included in this patent, and therefore was no infringement of it. (1 *Exch.* 339; 17 *L. J., Ex.* 122.)

(f) *STEVENS v. KEATING.* N. P. [1847]

Action for the infringement of a patent for the manufacture of cements. The specification states the invention to consist in producing certain hard cements of the combination of the powder of gypsum, powder of limestone and chalk, with other materials, such combinations being (subsequent to the mixing) submitted to heat. The specification then describes the method of making cement from gypsum, in the course of which alkali (for instance, best American

pearlash) is to be used, and is to be neutralized with an acid (sulphuric acid is stated to be the best); the result is to be subjected to heat. The patentee claimed "the processes of mixing the powdered materials, alkalies, and acids, as hereinabove described," &c. The defendant manufactured cement by combining gypsum with borax, and subjecting the whole to heat. It was in evidence that borax is composed of an acid and an alkali:—*Held*, by Pollock, C.B., that there was sufficient evidence of infringement. (2 *Web. P. C.* 181.) His lordship told the jury that "if it had turned out that they (the defendants) had, by the use of borax, produced a substance very superior indeed, I think it would have been a fair question for the jury to consider, whether that was a colourable imitation or evasion, or whether it was a person travelling in his own direction, and making discoveries in the field that was not closed against him." (*Ib.* 185.)

(g) *THE ELECTRIC TELEGRAPH COMPANY v. BRETT.* [1851]

Action for the infringement of a patent "for improvements in giving signals and sounding alarums in distant places, by means of electric currents transmitted through *metallic circuits*." The defendant arrived at the same result by using a circuit not *wholly* or continuously metallic throughout, but by using the earth, to an extent nearly amounting to the half, as the connecting medium between two portions of the metal. It appeared in evidence, that after the grant of the letters patent, it had been discovered that a large portion of the wire through which the electric current returned to the battery might be dispensed with by plunging into the earth the two ends of wire which would have been joined by the parts left out, the electric current passing from one end of the wire to the other as effectually as if a continuity of wire had been kept up:—*Held*, that though a circuit upon this principle would not be *wholly metallic*, yet, inasmuch as it was so in all that part which formed the substance of the patentee's claim, viz., that part which gave the signals, it amounted to an infringement of the plaintiffs' patent. (10 *C. B.* 838; 15 *Jur.* 579; 20 *L. J., C. P.* 123.)

(h) *HANCOCK v. MOULTON.* Ch. [1852]

On an application to the Court of Chancery for an injunction to restrain the manufacture by the defendant of vulcanized or cured caoutchouc, alleged to be an infringement of the plaintiffs' patent, it appeared that this patent was for obtaining a certain useful product by subjecting a mixture of sulphur and caoutchouc to heat. The mixture was first made mechanically, and then, by the operation of heat, the character of the caoutchouc was changed, so that it ceased to be liable to stiffen from cold. It was not decomposed by heat, and it was improved in elasticity. The patent extended to the incorporation of sulphur, and of sulphur only, with the caoutchouc by means of heat. The defendant subsequently obtained a patent for the combination of hypo-sulphate of lead and artificial sulphuret of lead with caoutchouc;

that combined mass, acted upon by heat, was alleged by the defendant to produce more beneficial results, but the results were of the same character as those which were produced by the plaintiffs' invention. Turner, V.-C.: "Assuming the materials thus used by the defendant to be different, the process of the defendant would *per se* be no infringement of the plaintiffs' patent. The plaintiffs confine their patent to sulphur; the defendant had used hyposulphate of lead and artificial sulphuret of lead. It was said that the hyposulphate and sulphuret of lead do not of themselves produce the change, but that the change is produced by the sulphur which they contain, and which forms one of their several constituent parts; and that those parts being decomposed by *heat*, the sulphur combined with the caoutchouc and left a residuum of lead, which had no operation in the change which was effected. If the qualities conferred upon the caoutchouc by the process were imparted by the sulphur, it would no doubt be an infringement of the plaintiffs' patent." (*Johnson's Patentees Manual*, 3rd ed. p. 208.)

(i) *BATEMAN v. GRAY*. N. P. [1853]

Action for the infringement of a patent for "certain improvements in valves or plugs for the passage of water or other fluids."

Martin, B., in summing up to the jury, said: "If you believe that the defendant's instrument, though he might have employed skill and knowledge upon it, was taken by him substantially from the plaintiffs, and that what he has produced is nothing more than a substitution of other and equivalent means for producing the same end, even though the means employed might be better than those of the plaintiffs, it is my duty to tell you that that is an infringement of the patent. If that were not the law no patent would be safe, for a patentee is forced to produce to the public a specification of his invention, and he has had no opportunity of testing it so as to point out every application of it for public use." (*Mac. P. C.* 102.)

(j) *UNWIN v. HEATH*. H. L. [1855]

A. obtained a patent for certain improvements in the manufacture of iron and steel, described as consisting in "the use of carburet of manganese in any process whereby iron is converted into cast steel"; the specification directed the unfused carburet of manganese to be put into the pot containing the steel in a fused state. The patentee claimed as his invention "the use of carburet of manganese in any process for the conversion of iron into cast steel." B. manufactured cast steel by placing oxide of manganese and carbonaceous matter into the pot at the same moment as the steel. Evidence was given that carburet of manganese would be formed by the combination of these substances before the steel was melted. They produced the same effect upon the steel as the carburet of manganese, at a cheaper rate. This method of producing the effect was not known at the time of taking out the patent:—*Held*, that this was a new invention, and not an infringe-

ment of the patent. (5 *H. L. Cas.* 505; 16 *C. B.* 713; 25 *L. J., C. P.* 8.)

Crompton, J., in delivering judgment in the Exchequer Chamber, said: "The discovery of the new mode of making the carburet in the pot, in the course of the process, so as to be ready to alloy with the steel in a subsequent part of the process, may have been a discovery and an improvement on the plaintiff's invention, for which a patent might perhaps have been taken out, and, if taken out by a stranger, the plaintiff could not have used the new method without infringing the patent for the improvement. On the other hand, the new method could not in such case have been carried on without infringing the plaintiff's patent, if, as I think, it was an improved and neater mode of bringing the two substances together." (22 *L. J., C. P.* 10.)

Coleridge, J., in delivering judgment in the same Court, said: "There can be no doubt, I think, that an equivalent has been used. If that equivalent were known at the date of the specification to the plaintiff or ordinary chemists—those, I mean, who would bring to the reading of the specification such knowledge as must be presumed in those to whom the patent must be taken to be addressed—then it is within the specification, and the use of it is an infringement. If not, the contrary conclusion follows, and the use of it is an improvement, in virtue of a new discovery. . . . Whether the equivalent be in its nature near to or remote from the thing itself, seems to be in principle wholly immaterial, and equally so that the one should be so nearly identical with the other, as that the one should be the component parts and the other the composite substance." (*Ib.* 13.)

The Judges, in answering the question put to them by the House of Lords, differed as to the question of infringement.

Crowder, J.: "The process of the plaintiff in error is an improvement upon the invention of the defendant in error (the patentee), while at the same time it is an infringement of his patent." (25 *L. J., C. P.* 11.)

Williams, J.: "Though the use of a chemical or mechanical substitute, which is a known equivalent to the thing pointed out by the specification and *claimed as the invention*, amounts to an infringement of the patent, yet if the equivalent were not known to be so at the time of the patent and specification, the use of it is no infringement. . . . If a patent is taken out for *the application of a principle*, coupled with a mode of carrying the principle into effect, the patentee is entitled to protection from all other modes of doing so, whether known or not known at the time of the specification." (*Ib.* 13.)

Erle, J.: "I am of opinion that a patent for the use of a substance in a process is infringed by the use of the elements of that substance known to be equivalent thereto *at the time of the use*, if used for the purpose of taking the benefit of the patent and of making a colourable variation therefrom. . . . If the discovery had been made after the patent, that carbon and manganese were elements of the carburet, equivalent to the carburet

of manganese in the patented process, the use of those elements in that process for the purpose of being equivalent to the carburet, would, in my judgment, be a colourable variation and an infringement." (*Ib.* 15.)

The Lord Chancellor said that judgment ought to be for the defendant on the short ground that the invention claimed was for the use of a particular substance, whereas the defendant had used two other substances of a cheaper kind, the use of which for the same purpose was not known when the patent was obtained. (*Ib.* 21.)

(k) *BOVILL v. PIMM.* [1856]

In 1844, G. obtained a patent for "improvements in grinding wheat and other grains." He described as his invention "the forcing and distributing of atmospheric air from the eye or centre of mill-stones, for the purpose of cooling the grain during the process of grinding;" this was effected by an air-box placed below the mill-stones, into which air was forced by the rapid rotation of a fan or blower, which caused a current of air perpendicular to the axis of the fan; and the air was conducted by a pipe through the eye of the lower stone to the centre of the two stones, and there distributed between them by an apparatus provided with fans or arms. In 1846, the plaintiff obtained a patent for "improvements in manufacturing wheat and other grain into meal and flour." His invention consisted in the application of ventilating vanes or screws at the centre of the stones for supplying the air between the grinding surfaces; a portable ventilating machine, blowing by a screw vane, which caused a current of air parallel to the axis of the vane, was attached externally to the eye of the upper mill-stone; the screw vane being set in rapid motion, the air was compelled to pass through the eye into the centre of the two stones, and so find its way out between them. In 1851, the defendant obtained a patent for "improvements in grinding wheat," and his plan was to remove from the centre of both stones a large circular portion of each, and in this space, opposite to the separation of the two stones, to place a fan or blower, by the rapid rotation of which a centrifugal motion was given to the air, and it was driven between the stones:—*Held*, that the defendant's invention was no infringement of the plaintiff's, but that each was a new method of accomplishing a well-known object, viz., the cooling grinding substances by the common principle of obtaining a current of air by a rotating vane. (11 *Exch.* 718.)

Pollock, C.B., in delivering the judgment of the Court, said: "Where a subject is not new, as this certainly was not, viz., 'the cooling of substances undergoing the process of grinding' (which had been long known to be a desideratum in grinding, and to effect which various contrivances had been adopted, and several, if not many, patents taken out), any patent taken out for a method of performing the operation is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common

object, and may apparently be described by the same general phrase." (*Ib.* 739.)

(l) *SIMPSON v. HOLLIDAY*. Ch. [1864]

If a patentee claims as his invention the mixing of two chemical substances, and boiling them together, to produce a certain result; and the same result is arrived at by mixing the two substances together in the presence of a third body, without boiling, that would be an infringement. (20 *Newt. Lon. Journ.*, N. S. 111.)

(m) *NEEDHAM v. OXLEY*. Ch. [1865]

Where a patentee has been led up to the invention of his patented machine, by an idea thrown out by a previous patentee of a machine for the same purpose, but arrives at a similar result by another and different mode, there is no infringement. (21 *Newt. Lon. Journ.*, N. S. 300.)

(n) *CURTIS v. PLATT*. H. L. [1866]

Held, affirming the judgment of the Lord Chancellor, that a patent for an entire combination is not infringed by a different combination, for the same object, of the same elements, though important, or of equivalents for them, if not a mere colourable evasion or imitation. The principle which protects a patentee against the use by others of mechanical equivalents is inapplicable to a case where the whole invention depends entirely on the particular machinery by means of which a well-known object is attained. (35 *L. J.*, Ch. 852.) The Lord Chancellor, in delivering his judgment in the court below, said: "If the invention be, as I have already described, nothing in the world more than a particular means to attain to a given result which is perfectly well known, then the invention is for the means, and you can no more prevent the invention of one distinct set of means being interfered with—you can no more say that it interferes with the invention of another, than you could say originally that there ought not to be patents granted for the invention of distinct means to an end." (11 *L. T. Rep.* N. S. 249.)

(o) *MURRAY v. CLAYTON*. Ch. [1872]

A clumsy imitation of a patented machine, or a patented article, may be an infringement, although it is not such as would have been an anticipation defeating an inventor's right to a patent. Decided on the authority of *Daw v. Eley*. (*L. Rep.*, 7 Ch. 585.)

(p) *JOHNSON v. RYLANDS*. [1873]

Action for infringement of a patent for improvements in testing the strength of wire for telegraphic and other purposes. The invention consisted of two drums, g and i; the wire from a reel was carried to drum i, and coiled several times round it, and was then carried to drum g, which was driven at a higher surface

speed than drum i. The alleged infringement consisted in the use of two drums and the passing of wire over them, so as to take the kinks out, the second drum being retarded by a clip so as not to go as fast as the first; the wire pulled round the second drum being gathered up on the first. The defendant had used this method before the date of the plaintiff's patent, but not for the purpose of testing the strength :—*Held*, that there was no infringement. Blackburn, J. : “Inasmuch as the front wheel which gathers up the defendant's wire (which must necessarily be subjected to strain and to expansion) must gather up a greater length of wire than that which travels over the other drum behind, your front wheel must travel quicker than your second, which is true, and it is said that any means by which you retard the other wheel which receives the wire first is a ‘mechanical equivalent’ for the machinery in the plaintiff's machine, by which it was secured that the first should travel quicker than the second. That phrase, ‘mechanical equivalent,’ according to my experience in patent cases, is always used when a man intends to disguise something else which he cannot clearly express in any other way. But I do not think that this can be said in any sense to be a mechanical equivalent. In the one case the relative motion of the wheels is the cause of the wire expanding instead of being the effect.” (*Griff.* 138.)

(q) THORN v. WORTHING SKATING RINK COMPANY. M. R. [1876]

Jessel, M.R., in delivering judgment, said : “The question I have to decide is, whether the defendant's skate is, in substance, an infringement of the plaintiff's. . . . I take it this is the first test. Is it so like the patented thing that your mind is not directed in the first instance to dissimilarity, but to similarity? In other words, have you to examine it very carefully to find any distinction or difference? If that is the real position of the matter, *prima facie* it is an infringement; not necessarily so, because you may, on examination, find that what you had overlooked in the first instance was really so essential and important a part of the invention, that you ought to decide at once that it is not an infringement. Then, having arrived at that conclusion on the inspection, the next thing is to see what really has been done. In one sense, what has been done is undoubtedly a mechanical equivalent; but whether it is a mechanical equivalent in the sense in which that expression is used in patent law is, of course, the question I have to decide.” (*L. R.*, 6 *Ch. D.* 417 (n).)

(r) CLARK v. ADIE (First App.). H. L. [1877]

Lord Hatherley : “The case of *Seed v. Higgins* (8 *H. L. Cas.* 550) is one which I have always thought exceedingly illustrative of the great difficulty which patentees are put to. . . . There the plaintiff was put to this extraordinary difficulty: He first claimed an improvement by using centrifugal force in the winding of bobbins. He then found that, having been anticipated as to the use of centrifugal force, he

could only claim in respect of a certain weight, which was moved by centrifugal force in a given position, and he disclaimed all but that weight. When another person sought to substitute what was a mechanical equivalent for the weight (it was not applied in exactly the same place or the same position, but the effects were almost the same), the Court came to the conclusion that the very disclaimer itself showed that the plaintiff was only claiming the exact thing which was left open to him by the numerous other patents which had been taken out for the application of centrifugal force; and that, although the defendant had come as near as could be conceived to infringement, yet he had not actually violated or infringed the patent, because the patent must be confined very strictly to what was expressed in it—that is to say, very strictly to the application of the weight there mentioned.” (*L. R.*, 2 *App. Cas.* 332.)

(s) *FLOWER v. LLOYD*. C. A. [1877]

Action for the infringement of a patent for improvements in the method and process of printing on tin plates, and in furnaces or ovens for heating or drying printed tin plates. It was contended for the plaintiffs that the specification claimed a combination of four processes, old in themselves, but from which a marketable product was for the first time obtained. The combination was said to consist of (1) printing from raised surfaces with heat-resisting inks; (2) drying in an oven of a particular kind; (3) varnishing; and (4) final heating. The defendants were charged with employing three of these processes and making only a colourable imitation of the fourth. The defendants alleged that the plaintiff's patent was not for a combination, but for a dry process of printing, whereas they had employed the old and well-known process of printing from damp lithographic stones. It was also shown that although, as a last step in the manufacture, they varnished the tin plates and put them again into an oven, this oven was not the plaintiff's improved oven or anything like it:—*Held*, reversing the judgment of V.-C. Bacon (*W. N.* 1877, p. 71), that in order to constitute an infringement of a patent for a combination there must be an infringement of the whole combination, not in the sense that every step of the combination must be adopted, but that there must be an adoption of that which constitutes the essence of the combination. In this case the process of the defendants differed from that of the plaintiffs in every step, except that, after the plates had been printed and baked, they varnished them and replaced them in an oven, but in an oven of a different construction from that employed by the plaintiffs. Moreover, that this was a well-known process which could not, on a fair construction of the plaintiff's specification, be considered as any part of what constituted the essence of the combination protected thereby. (*W. N.* 1877, p. 132; *Johnson's P. M.*, 4th ed., p. 245.) The plaintiffs afterwards tried to set aside the judgment on the ground that the defendants had fraudulently



misled the Court, but the Court of Appeal *held* that no fraud was proved. (6 *Ch. D.* 297; 10 *Ch. D.* 327.)

(t) DUDGEON v. THOMSON. H. L. [1877]

Lord Cairns, L.C.: "The words 'colourable imitation' are words which appear to me not very happily chosen, and calculated to create some confusion. I am quite aware that they are words which are used sometimes in the argument of patent cases, but I doubt very much whether the particular expression is one which has any great authority for its use. There is a well-known manner in which the word 'colourable' or 'colourably' is used in patent cases. I have referred to the ordinary form in which injunctions are granted in patent cases by the Court of Chancery, and I take from Mr. Seton's book an example which appears to me to be exactly in accordance with what I recollect to be the practice of the Court in granting injunctions. It is in a case which, I think, came before my noble and learned friend as Vice-Chancellor, the case of *De la Rue v. Dickenson*. The injunction restrains the defendants, their agents and servants, during the continuance of the patent, from 'using or employing any machines similar to the machine in the plaintiff's bill stated, or any machinery, mechanism, or mechanical contrivance made or arranged according to the plaintiff's said patent inventions, or differing therefrom only colourably, or by the substitution of mere mechanical equivalents for the same.' Now, my lords, what I understand by that, is this, if there is a patented invention, and if you, the defendant, are found to have taken that invention, it will not save you from the punishment or from the restraint of the Court that you have at the same time that you have taken the invention dressed it up colourably, added something to it, taken, it may be, something away from it, so that the whole of it may be said, as is said in this injunction, here is a machine which is either the plaintiff's machine or differs from it only colourably. But underlying all that, there must be a taking of the invention of the plaintiff. . . .

"My lords, when I look at that which the respondents have in this case done and the article which they have sold, it appears to me to be a different article from the article specified. It is, no doubt, a cognate invention; it aims at accomplishing the same purpose; it uses, no doubt, friction rollers, but it has not that thing which the patentee in this case has chosen (I have no doubt for proper reasons) to describe as one of the characteristic features of his invention, and which, as it seems to me, he might almost have said was *the* characteristic feature of his invention; because, as it seems to me, it was that without which his invention would have been absolutely nil." (*L. R.*, 3 *App. Cas.* 45.)

Lord Blackburn: "The phrase 'colourably' is very apt to mislead in these cases. If part of the property in the invention be really taken there is an infringement, however much that may be disguised or sought to be hidden. If that is detected by the patentee, and if what is taken is really part of his property

given to him by the letters patent, he has a right to proceed against the infringer, however ingeniously the colours may have been contrived to try to conceal the fact that there has been a taking of part of the property. (*Ib.* 53.)

(u) *BARRETT v. VERNON.* V.-C. B. [1877]

The plaintiffs obtained letters patent for "an improved stopper for bottles containing aerated or gaseous liquids." The invention consisted in stoppering bottles containing aerated water, by means of a cylinder or plug of hard wood, having a *greater* specific gravity than water, such as lignum vitæ, or other suitable material. Subsequently, the defendant obtained letters patent for "an improved means for effecting the closing or stopping of aerated liquid bottles," having internal stoppers of *less* specific gravity than the liquid contained in the bottle, the stopping being effected by means of a "weight or closed device arranged to be temporarily applied to the stopper," so that the weight of the stopper and closing device combined exceeded the specific gravity of the liquid contained in the bottle:—*Held*, that the defendant's invention was a colourable imitation and an infringement of the plaintiffs' patent, and that the plaintiffs were entitled to an injunction. (45 *L. T. Rep., N. S.*, 755.)

(v) *BAILEY v. ROBERTON.* H. L. [1878]

Patent for "improvements in preserving animal substances." The provisional specification stated the object of the invention to be the preserving of animal substances in a fresh state; and the patentees described their invention to consist in the use of a solution, composed of a certain specified quantity of gelatine mixed with a given quantity of bisulphite of lime, and applied for the above purpose in the manner pointed out:—*Held*, that if the complete specification claimed the same invention as that described in the provisional specification, it was not infringed by the use of a solution of bisulphite of lime, pure and simple, and without admixture of gelatine, in substantially the same manner, for the purpose of preserving fresh meat. (*L. R.*, 3 *App. Cas.* 1055.)

(v<sup>1</sup>) *PENNYCOOK PATENT GLAZING COMPANY v. MACKENZIE, HARLEY AND COMPANY.* [1882]

A patent for astragals for holding glass which were formed out of strips of sheet zinc folded into a particular shape:—*Held*, not to be infringed by astragals rolled from solid iron, the use of metal instead of putty not having been separately claimed. (19 *Scott. Law Rep.* 353.)

(w) *COUCHMAN v. GREENER.* H. L. [1884]

The plaintiff was assignee of a patent for improvements in breech-loading guns, one of the improvements claimed being the converting the fore-end of the gun into a lever by prolonging it backwards into the body of the gun, so as to cock a hammer on the barrels being raised. The defendant being a licensee of the said patent manufactured guns in which the fore-end acted so as to cock

the gun on being raised, but not by being prolonged backwards so as to form a lever:—*Held*, that this would be no infringement, and that therefore royalties were not payable. (1 O. R. 197; *Griff.* 58.)

(x) *NEEDHAM v. JOHNSON.* C. A. [1884]

The plaintiff's patent being for a combination, if the defendants have used that combination, and also something added to it, that combination remaining a necessary part of their machine, but the addition to it being an improvement, and if they have used that, without acknowledgment that they are only using an improvement, that would be an infringement. If they had invented such a machine, they would have been entitled to take out a patent, not for a new machine, but for an improvement upon the plaintiff's machine, and then they could not use their improved machine without paying the proper price to the plaintiffs for having used their machine, although improved. If they used it without paying, they would infringe. The claim being for machinery by which liquid, while being filtered, was caused to pass in a particular way, it was found that the defendant caused the liquid to pass in a similar way, but produced this result by machinery which was substantially different:—*Held*, no infringement. (*Griff.* 168; 1 O. R. 49.)

(y) *HAYWARD v. THE PAVEMENT LIGHT COMPANY.* [1884]

A patent for improvements in pavement lights by making them of prisms placed so that one side was horizontal, one side was vertical, or nearly so, and the other side was inclined at any angle so as to deflect the light more or less horizontally:—*Held*, to be infringed by a pavement light, in which the prisms used were in all respects similar, except that the third side was curved. (1 O. R. 207; *Griff.* 124.)

(z) *MOORE v. BENNETT.* [1884]

In an action for infringement of a patent for improvements in machines for cutting and trimming the hairs or bristles of brushes, the plaintiff alleged that the real invention was the new principle of cutting by means of the inclined cutting edges as described, but it appeared that if there were any inclination of the edges in the defendant's machine, it was not in any degree the same as that described in the plaintiff's specification, nor would it produce the same effect. Blackburn, L.: "If the defendant had taken the plaintiff's edges, not parallel, but tapered, . . . it would have been taking a substantial and real part of the combination, and for the object for which the combination was to be useful, viz. the making of brushes in that way; and it would not have been less an infringement because the defendant added superfluous things, if he did add them, or because he substituted equivalents, or even left out parts of the combination altogether, provided always that he had taken a substantial part of it for the purposes shown in the specification. And I am strongly inclined to think . . . that if the plaintiff had proved that, he would have proved that there was an infringement." (*Griff.* 158; 1 O. R. 129, at p. 150.)

*(a) NORDENFELT v. GARDNER. C. A. [1884]*

A machine which is alleged to be an infringement of a patented combination may have the combination without any variance, or may have it with some alteration, either by subtraction, or by addition, or by substitution of parts. If the alteration be merely colourable, notwithstanding such colourable alteration there may be an infringement. If an alteration by addition be made, and such alteration is an improvement, then no good patent can be made with regard to the new machine except by claiming the invention as an improvement, and showing distinctly what the addition is. An alteration by subtraction, if more than colourable, would alter the combination. It would not be a combination of the same things, and if the combination were altered by a material subtraction, it would be a new combination. But an alteration by substitution—that is, by substitution of one of the material elements of the original combination—must be a new combination. The second combination, then, is a combination of different things. There is the taking away of a material element, and a putting in of a new material element which is different from any of the elements of the former combination. (*Griff.* 175; 1 *O. R.* 10, 61.)

*(b) MACKIE v. BERRY. [1885]*

In an action for infringement of a patent for improvements in the manufacture of knitted fabrics and in machinery therefor, it appeared that the complainer's machinery was so contrived as to vary the length of the courses by varying the number of needles without removing the stitches from the unemployed needles, and knitted the courses so as to be radial, or nearly so, instead of circular. Radial knitting had been produced before by machines requiring more or less manipulation, but not by an automatic machine. The needles used were latch needles, which worked vertically, being lifted by a horizontal bar, and the courses were altered by altering the effective length of this bar. The alteration was determined automatically by a pattern mechanism. The basis of the respondent's machine was the stocking frame, and in order to produce radial work he used barbed needles, horizontal in position, and stationary. The thread was laid across the tops of the needles by a yarn carrier pressed into the barb by a device for that purpose, and the barb was closed by a movable presser. The yarn guide was arrested opposite any particular needle by an adjustable stop, and the pattern was determined by a rack bar operated by an escapement, which had to be moved back by hand after each section was completed:—*Held*, that this machinery was substantially different from the complainer's, and that there was no infringement. (2 *O. R.* 146.)

*(c) LAURIE v. BAKER. [1885]*

In an action for infringement of a patent for improvements in bird cages, and for an injunction to restrain the defendant from

fraudulently passing off defendant's goods as the plaintiff's, it appeared that the defendant had designed a feeding cup which was similar to the plaintiff's in one particular only—viz., the frame—had registered his design, and had then sold the cup as a patent cup:—*Held*, that as the plaintiff's patent was for a combination, there was no infringement; but that the trade understood "patent cup" to mean the plaintiff's cup, and that as the defendant knew this, he must be taken to have fraudulently represented his goods to be the plaintiff's, and damages and an injunction were awarded. (2 O. R. 213.)

(d) *EASTERBROOK v. GREAT WESTERN RAILWAY COMPANY.* [1886]

Although there cannot be a patent for an idea or a principle apart from its physical embodiment in adequate apparatus, yet if the specification discloses an idea, shows a method by which it can be carried out, and does not limit the claim of the patentee, any apparatus which by different mechanical means carries out the same idea, is an infringement, though the method used and even the purpose to which the principle or idea is applied is different from those embodied in the specification. (*Griff.* 81; 2 O. R. 201; 3 O. R. 94.)

(e) *PROCTOR v. BENNIS.* C. A. [1886]

A patent for a combination of known mechanical contrivances producing a new result held to be infringed by a machine producing the same result by a combination of mechanical equivalents of the above contrivances, with some alterations and omissions which did not prevent the new machine from being one which took the substance and essence of the patented invention. (36 Ch. D., 740.)

(f) *UNITED TELEPHONE COMPANY v. ST. GEORGE.* [1886]

A disc of carbonized leather, on which a carbonized wood ball rested lightly by gravity, being suspended from a flexible conductor:—*Held*, to be an infringement of the Edison patent, as it formed a closed circuit and did not act by make and break when affected by waves of sound. (*Griff.* 230; 3 O. R. 33 & 321.)

(g) *MUSGRAVE AND SONS v. HICKS, HARGREAVES AND CO.* [1886.]

In an action for infringement of two patents for improved gear for starting engines, it appeared that both the plaintiffs' and defendants' machines were developments of an apparatus known as Galloway's:—*Held*, by Mathew, J., that, whether the plaintiffs' invention was to be regarded as claiming a combination of old mechanical means for a new and useful purpose, or of old means, and an essential part which was new, the defendants had not imitated the whole or the essential new part, and had, therefore, not infringed. (3 O. R. 49.)

(h) *HOCKING AND CO. v. HOCKING.* [1887]

The assignees of a patent for a novel apparatus, capable of being

used as a condenser, brought an action against the patentee for infringement. The defendant denied infringement, and alleged, that if the patent was so construed as to cover the alleged infringement, it would be void for want of novelty. The Court of Appeal, regarding with extreme jealousy the defendant's claim as being in derogation of his own grant, *Held*, that although there were some minor differences, the defendant's apparatus was an infringement. (4 O. R. 255, 434.) But *held* by the House of Lords that there was no infringement. (6 O. R. 69.)

(i) *WENHAM COMPANY v. MAY*. [1887]

In an action for infringement of a patent for improvements in gas lamps, the only material difference between the plaintiffs' and defendant's lamps was, that in the latter there was one gauze covering in place of two, in two distinct positions, to moderate and equalise the currents of air:—*Held*, that as the equalising of the current, rather than the exact position, appeared to be the material point, there was an infringement. (4 O. R. 303.)

(j) *FLETCHER v. GLASGOW GAS COMMISSIONERS*. (Scotch.) [1887]

In an action for infringement of a patent for improvements in cooking stoves, it was *Held*, that the patent could only be supported by construing it as claiming the mechanism therein described, and that, although the respondents used part of such mechanism, or something similar thereto, they used it for a different purpose, and did not infringe. (4 O. R. 386.)

(k) *EHRlich v. IHLEE*. C. A. [1888]

In an action for infringement of a patent for mechanical musical instruments, *Held*, that the defendants had infringed, in that they had taken the same parts to perform the same functions, with the colourable variation of a rotating wind chest and fixed music sheet, instead of the plaintiff's fixed wind chest and rotating music sheet. (5 O. R. 198.) Where a defendant has substantially infringed a patent, it is no defence to say he has made improvements. (5 O. R. 437.)

(k<sup>1</sup>) *KAYE v. CHUBB*. H. L. [1888]

In an action for infringement of a patent for improved means of fastening and unfastening doors, *Held*, that the defendants had infringed, as they had appropriated every part of plaintiff's combination, with a mere colourable variation, which consisted in making one part act directly instead of indirectly. (5 O. R. 641.)

(l) *GOSNELL v. BISHOP*. C. A. [1888]

In an action for infringement of a patent for improved trouser stretchers, it was *Held*, that the defendant's stretchers, although obtaining the same result, obtained it by different means, and were not an infringement. (5 O. R. 41, 151; 4 T. L. R. 397.)

(m) *AUTOMATIC WEIGHING MACHINE COMPANY v. KNIGHT*. C. A. [1889]

The essential part of the plaintiffs' patent was the introduction

of a break with spindle, so that though the process of weighing was complete, the index on the dial was not moved until the stop was removed by inserting a penny. The defendant's mechanism was different, in that it had a stop which prevented the machine itself being set in operation until a coin was put in:—*Held*, that this was equivalent to putting a lock on the machine, and was not a colourable imitation of the plaintiffs' mechanism, and therefore that there was no infringement. (5 *T. L. R.* 359; 6 *O. R.* 297.)

(n) AUTOMATIC WEIGHING MACHINE COMPANY *v.* COMBINED WEIGHING AND ADVERTISING MACHINE COMPANY. C. A. [1889]

This was an action for infringement of the same patent which the Court of Appeal had under consideration in the *Automatic Weighing Machine Company v. Knight*. The machine, which was alleged to be an infringement, remained out of gear until the coin was dropped in, so that the coin operated on the machine, instead of operating only on the indicator:—*Held*, by the Court of Appeal, that they could not reconsider the construction already put on the plaintiffs' specification in *Knight's* case, and that if that construction were correct there was no infringement. (6 *O. R.* 367.)

(o) AUTOMATIC WEIGHING MACHINE COMPANY *v.* INTERNATIONAL HYGIENIC SOCIETY. [1889]

This was an action for infringement of a patent for an automatic weighing machine, which had already been held by the Court of Appeal to be limited to a claim of every combination of mechanism substantially the same as that described, and to be valid. In the defendants' machine there was a revolving dial connected with the platform on which the person stood to be weighed, and the proper figure on the dial was disclosed by the opening of two shutters actuated by the insertion of a coin. In the plaintiffs' machine there was an index connected with the platform, which revolved opposite a concealed fixed dial; on the insertion of the coin, an index on an exterior dial became connected with the index of the interior dial, and revealed the weight. There was no difference in the methods used for collecting and releasing the coin, and resetting the machines. The inventor of the defendants' machine was not called to show how he arrived at his invention:—*Held*, by Charles, J., that the defendants' machine achieved the same ends by means with differences which were merely colourable, and that there was infringement. (6 *O. R.* 475.)

(p) THOMSON *v.* MOORE. [1889]

This was a motion for attachment to commit the defendant for breach of an injunction to which he had consented, restraining him from infringing the plaintiff's patent for improvements in compass cards. The defendant denied that his cards were an infringement. The plaintiff used a thin rim of paper, surrounded with a thin rim of aluminium, connected to the boss by fine silk radial threads in tension, and short, light needles, arranged in a horizontal plane a little beneath the card, and attached to it by

light silk threads, and thereby attained: (1) diminution of friction, resulting in sensitiveness and accuracy; (2) small magnetic moment; (3) long vibrational period. The defendant's card differed in having an L-shaped rim of aluminium, transverse bars of aluminium instead of silk spokes, and the needles arranged in two vertical rows, some inches below the card, in order, as the defendant said, to suit his new patented system of correctors:—*Held*, by the Court of Appeal in Ireland (reversing Porter, M.R.), that: the essence of the plaintiff's invention being so to combine extreme lightness of card with long period of vibration, and small needles as to obtain a combination of results not previously obtained, viz. diminution of frictional error, steadiness, and amenability to correction, such a combination amounted to a new result, and the doctrine of mechanical equivalents applied; that there was an essence or substance of invention underlying the combination, and that the defendant's card obtained the same results by substantially the same means, and differed only in non-essential particulars from the plaintiff's invention, and was therefore an infringement, and that the attachment must go. (6 O. R. 426.)

(q) *WINBY v. MANCHESTER STEAM TRAMWAYS*. [1889]

You cannot evade the rights of a patentee (of improvements in points for tramways where the tongue was worked vertically by a spring) by substituting a weight for a spring. (6 O. R. 359.)

*Intention immaterial.*

(r) *HEATH v. UNWIN*. Ch. [1847]

The doctrine laid down in this case by the Court of Exchequer (14 L. J., *Ex.* 153), that, if a patent has been infringed unintentionally, the patentee is not entitled to redress, disapproved of. (15 *Sim.* 552.)

Shadwell, V.-C., said: "The party complaining of the act is not the less prejudiced by it because it was committed unintentionally; and my opinion is that, if a party has done an act that is injurious to the rights of another (though without any intention of doing him an injury), he is answerable for the consequences. In *Stevens v. Keating*, the Lord Chancellor disapproved of the case in the Court of Exchequer; and I must decline to act upon the principle which it lays down." (*Ib.* 553.)

(s) *STEAD v. ANDERSON*. [1847]

The question of infringement depends not on what the defendant intends, but on what he does—per Wilde, C.J. (2 *Web. P. C.* 156.)

(t) *HEATH v. UNWIN*. H. L. [1855]

Parke, B., said: "In delivering the judgment of the Court of Exchequer in a former stage of this case, I stated the opinion of the Court to be, that there could be no indirect infringement if the defendant did not intend to imitate at all. That part of the



judgment has since been justly objected to in *Stevens v. Keating*, and no doubt we were in error in that respect. There may be an indirect infringement as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself." (25 *L. J., C. P.* 19.)

(u) *WALTON v. LAVATER.* [1860]

Erle, C.J.: "With respect to the defendant not being liable, because the articles were imported from abroad, I should say that, even if it was a simple case of importation, *without any proof of knowledge of the article being patented, or of the infringement*, it would be sufficient evidence of infringement that the defendant had imported and sold." (29 *L. J., C. P.* 279.)

(v) *M'CORMICK v. GRAY.* [1861]

Bramwell, B.: "I am satisfied there is no difference between making a thing with one intent and making it with another, because I always understood that if a man may do a thing he may do it with whatever intent he pleases." (31 *L. J., Ex.* 42; 7 *H. & N.* 25.)

(w) *NEWALL v. ELLIOTT.* [1864]

Mere intention cannot make any act done an infringement which, without that intention, would not be an infringement. (10 *Jur., N. S.*, 954; 13 *W. R.*, 11; 10 *L. T. Rep., N. S.*, 792.)

(x) *CURTIS v. PLATT.* Ch. [1864]

Ignorance of the existence of a former invention is no answer to a charge of infringement, where the second invention is capable of being accurately represented as an imitation of the former. (11 *L. T. Rep., N. S.*, 245.)

A Question for the Jury.

(y) *WALTON v. POTTER.* N. P. [1841]

Tindal, C.J.: "Now, according to the general rule upon this subject (infringement), that is a mere question of fact, and peculiarly for the consideration of the jury, and it will be for you to say under the circumstances that have been brought in review before you, whether that which has been done by the defendants amounts to such an infringement or not." (1 *Web. P. C.* 586.)

(z) *MACNAMARA v. HULSE.* N. P. [1842]

Where, in an action for infringing a patent for blocks for pavements, the plaintiff claimed as his invention that his block was bevelled both inwards and outwards on the same side of the block, and it was alleged that the defendant's blocks were an imitation of the plaintiff's, as two of the defendant's blocks were equivalent to one of the plaintiff's:—*Held*, that it was for the jury to say whether the defendant's blocks were in effect the same as the plaintiff's, although no single block of the defendant's was

bevelled both inwards and outwards on the same side. (*Car. & M.* 471.)

(a) *NEWTON v. GRAND JUNCTION RAILWAY COMPANY.* [1846]

The question, whether what the defendant has done is merely colourably different from the plaintiff's invention, is for the jury. (5 *Exch.* 331; 20 *L. J.*, *Ex.* 427 (n).)

(b) *STEVENS v. KEATING.* N. P. [1847]

Upon the plea of not guilty his lordship said: "The question is, has the defendant done that which is within the claim—no matter whether the claim is good or not." (2 *Web. P. C.* 191.)

(c) *SELLERS v. DICKINSON.* [1850]

The Court will not, in deciding whether there has been an infringement, express an opinion as to whether the jury were justified in their verdict, unless it is contended that the verdict was against evidence. (5 *Exch.* 323.)

(d) *DE LA RUE v. DICKINSON.* [1857]

In an action for the infringement of a patent, the question of infringement is for the jury and not for the judge, although there be no question with respect to whether the defendant has or has not used the particular machine or process which is alleged to be an infringement. (7 *Ell. & Bl.* 738.)

Campbell, C.J., in delivering the judgment of the court, said: "There may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But, if the evidence has a tendency to show that the defendant has used substantially the same means, to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact, or of fact mixed with law, which the judge is bound to submit to the jury." (*Ib.* 755.)

(e) *SEED v. HIGGINS.* H. L. [1860]

When a question of novelty, or infringement, depends merely on the construction of the specification, it is one entirely for the judge; but where it also depends on other circumstances, such as the degree of difference or of similitude between two machines, it is a mixed question of law and fact; what the jurymen find to have been done is the matter of fact, but the judge must apply that fact according to the rules of law, and is entitled and bound to say whether what has been done amounts to an infringement. (8 *H. L. Cas.* 550; 30 *L. J.*, *Q. B.* 314; 6 *Jur.*, *N. S.*, 1264.)

(f) *CURTIS v. PLATT.* H. L. [1866]

The question of infringement is a mixed question of law and fact. (35 *L. J.*, *Ch.* 852.)

**Injunction.** See Practice—Injunction, pp. 330 to 353  
to restrain Threats. See under Threats, p. 545 *seq.*

**Inspection** in Patent Cases. See Practice—Inspection, pp. 324 to 330.

**Intention** to infringe is immaterial. See under Infringement, pp. 202, 203  
may be material in order to show dedication, p. 242 (*d*).

**International** arrangements for protecting inventions. See pp. 61 to 64.  
Exhibition. See Exhibition, p. 93.

**Interrogatories.** See Practice, pp. 318 to 324.

### **In Transitu.**

Infringement by user in transitu in England, pp. 160 (*d*), 162 (*h*), 289 (*d*).

### **Invention.**

PATENTS ACT, 1883, sect. 46. In and for the purposes of this Act, invention means any manner of new manufacture the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James I., chap. 3, intituled An Act concerning Monopolies and Dispensations with penal laws and the forfeiture thereof), and includes an alleged invention.

[For sect. 60 of the Statute of Monopolies, see p. 491.]

[As to what manner of new manufacture may be the subject of letters patent, see under Subject-matter, pp. 491 to 544.]

### **Inventor,**

first and true. See under Patentee, pp. 272 to 278

importer of foreign invention, pp. 144, 278 and 279

merit of, ground for extension, pp. 113 to 116

remuneration of, consideration of, by judicial committee, pp. 120 to 127.

### **Ireland.**

PATENTS ACT, 1883, sect. 110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

### **Isle of Man.**

PATENTS ACT, 1883, sect. 16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.

Sect. 112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those courts;

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

**Issues.** See Practice—Pleading, pp. 290 to 293.

### Joint Inventors.

PATENTS ACT, 1883, sect. 4 (1). Any person, whether a British subject or not, may make an application for a patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

Sect. 5, sub-s. 2. An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

PATENTS ACT, 1885, sect. 5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the Principal Act to grant such a patent.

[As to the declaration which is required, see Patents Act, 1885, sect. 2, under Declaration, p. 81.]

### Joint Owners,

liability of, p. 206 (*h*)

what agreement creates a partnership, pp. 207 (*i*), (*h*), 208 (*n*)

what interest creates a partnership, p. 206 (*g*)

interests of, under agreement relating to prospective patents for particular objects, p. 207 (*j*)

where tenants in common, p. 207 (*l*)

joint tenants, p. 207 (*l*)

right of co-patentees severally to use a joint patent for their own exclusive benefit, p. 208 (*m*)

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cannot severally release joint rights of action, p. 400 (*y*)

estopped from disputing validity of patent as against each other, p. 91 (*q*)

but not by acts of former joint owners, p. 91 (*s*)

nor after termination of partnership, p. 338 (*s*)

one of, may maintain suit if bill not demurred to, p. 288 (*t*)

account of sales or profits between, pp. 369 (*m*<sup>1</sup>), 370 (*o*), (*q*).

(*g*) RIDGWAY *v.* PHILIP. [1834]

A., the patentee of an engine, and B., were partners under the firm of A. & Co. C. purchased the licence of erecting such engines in Cornwall. D. contracted with A. & Co. to erect an engine in Cambridgeshire. A. informed D. that B. and C. were his partners, and C., on being applied to, said it was correct. During the making of the engine, C. frequently came to inquire how the work went on. D. sued B. and C. for a breach of the contract, when C. proved his limited interest in the patent. The jury having found that C. was not a partner, the Court refused a new trial. (1 *C. M. & R.* 415; 5 *Tyr.* 131.)

(*h*) LOVELL *v.* HICKS. Exch. Ch. [1837]

Joint owners of a patent, for a particular process used in carrying on a trade, are answerable *in solido* for the losses occasioned in

relation to the patent by the frauds of their co-adventurers. (2 Y. & C. 481.)

(i) *ELGIE v. WEBSTER.* [1839]

By an agreement in writing, W. agreed with E. to advance him a sum of money for the purpose of manufacturing and perfecting certain inventions; and it was agreed that if the inventions should become of public or private use, W. should be entitled to one-third of the profits of the invention. The agreement contained an express promise on the part of E. to repay the sum of money advanced by W.:—*Held*, in an action brought by W. to recover the money thus advanced, that this agreement did not constitute a partnership between the parties with respect to that sum. (5 M. & W. 518.)

(j) *BEWLEY v. HANCOCK.* Ch. [1856]

An agreement was entered into between four persons who were interested in patents and inventions relating to gutta percha, that all patents taken out, or in the course of being taken, or intended to be taken out, or that might at any time thereafter be taken out by any or either of them, or on account of and for the benefit of any or either of them in relation to the preparation and application of gutta percha, or the manufacture of any article therefrom, should be assigned to trustees, and held for their common benefit. Subsequently one of the parties took out a patent for “improvements in apparatus and machinery for giving shape and configuration to plastic substances,” and refused to assign the patent to the trustees, alleging that it was not comprised in the agreement:—*Held*, that the patent, so far as it related to gutta percha, was subject to the trusts of the agreement, and that it could not be treated as not being so, because it was for machinery which might be applied to the manufacture of articles of gutta percha, and was not for the manufacture of any such articles. (6 De G., M. & G., 391; 2 Jur., N. S., 289.)

(k) *OSBORNE v. JULLION.* [1856]

O. agreed in writing with J. to work certain patents, the property of J., upon an experiment, and on a specified result being attained to the satisfaction of O. to be expressed in writing, the patents were to be assigned to O., and to be worked by J. at a salary. The experiment was successful, but O. neither expressed his satisfaction in writing, nor called for an assignment; and after the lapse of several years filed a bill for a dissolution of the agreement, on the ground of a *quasi* partnership:—*Held*, that there was no partnership, and that therefore the remedy was at law. (4 W. R. 767; 26 L. J., Ch. 6.)

(l) *HANCOCK v. BEWLEY.* Ch. [1860]

Where a patent is vested in trustees upon trust for several tenants in common or joint tenants, *quære*, whether any one of them is at liberty to work the patent on his own account. (*John*. 601.)

## (m) MATHERS v. GREEN. Ch. [1864-5]

A., B. and C. were co-patentees of an improvement upon a prior invention of which C. was the sole patentee. B. & C. having worked the joint patent:—*Held*, that, inasmuch as A. could not use the improvement profitably without the consent of C. as owner of the prior patent, A. was entitled to a third of the profits made by B. and C. from the use of the joint patent as an improvement on the prior patent. (34 *L. J.*, *Ch.* 298.)

The above decision of the Master of the Rolls was reversed by the Lord Chancellor (Cranworth) on the ground that there is no principle of law, in the absence of contract, which can prevent any person not prohibited by statute from using any invention whatever; and no implied contract, where several persons jointly obtain letters patent, that no one of them shall use the invention without the consent of the others, or if he does, that he shall use it for their joint benefit. *Seem*, where letters patent have been granted to more than one person, the Court will not admit parol evidence to show that the patent is the property of one or more to the exclusion of any of the others. (35 *L. J.*, *Ch.* 1; 11 *Jur.*, *N. S.*, 845; 14 *W. R.* 17; 13 *L. T. Rep.*, *N. S.*, 420.)

(n) *Ex parte* MACMILLAN, *In re* WHITTAKER. Ch. [1871]

W., being in difficulties, mortgaged to M. certain patents, to secure advances previously made for the purpose of developing the patents, and paid him, out of the proceeds of the patent, 6*l.* a week:—*Held*, that this payment did not constitute a partnership between W. and M. (24 *L. T. Rep.*, *N. S.*, 143.)

## (o) KENNY'S PATENT BUTTON-HOLEING COMPANY v. SOMERVILLE AND LUTWYCHE. V.-C. B. [1878]

Where a partnership at will is formed, for the purpose of working an invention for which a patent has previously been taken out by and registered in the name of one of the partners alone, the patent becomes an asset of the partnership, and each partner acquires a right to practise the invention; and this right is not taken away by the registered owner assigning the patent to third parties, who have notice of the existence of the partnership. K. had, with the assistance of L., obtained a patent in his own name. After working the patent in partnership with L. for four years, K. agreed with the trustees of a projected company to assign the patent to it. At the time of the agreement the trustees, and at the time of the assignment the directors, knew that L. and K. had been working the invention together. L. was warned not to infringe the patent, but he continued to work the invention, and the company then sought to restrain him from so doing:—*Held*, that by the partnership, L. had obtained a licence to work the invention; that, at the time of the assignment of the patent, the company had notice of the existence of his right; and that they could not revoke the licence. (37 *L. T. Rep.*, *N. S.*, 878.)

**(p) KING v. OLIVER AND Co. [1884]**

In an action for infringement of a patent for apparatus for preventing unwinding at collieries, and for a declaration that an agreement between the plaintiff and one H., was void, it appeared that the plaintiff, the patentee, agreed with H., in 1879, that H., who afterwards assigned to the defendants, should have the sole right of manufacturing the patented article, and should pay one-half the fees for keeping up the patent, and should thereupon become part owner of the patent, and should use his best endeavours to obtain orders for, and manufacture the patented article. The plaintiff and H. were to be entitled to any extension or modification of the patent, or the principle thereof. The plaintiff took out further letters patent in 1882. The jury found that H. had failed to pay some of his share of the fees, and had failed to use his best endeavours, and that the patent of 1882 was a new invention, simply added to the old patent, and not an extension or modification. On these findings, it was declared that the agreement was void, and a motion for a new trial was refused. (1 O. R. 23, 42.)

**(q) WILSON v. BARBOUR. Ireland. C. A. [1888]**

A. and B. being jointly interested in a patent, it was agreed that B.'s firm should make and sell, and use their best endeavours to develop the sale; A. to receive part of the profits, and all future improvements of the patent, whether invented by A. or B., to belong to the patent. B. and Co. found the machine defective; made experiments to improve it; and ultimately adopted a machine with a different principle, and sold them, without sharing the profits:—*Held*, that B. and Co. had not used their best endeavours to develop the sale, and that the plaintiff was entitled to royalties during the continuance of the agreement, but not to damages besides. (5 O. R. 675.)

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**PATENTS ACT, 1883, sect. 117 (1).** In and for the purposes of this Act unless the context otherwise requires: Law Officer means Her Majesty's Attorney-General or Solicitor-General for England.

### Letters Patent.

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(*r*) **CRAMPTON v. SWETE.**

The plaintiff brought an action for libel, alleging that the defendants sent to their customers a circular, stating that they were unable to supply a particular kind of electric bell, invented by the plaintiff, because it had been "proved to be an infringement" of another patented bell. No action had then been brought against the plaintiff for infringement, and, although one was afterwards commenced, it was abandoned:—*Held*, that the plaintiff was entitled to damages. (58 *L. T.* 516.)

### Licence.

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**Licensee,**

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 void, p. 211 (*s*)  
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 patentee and third party, p. 90 (*m*)  
 cannot manufacture articles which are within the specification although  
 known before the date of patent, p. 218 (*p*)  
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 p. 218 (*q*).

(*s*) TAYLOR *v.* HARE. [1805]

A., having obtained a patent for an invention of which he supposed himself the inventor, agreed to let B. use it upon payment of a certain annual sum secured by bond; this sum was paid for several years, when B., discovering that A. was not the inventor, but that it was in public use before A. obtained his patent, brought an action for money had and received, to recover back the amount of the annuity paid:—*Held*, that he could not recover. (1 *B. & P. (N. R.)* 260.)

(*t*) PROTHEROE *v.* MAY. [1839]

The grant of an exclusive licence to use a patent does not invalidate the patent itself, although the patent may be vested in twelve persons; and it is wholly immaterial to its validity, in what number of persons such a licence is vested, whether exclusive or not. Such a licence would not be invalid if the districts or district covered by the licence included the whole extent of the patent. (5 *M. & W.* 675; 1 *Web. P. C.* 414.)

(*u*) CHANTER *v.* LEESE. Ex. Ch. [1839]

By an agreement, not under seal, between the plaintiff and A., B. and C. of the one part, and the defendant of the other part, reciting that the plaintiff had obtained a patent for an improvement in furnaces, and was solely interested in another patent invention; that the plaintiff and A. had obtained a patent for another invention; the plaintiff and B. for another; and the plaintiff and C. for another; it was agreed between the parties, that, for the considerations therein mentioned, it should be lawful for the defendant, *exclusively* to use, manufacture and sell any or all of the said patent inventions, within certain limits, during the continuance of the several patents, on certain terms specified in the agreement. In an action on this agreement by the plaintiff

alone, to enforce one of such terms, the defendant set out the plaintiff's patent for the improvements in furnaces, and pleaded that it was not, at the time of the grant, a new invention, whereby the grant was void, which the plaintiff, at the time of making the agreement, well knew:—*Held*, that the plea was a bar to the action. (4 *M. & W.* 295; 1 *H. & H.* 224; affirmed on appeal; 5 *M. & W.* 698.)

(v) *CHANTER v. DEWHURST.* [1844]

Action for the price of a licence granted by the plaintiffs to the defendants. The licence was in writing, but not under seal. The defendants having received the licence, kept it, and used the invention, but, when called upon to pay the price agreed upon, objected to pay for it, on the ground that it was void, as not being under seal. By the terms of the letters patent, all persons were commanded not to make, use or put in practice the said invention, &c., without the licence, consent or agreement of the patentee, his executors, &c., “in writing, under his or their hands and seals, first had and obtained,” upon pain of a contempt of the royal command, and of being answerable to the plaintiffs in damages:—*Held*, first, that the defendants, having obtained the licence they had bargained for, and kept it, were bound to pay for it; and secondly, that the licence was not void as not being under seal. (12 *M. & W.* 823; 13 *L. J., Exch.* 198.)

(w) *CHANTER v. JOHNSON.* [1845]

Parke, B.: “The licence was rejected at the trial, for want of a stamp, and the question, therefore, arises whether any stamp was necessary. The defendants say the instrument is a deed, and ought to be stamped as such; but that is not so: it does not purport to be sealed and delivered as a deed; it rather resembles an award, or a warrant of a magistrate, which, though under seal, are not deeds.” New trial ordered. (14 *M. & W.* 411.)

(x) *TIELENS v. HOOPER.* [1850]

By indenture, the plaintiff granted to the defendant, for a term of years, the exclusive licence to use a patent upon payment of certain sums by way of royalty. The indenture contained a covenant for payment of the royalty, and also the following:—“And it is hereby agreed that if it shall happen in any year during the continuance of the term that royalties or sums of money hereinbefore covenanted to be paid shall not amount to the sum of £2,000 sterling, then, and in every such case, and as often as the same shall so happen, the defendant shall, within fourteen days after the expiration of any year in which it shall so happen, pay to the plaintiff such a sum of money as with the royalty hereby reserved will amount to £2,000 for that year; or if the defendant shall, at any time, make default in payment of such sum of money aforesaid, within the time appointed for payment, then it shall be lawful for the plaintiff, by writing signed by him, and endorsed on the said indenture or duplicate thereof, to declare that the said

indenture and the powers and licence thereby granted shall cease and determine.”—*Held*, that this was not an absolute covenant on the part of the defendant to pay £2,000 a year during the term, but an alternative covenant, enabling the plaintiff to put an end to the licence on non-payment of that sum by the defendant. (5 *Exch.* 830.)

(y) *WARWICK v. HOOPER.* [1850]

The plaintiffs, the assignees of a patent, granted a licence to the defendant to use the patent upon the terms of his paying an annual rent of £2,000, to be made up at the end of each year, and reserved to themselves the power of determining the licence in the event of default being made in payment of this rent. The defendant failed in paying the rent; but the plaintiffs, notwithstanding, for several years allowed the defendant to use the patent, and received from him a less annual sum than that stipulated. At length, however, they determined the licence, having, subsequently to the expiration of the previous year, received from the defendant payments on the footing of the reduced rent:—*Held*, that, by so doing, the plaintiffs had elected not to treat the previous breach as a forfeiture of the licence, and that consequently they were not entitled to an injunction restraining the defendant from using the patent. (3 *Mac. & G.* 60.)

(z) *BOWER v. HODGES.* [1853]

A., the patentee of machinery for making iron pipes, granted by deed to B. and his assigns the exclusive licence to manufacture them, B. paying a royalty of so much for every ton manufactured or sold by him or his assigns, and to account. B. subsequently assigned his interest in the licence to the plaintiff, who transferred it to M. and R. in trust for the defendants; and the defendants covenanted with the plaintiff to perform the covenants made by B. to A. in the first deed. It was *Held*, that the covenant to account was no qualification of the covenants to pay the royalties, but merely auxiliary to it.

Maule, J.: “You cannot say there is any particular form for passing a licence, but licensing a person and his assigns is licensing him and all whom he may licence. . . . A licence is not really assignable. The assignment acts only as an estoppel between the parties.” (22 *L. J., C. P.* 198.)

(a) *JONES v. LEES.* [1856]

A covenant, by a licensee for the residue of a term of fourteen years, of patented improvements in machinery for slubbing fibrous substances, not to make or use any slubbing frames whatever without the invention applied to them, is not void as a covenant in restraint of trade. (1 *H. & N.* 189; 2 *Jur., N. S.* 645; 26 *L. J., Exch.* 9.)

(b) *SCHLUMBERGER v. LISTER.* [1860]

Declaration for the infringement of a patent. Plea, that admi-

nistrator of the patentee granted a licence to S. and A. to use the patent, who assigned the same to the defendant. Replication on equitable grounds, that the deed of licence was of even date with another deed between the administrator of the patentee, six other persons and S. and A.; and by the latter deed it was witnessed that S. and A. should not manufacture or sell machines under the licence out of Great Britain and Ireland, and that by another deed between S. and A. of the one part, and the defendant of the other part, the defendant covenanted that he would perform all the covenants in the first deed contained, to be performed on the part of S. and A. The replication then alleged breaches of the covenant by the defendant in making and selling machines out of Great Britain and Ireland. Replication held bad on demurrer. (2 *Ell. & Ell.* 870; 29 *L. J., Q. B.* 157; 6 *Jur., N. S.*, 1336; 9 *W. R.* 138; 3 *L. T. Rep., N. S.*, 549.)

(c) *CROSSLEY v. DIXON.* H. L. [1863]

D. agreed verbally with C. to be supplied by C. with machines constructed according to patents of which C. was the owner, and to pay royalties for the use of such machines, and for the use of any machines supplied to him by anybody else which embodied the principle of C.'s patent:—*Held*, that this verbal agreement must be treated as a licence. (10 *H. L. Cas.* 293; 9 *Jur., N. S.*, 607; 32 *L. J., Ch.* 617; 11 *W. R.* 716; 8 *L. T. Rep., N. S.*, 260.)

(d) *THOMAS v. HUNT.* [1864]

A licence to A. to manufacture a patent article is an authority to his vendees to vend it without the consent of the patentee. (17 *C. B., N. S.*, 183.)

(e) *GOUCHER v. CLAYTON.* Ch. [1865]

The patentee of an invention for improved beaters for thrashing machines, granted a licence to the defendants, to make, manufacture and sell machines, as described in the specification, for a term of years, and during the same period to apply the invention to other machines, paying a royalty of 1*l.* for every thrashing machine manufactured by them, and the like sum for every machine made, or to be made, to which the invention should be wholly or in part applied by them; and the defendants covenanted to affix royalty plates to every new and altered machine which should be manufactured or applied by them:—*Held*, that the defendants were not intended to pay royalty merely on every thrashing machine, but that the true construction of the licence was, that they were to pay on all beaters manufactured by them according to the patent, and applied to machines originally, or by way of renewal. (11 *Jur. N. S.* 462; 13 *L. T. Rep., N. S.* 115.)

(f) *HENDERSON v. MOSTYN COPPER COMPANY.* [1868]

The plaintiff being possessed of a patent, granted to the defendants the exclusive licence to work it in a certain district,

by a deed by which the latter covenanted to pay certain royalties, and to give every information the better to enable the patentee to support the letters patent; and the patentee covenanted for quiet enjoyment of the patent by the defendants, and that, "in case any person should work the patented processes, the patentee would, at his own cost, commence and carry on all such actions, &c., as should be necessary to establish the validity of the patent, and to put a stop to the working of the patented processes by such person; and that, in case the patentee should fail or neglect so to establish or maintain the validity of the patent, and to put a stop to the working of the patented processes by such other person, he (the patentee) would not call upon the defendants, nor should the defendants be liable thenceforth to pay any royalty, until the patentee should, by authority of law, or otherwise, have restrained such person from working under the letters patent:"—*Held*, that the condition for suspension of payment of the royalties did not come into operation until the patentee had notice of an infringement, and until after the lapse of a reasonable time to allow him an opportunity of instituting proceedings to restrain it. (*L. R.*, 3 *C. P.* 202.)

(g) *KNOWLES v. BOVILL.* [1870]

The plaintiff was the holder of a licence to use a patented invention from the patentee. The patentee intending to apply for a prolongation of this patent, and also for a patent for a new invention of a similar description, the plaintiff agreed to give him 150*l.* for the free use for ever of the former patent, as well as for the free use for three years of the new patent which the patentee was about to take out. The money was paid to the patentee, but he died almost immediately afterwards, and in consequence of his death no application was ever made for a renewal of the former patent or the grant of one for the new invention. The plaintiff brought an action against the patentee's executors to recover back the money, on the ground that the consideration for it had totally failed:—*Held*, that he was entitled to maintain the action on the ground that, on the true construction of the contract between the parties, he had bought the right to have an application for the patents made, not merely the right to have the benefit of it if it should happen to be made, and the consideration had therefore totally failed. (22 *L. T. Rep.*, *N. S.* 70.)

(h) *HASSALL v. WRIGHT.* [1870]

W., a patentee, granted to H. an exclusive licence to manufacture, by a deed which was prepared by the solicitor of W. alone. This deed was not registered:—*Held*, that W. could not avail himself of the non-registration of the licence as a defence to an action by H. (40 *L. J. Ch.* 145.) (*Per* Cotton, *L.J.*, in *Heap v. Hartley*, 6 *O. R.* 495. "In *Hassall v. Wright* it was not meant that a licence was equivalent to an assignment.")

(i) *BETTS v. WILLMOTT.* Ch. [1871]

Where the owner of a patent manufactures and sells the patented article in a foreign country as well as in England, the sale of the article in one country implies a licence to use it in the other. But if he has assigned his patent in either country, the article cannot be sold so as to defeat the rights of the assignee. (*L. R.*, 6 Ch. 239; 19 *W. R.* 369.)

(j) *RODEN v. THE LONDON SMALL ARMS COMPANY.* Q. B. [1876]

The plaintiff granted by deed to the defendants a licence to use a patented invention for the manufacture of rifles, on payment of a fixed royalty, which the defendants covenanted to pay for every rifle manufactured or produced "under the powers hereby granted." At the time the deed was entered into, as well as previously, the defendants had been manufacturing arms, under contracts, for the British Government, in accordance with the plaintiff's patent, and without paying royalties, under the belief that they were legally entitled to do so; and the deed itself, as the plaintiff knew, was intended by the defendants to apply only to rifles exclusive of those manufactured by the Government. Some years after it was decided that the right of the Crown to the free use of a patent did not extend to manufacturers fulfilling Government contracts, and the plaintiff thereupon brought his action under the deed to recover royalties on all arms so manufactured from the time that the deed was entered into:—*Held*, that he was not entitled to recover; for, though the terms of the licence would, *prima facie*, be taken to include every exercise of the patented invention, the words "under the powers hereby granted," contained a latent ambiguity, which admitted of parol evidence to show that the deed was not intended to apply to rifles manufactured for the Government:—*Held*, also, that, irrespective of the construction to be put on the deed, there was a good equitable defence to the claim. (46 *L. J.*, Q. B. 213.)

(k) *CLARK v. ADIE.* Ch. [1877]

A patentee who grants a licence cannot, without derogating from his grant, publish advertisements and circulars which have the effect of deterring usual customers or the public from dealing with his licensee. (21 *W. R.* 456; affirmed on appeal, 21 *W. R.* 764.)

A licensee under a patent cannot in any way question its validity during the continuance of his licence. But he may show that what he has done does not fall within the limits of the patent. (*L. R.* 2 App. C. 423.)

(l) *SOCIÉTÉ ANONYMES DES MANUFACTURES DE GLACES v. TILGHMAN'S PATENT SAND BLAST COMPANY.* C. A. [1883]

The defendants, who were owners of patents in Belgium and England for an invention for making lamp globes, by a deed

executed in Belgium, granted a licence to the plaintiffs during the continuance of the patent for twenty years (which clearly pointed to the Belgian patent) to use and employ the said invention which has been patented, at their manufactory, which was situated in Belgium and not elsewhere:—*Held*, that this licence did not imply permission to sell the manufactured articles in England in violation of the defendants' English patent. (25 *Ch. D.* 1; 53 *L. J. Ch.* 1; 49 *L. T.* 451; 32 *W. R.* 71.)

(m) *COUCHMAN v. GREENER.* [1884]

Where a licensee disputes his liability to pay royalties, the question is, would the articles made by him be infringements of the patent as it stands, and it is immaterial to say that the articles would be within an older patent, because that amounts to saying that the licensor's patent is bad, which he is not entitled to do. (*Griff.* 58; 1 *O. R.* 197.)

(n) *WARD v. LIVESEY.* [1887]

The owners of a patent granted a licence under seal upon certain terms and conditions, some of which were not complied with. The plaintiffs gave notice by letter to the defendants that the licence was determined, but the defendants did not assent, and the plaintiffs brought this action:—*Held*, that the licence was one coupled with an interest and therefore not revocable at will, but that the terms had in fact been broken, that the plaintiffs thereupon became entitled to determine it, and that the letter, although not under seal, was sufficient for that purpose. (5 *O. R.* 102.)

(o) *BOWN v. HUMBER AND COMPANY.* [1888]

The plaintiff having brought an action for infringement against Humber and others, judgment was given against the defendants by consent upon certain terms, and part of the order was that the plaintiff should grant and the defendant should accept a licence to use the invention at a certain royalty. Accordingly the plaintiff granted to Humber and others, who were the assignors to the present defendant company, a licence within the United Kingdom, the Channel Islands and the Isle of Man, to make, use, exercise, and put in practice the said invention for the purpose of applying the said invention to the wheels of bicycles, tricycles and other carriages manufactured for sale or use, or otherwise by the licensees or by persons employed by them, but not in any other manner. The licence was not to authorise the use of the invention by the licensees individually and separately from each other, but only by the licensees jointly or by such two or one of them as should continue to carry on the business hitherto carried on by the three licensees in partnership at Beeston, or the person or persons or company from time to time carrying on such business:—*Held*, that the original licensees had a right to start a business and to manufacture under the licence elsewhere than at Beeston, and that their assignees, the present defendants, were therefore also entitled to do so. (6 *O. R.* 9.)

(p) *CROSTHWAITE v. STEEL*. [1889]

The plaintiffs, who were patentees of an improved canopy for fire-grates, entered into an agreement with the defendants that they should be at liberty for ten years to manufacture grates with the patent canopy, each of the grates to have stamped on it in a prominent position "Crosthwaite's Patent." On a motion for an interim injunction to prevent the defendants from selling grates stamped inside, the defendants undertook not to sell grates having the patent canopy unless stamped in a prominent position; but later on they found, as they alleged, that the canopies which they were selling were the same as canopies manufactured before the date of the plaintiffs' patent, and differed from the plaintiffs' patent canopy in having side wings. The defendants at the trial attempted to use the fact that these side winged canopies were known before in order to show that the plaintiffs' specification must be read so as not to include them. *Held*, that between licensor and licensee this could not be allowed when the specification was not ambiguous, and that the defendants' canopies were in fact substantially the same as that described in the plaintiffs' specification. (6 O. R. 190.)

(q) *OTTO v. SINGER*. [1889]

The plaintiff, when he had obtained provisional protection only, granted by deed a licence to the defendant to use the invention, paying royalties, for a year certain, and further from year to year during the continuance of the said letters patent to be granted (if granted) for the said invention, or any prolongation or extension thereof. The plaintiff covenanted to complete the letters patent, but when before the Comptroller he admitted that he knew of the claims of certain prior patentees to the use of tires with a helical spring core and the introduction into an india-rubber tire of a core of corrugated steel wire, and was compelled to abandon this part of his claim. The defendant alleged that it was the use of the invention so disclaimed that they intended to obtain in taking the licence, and refused to pay royalties after the first year:—*Held*, that there was no ground for saying that there was a total failure of consideration, and that there was no misrepresentation, and that therefore the defendants were liable to pay the royalties. (6 T. L. R. 52; 7 O. R. 7.)

(r) *HEAP v. HARTLEY*. C. A. [1889]

The patentee of a machine had granted an exclusive licence to the plaintiff to use and exercise his invention within a certain district for four years, with a conditional contract that if there was any infringement either within or without the district the patentee would allow the licensee to use his name in order to sue the infringer, and the deed conferring the licence was duly registered. The defendants bought machines outside the district from persons who had purchased from the patentee and brought them into the district and used them there. The licensee brought this action to restrain such user, and the action was dismissed:—*Held*, on appeal, (1) that if the plaintiff relied on actual notice of the licence, the



onus was on him to prove it, and that he had not done so; (2) that where, as in this case, there is only a licence not entitling the licensee to take anything away, then it is merely an authority to the licensee to do that lawfully which without the licence he could not do, and is not a grant; (3) that therefore the plaintiff could not sue except in the name of the patentee, and could not sue in his name because the patentee's rights had not been violated; (4) that it was not material to consider the effect of sect. 87 of the Act of 1883. (6 *O. R.* 495.)

(s) **POSTCARD AUTOMATIC SUPPLY COMPANY v. SAMUEL.** [1889]

Where parties are negotiating as to a licence to work a patent, and terms have been proposed and accepted by letter preparatory to the execution of a formal document, the parties stand in the same position in equity as if the legal document had been executed. In this case an agreement had been arrived at, but the licence had not been settled, and the defendant, who had not paid royalties, set up as defences to an action for infringement of the patent (1) that the articles were manufactured under the licence, and (2) that the patent was invalid:—*Held*, that the defendant must elect on which of these defences he would rely, and that the plaintiffs were justified in revoking the licence, as the royalties had not been paid. On the defendant electing to rely on the second ground, held that he must remove the words “manufactured under licence from the Postcard Company” from the machines. (6 *O. R.* 560.)

(s<sup>1</sup>) **ASHWORTH v. LAW.** [1890]

The plaintiff's claim being against the defendants as licensees, the defendants pleaded *inter alia* that if the patent was construed so as to include what they were doing, it would be invalid for want of novelty, and also that the patent was invalid:—*Held*, that these pleas must be struck out as embarrassing. (7 *O. R.* 231.)

**Limited** grant in case of rival inventors, p. 150 (z).

**Lunatic.** Declaration by, Patents Act, 1883, sect. 99, p. 81.

**Making.** See Infringement by Making, pp. 156 to 163.

**Manufacture.** See under Subject Matter, pp. 491 to 500.

**Materials** to be used must be in the market, p. 219 (t).

(t) **DEROSNE v. FAIRIE.**

The materials described in the specification as those to which the patented process is to be applied must be substances capable of being ordinarily purchased in the market as articles of commerce. (1 *Web. P. C.* 158.)

**Memorandum of Alteration.** See Amendment by Disclaimer, p. 15 amendment of, p. 29 (q).

**Merit**, of inventor, ground of extension, pp. 113 to 116.

**Method of Obtaining Letters Patent.** See Application, p. 33.

**Minor.** Joint patent granted to, p. 277 (*a*).

**Misleading Specification.** See under Specification, pp. 436 to 445.

**Misrepresentation** in Specification will avoid the patent, pp. 436 (*i*), 437 (*j*).

**Model,**

making patent machine as, no infringement, p. 156 (*t*)

public user of invention by exhibition of, pp. 232 (*f*), 242 (*d*), 265 (*n*), 266 (*s*)

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PATENTS ACT, 1883, Sect. 42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

**Monopolies,** Statute of. See p. 491

Construction of, pp. 492 (*b*), 534 (*n*).

**Mortgagee** of patent need not be joined as plaintiff in action for infringement, p. 290 (*e*).

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**New Use,** application to. See under Subject Matter, pp. 522 to 532.

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**Novelty of Invention,**

*Novelty generally,*

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in principle of invention, p. 224 (*d*)

method of effecting a known object, p. 225 (*f*)

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*Want of, in a Part of an Invention,*

when that part is material, pp. 228 (*v*), 230 (*a*)

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in subsidiary invention, p. 231 (*d*)

when advantages only claimed, p. 232 (*e*).

*Public Use,*

- meaning of, pp. 235 (*j*), (*l*), 236 (*n*), 242 (*e*)
- by exhibition of a model, pp. 232 (*f*), 242 (*d*), 266 (*s*)
- by experiments. See pp. 261 to 265
- by sale. See pp. 265 to 267
- when accidental, pp. 233 (*g*), 238 (*r*)
- of abandoned invention, pp. 235 (*l*), 241 (*z*), 262 (*e*)
- need not continue to date of patent, pp. 235 (*l*), 236 (*m*), 262 (*e*)
- in a private place, p. 236 (*m*), (*m*<sup>\*</sup>)
- by what number of persons, immaterial, p. 236 (*m*)
- without sale, pp. 240 (*s*), 266 (*t*), (*u*)
- manufacture of patent article by inventor prior to grant, pp. 234 (*i*), 238 (*q*), 242 (*e*)
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*Secret Use*—pp. 242 and 243.*Publication in a Book or Specification*—

- between date of patent and specification, p. 244 (*j*)
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*Novelty Generally.*

## (u) HASTINGS' PATENT. [1567]

A patent was granted to Mr. Hastings "in consideration that he brought in the skill of making frisadoes, as they were made in Harlem and Amsterdam, beyond the seas, *being not used in England*, that therefore he should have the sole trade of the making and selling thereof for divers years, charging all other subjects not to make any frisadoes in England during that time, by pain to forfeit the same frisadoes by them made, and to forfeit also 100*l.*, the one moiety thereof to the Queen's Majesty, the other to Mr. Hastings." This patent being infringed by certain clothiers, Mr. Hastings "exhibited his English bill in the Exchequer Chamber against them; where, upon the examination of the clause, it appeared that the same clothiers did make baies very like to Mr. Hastings' frisadoes, and that they used to make them before Mr. Hastings' patent; for which cause they were neither punished, nor restrained from making their baies like to his frisadoes." (*Noy, R.* 182; 1 *Web. P. C.* 6.)

## (v) MATTHEY'S PATENT. [Eliz.]

By this patent "it was granted unto him the sole making of knives with bone hafts and plates of lattin, because, as the patent suggested, he brought the first use thereof from beyond seas. Yet nevertheless, when the wardens of the Company of Cutlers did show before some of the council and some learned in the law, that they did use to make knives before, though not with such hafts, that such a light difference or invention should be no cause to restrain them, whereupon he could never have benefit of this patent, although he laboured very greatly therein." (*Noy, R.* 178; 1 *Web. P. C.* 6.)

## (w) HUMPHREY'S PATENT.

A patent was granted to Humphrey "for the sole and only use of a sieve or instrument for melting of lead, supposing that it was of his own invention, and therefore prohibited all others to use the same for a time. And because others used the like instrument in Derbyshire, contrary to the intent of his patent, therefore he did sue them in the Exchequer Chamber, by English bill. In which Court the question was, whether it was newly invented by him, whereby he might have the sole privilege, or else used before at Mendiff, in the west country, which if it were there before used, then the Court were of opinion that he should not have the sole use thereof." (*Noy, R.* 183; 1 *Web. P. C.* 7.)

## (x) DARCY v. ALLIN. [1602]

"Where any man doth bring any *new* trade into the realm, or any engine tending to the furtherance of a trade, *that never was used before*, the king may grant to him a monopoly patent." (*Noy, R.* 182; 1 *Web. P. C.* 6.)

(y) ROEBUCK *v.* STIRLING. H. L. [1774]

Public user of an invention in England is sufficient to invalidate a patent subsequently granted for the same invention in Scotland. (*Web. P. C.* 45 and 451, n.)

(z) LIARDET *v.* JOHNSON. N. P. [1778]

The general question is, whether the invention was known and in use before the patent. (*Bull. N. P.* 76; 1 *Web. P. C.* 53; 1 *Carp. P. C.* 35.)

(a) R. *v.* ARKWRIGHT. N. P. [1785]

*Scire facias* to repeal letters patent granted to the defendant. The specification described various parts of machinery, but no complete machine, and the defendant did not point out what parts were new. Buller, J., left the following questions to the jury:—"First, whether this invention is new? secondly, if it be new, whether it was invented by the defendant?" After commenting upon the evidence, his lordship said: "Thus the case stands as to the several component parts of this machine; and if, upon them, you are satisfied that none of them were inventions unknown at the time this patent was granted, or that they were not invented by the defendant, upon either of these points the prosecutor is entitled to your verdict." (*Dav. P. C.* 61; 1 *Web. P. C.* 64; 1 *Carp. P. C.* 53.)

(b) HUDDARD *v.* GRIMSHAW. N. P. [1803]

Action for the infringement of a patent for a new mode of making cables and other cordage. Ellenborough, C.J., in addressing the jury, said: "In inventions of this sort, and every other through the medium of mechanism, there are some materials which are common, and cannot be supposed to be appropriated in the terms of any patent. There are common elementary materials to work with in machinery, but it is the adaptation of those materials to the execution of any particular purpose, that constitutes the invention; and if the application of them be new, if the combination in its nature be essentially new, if it be productive of a new end, and beneficial to the public, it is that species of invention, which, protected by the king's patent, ought to continue to the person the sole right of vending; but if, prior to the time of his obtaining a patent, any part of that which is of the substance of the invention has been communicated to the public in the shape of a specification of any other patent, or is a part of the service of the country so as to be a known thing, in that case he cannot claim the benefit of his patent." . . . If, in his specification, the patentee "appropriates more than his own, he cannot avail himself of the benefit of it. . . . And if he states that which of itself is not new, but old and known to the world, though it was unnecessary for him to do so, having done so, he has overstepped his right, and has included in his invention that which is not his invention; in that respect his patent would be void." (*Dav. P. C.* 278; 1 *Web. P. C.* 86; 1 *Carp. P. C.* 225.)

## (c) MANTON v. MANTON. N. P. [1815]

Action for the infringement of two patents, one for a hammer upon an improved construction, for the locks of fire-arms; the other, for "an improvement in double-barrelled guns." Gibbs, C.J., in directing the jury, said: "In order to support a right to the exclusive enjoyment of any invention, it is necessary that the party who takes out the patent should show that the invention is new, that it was unknown to the trade and to the world before, that it is not only new, but that it is useful to the public; and it is necessary likewise that he should show that he has accurately explained the nature of his invention in his specification, separating that which is new from that which is old. (*Dav. P. C.* 343.) . . . If any one man made these locks, and was in possession of the secret of making them upon the same principle as Joseph Manton's locks, there would be an end of the patent." (*Ib.* 353.)

## (d) R. v. CUTLER. Sci. fas. [1816]

*Scire facias* to repeal the defendant's patent for "improvements in firegrates or stoves." The specification, after describing the stove, claimed as the invention, the construction of stoves in such manner as that the fuel necessary to supply the fire shall be introduced from beneath, either in a perpendicular, or in an oblique direction. Ellenborough, C.J., was of opinion that the evidence showed grates to have been constructed, prior to the patent, on a principle identical with that described in the specification; that the patentee, by his claim, had confined himself to that principle, which was not new, and that, therefore, the patent could not be supported, although the application of the principle, as described in the specification, was new. (1 *Stark.* 354; 1 *Web. P. C.* 76; 1 *Carp. P. C.* 351.)

## (e) HILL v. THOMPSON. [1818]

Dallas, J., in delivering the judgment of the Court of Common Pleas, said: "This, like every other patent, must undoubtedly stand on the ground of improvement, or discovery. If of improvement, it must stand on the ground of improvement invented; if of discovery, it must stand on the ground of the discovery of something altogether new; and the patent must distinguish and adapt itself accordingly. If the patent be taken out for discovery, when the alleged discovery is merely an addition or improvement, it is scarcely necessary to observe that it will be altogether void. . . . If the discovery claimed were known and made use of before, the patent is at an end. Now, with reference to this particular case, it may be proper shortly to consider, what novelty and discovery are deemed to be; and when I say novelty and discovery, I mean to distinguish between those terms; for it is not enough to have discovered what was unknown to others before, if the discovery be confined to the knowledge of the party having made it; but it must have been communicated, more or less, or it must have been more or less made use of, so as to constitute discovery, as applied to subjects of this sort. The case of *Dollond* has been

mentioned at the bar, as also *Tennant's* patent for bleaching liquor, and they stand so contrasted as to illustrate the distinction to which I allude." (2 *B. Moo.* 451; 8 *Taunt.* 394; 1 *Web. P. C.* 244.)

(f) *HULLET v. HAGUE.* [1831]

When the object of two patents is the same, but the mode of effecting that object, which is the thing claimed, is different, the prior patent does not affect the novelty of the subsequent one.

A patent was taken out for improvements in evaporating sugar, &c. The specification stated that the invention consisted in forcing air through the liquid or solution subjected to evaporation by means of pipes, whose extremities reach nearly to the upper or interior area of the bottom of the pan or boiler containing such liquid or solution, *the other extremities of such pipes being connected with larger pipes*, which communicate with the bellows. The lesser pipes were to be equally distributed, and their lower ends on a level with each other. It was further declared, that the form of the apparatus might be varied, provided the essential properties were maintained:—*Held*, that taking the whole of the specification together, it appeared that the invention consisted of the particular method or process of forcing, by means of bellows, &c., air through the liquid subjected to evaporation, viz., *by pipes connected with larger pipes, and placed as mentioned in the specification*; and, therefore, that it was not void because another patent had been before granted to other persons for effecting the same object, by a coil of pipes (lying at the bottom of the vessel), perforated with small holes, or by a shallow cullender placed at the bottom of the vessel. (2 *B. & Ad.* 370.)

(g) *BROWN v. ANNANDALE.* H. L. [1842]

It is essential to the validity of a Scotch patent that the invention should be new in England as well as in Scotland. Accordingly evidence of the public use of an invention in England prior to the date of letters patent for Scotland is admissible, and will invalidate such letters patent. (1 *Web. P. C.* 433; 8 *Cl. & F.* 437.)

(h) *NEWTON v. THE GRAND JUNCTION RAILWAY COMPANY.* [1846]

Pollock, C.B.: "In order to ascertain the novelty, you take the entire invention, and if, in all its parts combined together, it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent." Alderson, B.: "In considering whether the invention is new, the proper mode is to take the specification altogether, and see whether the matter claimed as a *whole* is new. Now, the whole which may be new as claimed, may consist in some degree of old parts, and in some degree of new parts. The question of novelty, however, will depend on whether the whole taken altogether is new, though it may in part consist of old parts, provided the patentee does not claim

the old parts, but only the combination of them and the new." (5 *Exch.* 334; 20 *L. J.*, *Exch.* 429.)

(i) *NEWTON v. VAUCHER.* [1851]

The defendant in 1839 obtained a patent for an improvement in packing hydraulic and other machines by means of a lining of soft metal, the effect of which was to make certain parts of the machines air and fluid tight. Subsequently to this the plaintiffs discovered that the same soft metal had the effect of diminishing friction, and of preventing the evolution of heat when applied to the surfaces in contact of machines in rapid motion and subject to pressure; and he embodied the application of that discovery to machines in a patent, dated 1843.—*Held*, that as the plaintiff's application of the soft metal differed essentially from that of the defendant, the plaintiff's patent was new. (6 *Ex. Rep.* 859; 21 *L. J.*, *Ex.* 305.)

(j) *DAW v. ELEY.* Ch. [1867]

The antecedent existence of an invention which was so far similar, that, if subsequent in date to the patent, it would have been held a colourable and clumsy imitation for the purpose of effecting the same result, did not invalidate the patent by anticipation. (*L. Rep.*, 3 *Eq.* 496; 14 *W. R.* 126; 13 *L. T. Rep.*, *N. S.* 399.)

(k) *PARKES v. STEVENS.* Ch. [1869]

When, in a patent for an entire combination, the novelty of any individual part of the combination has to be determined, it is best done by asking whether, upon the evidence, it could by itself have been the subject of a valid patent. (*L. Rep.*, 5 *Ch.* 38; 18 *W. R.* 234; 22 *L. T. Rep.*, *N. S.* 639.)

(l) *CANNINGTON v. NUTTALL.* H. L. [1871]

The Lord Chancellor, moving the judgment of the House of Lords, said: "I take it that the test of novelty is this: Is the product which is the result of the apparatus for which an inventor claims letters patent, effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view." (*L. Rep.*, 5 *H. L.* 216.) His Lordship considered the following direction to a jury to be correct: "If a person takes well-known processes from a great number of sources and a great many inventions, and adapts them altogether to a perfectly new combination, for a perfectly new purpose, their previous use is not an anticipation of the patent." (*Ib.* 222.) (*L. Rep.*, 5 *H. L.* 205; 40 *L. J.*, *Eq.* 739.)

(m) *MURRAY v. CLAYTON.* Ch. [1872]

Sir W. M. James, L.J., in the course of his judgment in this case, said: "I am not aware of any principle or authority upon which the exhibition of a useless machine which turns out



a failure can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines." (*L. Rep.*, 7 Ch. 581; 20 *W. R.* 650.)

(n) *ROLLS v. ISAACS.* [1881]

The district of Natal is a British colony with a separate government under a Governor appointed by the Crown, and a law has been passed by the legislative council, providing for the granting in the colony of patents for inventions:—*Held*, that the validity of letters patent under the great seal for licence to use an invention in the United Kingdom of Great Britain and Ireland, the Channel Islands and the Isle of Man, would not be impeached by the fact if proved of prior use of the invention in Natal. (19 *Ch. D.* 268.) *Brown v. Annandale* 8 Cl. & F. 437, and *Roebuck v. Stirling*, *Ib.* 446 (n) distinguished.

(o) *SAXBY v. THE GLOUCESTER WAGGON COMPANY.* H. L. [1883]

The validity of the plaintiff's patent was disputed on the ground of want of novelty. The plaintiff admitted that all the material parts of his invention were to be found in two prior inventions, but tried to show that the combination of these two inventions required such skill and ingenuity as to entitle it to protection. There being evidence that any person of ordinary knowledge of the subject would be able to effect the combination without further experiment:—*Held*, that the finding of want of novelty could not be upset. (7 *Q. B. D.* 305; affirmed on appeal, *W. N.* 1882, 102; 2 *Griff.* 54; *Good P. C.* 417.)

(p) *YOUNG v. ROSENTHAL.* [1884]

It is not necessary in order to anticipate a patent that the old things should be exact and identical with the patent. Could the patentee—that is not a bad test—stop the public from using them under his patent? If he could, and they had been used before, then his patent is bad, because he has no right to stop the public, who used it before. (*Griff.* 249; 1 *O. R.* 29.)

(q) *BADISCHE ANILIN UND SODA FABRIK v. LEVINSTEIN.* H. L. [1887]

The defendants alleged that though the particular substance obtained by the plaintiff's patented process, was previously unknown, yet that similar bodies arrived at by similar processes were well known, and that chemical analogy would at once indicate the supposed invention:—*Held*, that this only amounted to saying that the inventor only completed by one step the route to which chemical discoveries had been tending without his aid, and did not invalidate the patent. (12 *App. C.* 710.)

(r) *GOSNELL v. BISHOP.* C. A. [1888]

Patent for improvement in stretchers for trousers held not to have been anticipated. Where there has been a long unsatisfied

demand, and suddenly an article springs into existence and satisfies it, it may be inferred that ingenuity was required to surmount the obstacle which would seem to have existed. (5 O. R. 151.)

(s) *EHRLICH v. IHLEE*. C. A. [1888]

It was admitted that the parts of the plaintiff's invention were not new, but the claim was for a combination; 150,000 of the plaintiff's instruments had been sold, and there had been no such previous sale. The inference was irresistible that the instrument supplied a want, and this was cogent, though not conclusive evidence of novelty. (W. N. 1888, 50; 5 O. R. 437.)

(t) *MORGAN v. WINDOVER*. H. L. [1890]

Patent for a combination of C springs and elliptic springs in the front part of a carriage held not to be new. The Court of Appeal held (Coleridge, C.J., diss.) that the anticipation alleged was experimental. The House of Lords declined to decide that point, as they held that the invention was not subject-matter. (W. N. 1887, 143; 1888, 80; 3 T. L. R. 748; 5 O. R. 295; 7 O. R. 131.)

(t<sup>1</sup>) *DOWLING v. BILLINGTON*. [1890]

A patent for weaving wire mattresses by a particular method, so as to distribute the strength evenly, was *held* by the Court of Appeal in Ireland not to be anticipated by prior methods which used the same machinery but did not obtain an even distribution of strength. (7 O. R. 191.)

*Want of Novelty in a Part of an Invention.*

(u) *BRAMAH v. HARDCASTLE*. N. P. [1789]

The patent was for a water-closet upon a new construction. It was objected that the patent, being taken for the whole water-closet, the arrangement of some of the parts only being new, was void. Kenyon, J., said: "Unlearned men look at the specification, and suppose everything new that is there. If the whole be not new, it is hanging terrors over them." The question for the jury is, whether the principle of the invention, and the means employed to effect the object to be obtained, are new; whether the shape is new or not is immaterial. (*Holroyd*, 81; 1 *Carp. P. C.* 168.)

(v) *HILL v. THOMPSON*. [1818]

Dallas, J.: "If any part of the alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void." (2 *B. Moo.* 457; 8 *Taunt.* 401; 1 *Web. P. C.* 249.)

(w) *BRUNTON v. HAWKES*. [1821]

Patent for "certain improvements in the construction, making, or manufacturing of ships' anchors, and windlasses, and chain

cables or moorings." It was proved at Nisi Prius, that the mode of manufacturing anchors described in the plaintiff's specification had never been applied before to ships' anchors; but had been applied to the adze-anchor, and the mushroom-anchor. These anchors are used only for the purpose of mooring floating lights or vessels intended to be stationary, and are never taken on board. The jury having found a verdict for the plaintiff, the defendant obtained a rule *nisi* for a new trial, which the court afterwards made absolute. In his judgment, Abbott, C.J., said: "I think so much of the plaintiff's invention, as respects the anchor, is not new, and that the whole patent is, therefore, void. . . . A man cannot be entitled to a patent for uniting two things instead of three, where that union is effected in a mode well known and long practised for a similar purpose. It seems to me, therefore, that there is no novelty in that part of the patent as affects the anchor, and, if the patent had been taken out for that alone, I should have had no hesitation in declaring that it was bad. Then, if there be no novelty in that part of the patent, can the plaintiff sustain his patent for the other part, as to the mooring chain? As at present advised I am inclined to think that the combination of a link of this particular form with the stay of the form which he uses, although the form of the link might have been known before, is so far new and beneficial as to sustain a patent for that part of the invention, if the patent had been taken out for that alone. But inasmuch as one of the things is not new, the question arises, whether any part can be sustained. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The king could not, in consideration of a new invention in one article, grant a patent for that article and another. The question then is, whether, if a party applies for a patent, reciting that he has discovered improvements in three things, and obtains a patent for these three things, and in the result it turns out that there is no novelty in one of them, he can sustain his patent. It appears to me, that the case of *Hill v. Thompson*, which underwent great consideration in the Common Pleas, is decisive upon that question (4 B. & Ald. 549.) . . . The consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The consideration is the entirety of the improvement of the three; and if it turns out there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention." (*Id.* 552.) (4 B. & Ald. 541; 1 Carp. P. C. 405.)

(x) LEWIS v. MARLING. [1829]

Parke, J.: "The objection to the patent, as explained by the specification, may be thus stated. The patent is for several things, one of which, then supposed to be useful, is now found not to be so; but there is no case deciding that a patent is on that ground void, although cases have gone the length of deciding, that if a

patent be granted for three things, and one of them be not new; it fails *in toto*." (10 *B. & C.* 27; 5 *M. & R.* 70; 4 *C. & P.* 58; 1 *Web. P. C.* 497.)

(y) *KAY v. MARSHALL.* [1839]

Tindal, C.J.: "If part of what is claimed is not properly the subject of a patent, or not new, the whole must be void." (5 *Bing. N. C.* 501; 7 *Scott*, 561.)

(z) *GIBSON v. BRAND.* [1842]

*Held*, that, inasmuch as the patentees claimed eight several heads of invention, in order to support their patent they were bound to show that each of the parts was new. And that, if the patent be for a new or improved process, and the jury find the process not to be new but improved, *seem* that the patent is invalid. (4 *M. & G.* 179; 4 *Scott, N. R.* 844; 1 *Web. P. C.* 631.)

(a) *MUNTZ v. FOSTER.* N. P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships." The patentee declared the nature of his invention to consist "in making the said plates for sheathing of an alloy of zinc and copper, in such proportions and of such qualities as, while it enables the manufacturer to roll the said compound metal into plates or sheets less difficult to work, &c., renders the said sheathing less liable to oxydation," &c. The plaintiff claimed "the manufacture of metal plates or sheets for the purpose aforesaid, of an alloy of copper and zinc in such proportions as will enable the manufacturer to roll the said alloy while at a red heat, into sheets fit for the sheathing of ships," &c.

Tindal, C.J., said to the jury: "The only further objection is, that hot rolling is made an essential part of the plaintiff's invention, and is not new, inasmuch as that is pointed out in Collins's specification, and has also been carried into practice—that that renders the patent void. I cannot understand that if the invention consists of various parts—that is, of the compound of the plates, and he states, as he goes along, that it is an advantage that it will roll hot—and the subject of it is, that it shall make an alloy for sheathing—the rolling of it hot, that being known before, will invalidate the patent." (2 *Web. P. C.* 112.)

(b) *TEMPLETON v. MACFARLANE.* H. L. [1848]

A patent was taken out for "a new and improved mode of manufacturing silk, cotton, linen, and woollen fabrics." The specification, and a disclaimer, set forth that the patentees claimed "the mode hereinbefore described of producing or preparing stripes of silk, cotton, woollen, or linen, or of a mixture of two or more of these materials, in such a manner that the weft, or lateral fibres of both cut edges of each stripe are all brought up on one side, and into close contact with each other, and the re-weaving of such stripes with the whole fur or pile uppermost, into the surfaces of carpets," &c. One of these processes was old. The judge directed

the jury, that if one was new, the patent could be supported for the combination of them, and would only be invalid if there had been a public use of both before the date of the patent:—*Held*, that this direction was erroneous, and that the patent was void. (1 *H. L. Cas.* 595.)

(c) *M'CORMICK v. GRAY.* [1861]

The specification of a patent reaping machine described the improvements as having for their object the holding of the straw in a favourable position while being cut, and the more conveniently arranging, collecting, and disposing of it when cut. Underneath a set of spear-head shaped fingers, placed at regular intervals apart from each other, was placed the cutting-blade, formed of a thin plate of steel, toothed upon its front edge and fitted into a groove, the blade having perfect freedom to slide from one side of the machine to the other. Wheel-gearing, being set in motion by the horse attached to the machine, caused a reel or gatherer to revolve, and so prevent the straws from being pressed forward when coming in contact with the cutting-blade, which had a rapid reciprocating motion imparted to it by the action of a crank and connecting-rod. "It has been found (the specification stated) to be of great advantage to have the cutting edge toothed somewhat similar to a sickle, and to have those teeth divided into sections corresponding to the number of fingers, each section having one half of the teeth inclined in one direction, and the other half having the teeth inclined in the opposite direction." The inventor claimed "the constructing and placing of holding-fingers, cutting-blades, and gathering-reels respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them, in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed." The published description of a previous patent machine stated it to be "for improvements in that kind of the machine in which the grain is cut by the serrated edge of a straight and vibrating cutter operated by a crank, the grain being sustained by fingers. The blade is serrated like a sickle, except that the angle of the teeth is reversed for every alternate tooth. . . . The fingers for supporting the grain are spear-formed."—*Held* (*Bramwell, B., dissente*), that in an action for an infringement of the subsequent patent, the defendant was, by reason of this prior publication, entitled to the verdict on the plea that the manufacture was not new.—*Held*, by *Bramwell, B.*, that in the absence of proof that the machine in its entirety was not new, the plaintiff was entitled to the verdict on that issue, notwithstanding the want of novelty in its separate parts. (7 *H. & N.* 25; 31 *L. J., Ex.* 42; 9 *W. R.* 809; 4 *L. T. Rep., N. S.*, 832.)

(d) *PLIMPTON v. SPILLER.* C. A. [1877]

The patentee claimed, first, a mode of applying rollers and runners to the footstand of skates, so that they might be cramped,

or turned so as to cause the skate to run in a curved line by the canting or tilting of the footstand; and, secondly, the mode of securing the runners and making them reversible, as above described.—*Held*, that, assuming that there was nothing novel in the mode of securing the runners to the footstand, yet the want of novelty in the second claim did not invalidate the patent, because the second claim must be read as claiming a subsidiary invention to be used only in connection with the principal invention. (*L. R.*, 6 *Ch. D.* 412.)

Brett, L. J., in delivering judgment, said: "I think it cannot be denied that if a really independent claim of something which is not new, however inadvertently or carelessly it be made, is in fact made on the face of the patent, the Court is bound to hold that the patent is therefore objectionable, and that therefore the plaintiff cannot succeed. If this second claim had been in a form which would have applied to the runner of any other skate than that which is patented here, I should have thought it would have been bad, and that therefore the whole patent would have been bad, and that this plaintiff could never recover. . . . If you can say that the subsidiary claim in a patent cannot, under any circumstances, increase the monopoly of the patent itself which is well claimed in the patent, it seems to me that the subsidiary claim is unimportant, is futile, has no effect, and, therefore, does not raise any objection to the patent. If you can bring it within the category of a subsidiary claim in the patent, you bring it within the principle stated by Lord Westbury (*Neilson v. Betts*, *L. R.*, 5 *H. L.* 21), and, under these circumstances, it is no objection to the patent. I therefore consider that this second claim is no objection to this patent, because it is a futile claim, and has no effect upon the monopoly." (*Ib.* 433.)

(e) *FREARSON v. LOE.* *M. R.* [1878]

Jessel, M. R.: "It does not follow that, because an inventor thinks he has invented more than he has in fact, and describes the advantages of his invention, and some of those advantages arise from an old portion of the invention, it may not still be a good patent, provided that the invention as claimed is so limited as to fail to cover the actual thing in use, while it covers some of the advantages mentioned; in such a case it may still be a good patent." (*L. R.*, 9 *Ch. D.* 58.)

#### *Public Use.*

(f) *LEWIS v. MARLING.* [1829]

Action for the infringement of a patent for certain improvements on shearing machines. It was proved by the defendant, that the specification of a similar machine had previously been enrolled in America, that a model of an exactly similar machine had been exhibited to three or four persons in England, and that a manufacturer in England had commenced the construction of a machine from the American specification. This, however,

was never completed, and it was proved by the plaintiffs that the same manufacturer had purchased the plaintiffs' machines. Tenterden, C.J., in summing up to the jury at *Nisi Prius*, said: "It is no doubt incumbent on the plaintiffs to show that their machine is new, but it is not necessary that they should have invented it from their own heads; it is sufficient that it should be new as to the general use and public exercise in this kingdom. If it were shown that the plaintiffs had borrowed from some one else, then, of course, their patent would fail. To show that the machine was not new, evidence is given that a model has been seen by three or four persons, and that the making of a similar machine was begun; but it appears to me, that the defendant has failed to prove that such a machine was generally known or generally used in England before the taking out of this patent by the plaintiffs." (4 *C. & P.* 55; 10 *B. & C.* 26; 5 *M. & R.* 69; 1 *Web. P. C.* 492; 1 *Carp. P. C.* 477.)

(g) *MINTER v. MOWER.* N. P. [1835]

Action for the infringement of a patent which claimed "the application of a self-adjusting leverage to the back or seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair, as above described." It was proved in evidence that a chair had been made by a person of the name of Brown before the date of the patent, which would have acted by a self-adjusting leverage if it had not been encumbered by bad machinery. Lord Denman, C.J., said: "I cannot conceive it would be very strong, even if he (Brown) had said he had discovered this principle of self-adjusting leverage, when it does not appear he claimed it, took out any patent for it, or that his master did, or that there was any production of the article that could be beneficial to himself or Mr. Mower. It seems that is a very strong argument to show that in point of fact they had not made the discovery, at least how to make this principle available for general use." (1 *Web. P. C.* 139.) "If that principle (self-adjustment) might have been deduced from the machinery of the chair that was made, but that it was so encumbered and connected with other machinery that nobody did make that discovery or even found out that they could have a chair with a self-adjusting leverage, by reason of that or any other defect in the chair actually made; I confess it seems to me that does not prevent this from being a new invention, when the plaintiff says, I have discovered, throwing aside everything but this self-adjusting leverage itself, that will produce an effect, which I think a very beneficial one." (*Ib.* 140.)

(h) *CORNISH v. KEENE.* N. P. [1835]

Tindal, C.J., said: "The main question is, whether the principal subject of the patent was or was not in use in England at the time of granting these letters patent. Was it or was it not, in the language of the Act of Parliament, such a manufacture (which has a very wide and extended meaning—you may call it almost

invention), was it or was it not such an invention, at the time of making the letters patent, as was current in use? If (the invention) was at the time these letters patent were granted in any degree of general use; if it was known at all to the world publicly and practised openly, so that any other person might have the means of acquiring the knowledge of it, as well as this person who obtained the patent, then the letters patent are void; on the other hand, if it were not known and used at the time in England, then, as far as this question is concerned, the letters patent will stand. . . . A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments and never communicates them to the world, and lays them by as forgotten things, another person, who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent, and protect himself in the privilege of the sole making of the article for fourteen years; and it will be no answer to him to say that another person before him made the same experiments, and, therefore, that he was not the first discoverer of it. . . . That would be an extreme case on one side. . . . On the other hand, the use of an article may be so general as to be almost universal. In a case like that, you can hardly suppose that any one would incur the expense and trouble of taking out a patent. . . . It must be between those two limits that cases will range themselves in evidence, and it must be for a jury to say, whether, . . . in any particular case, evidence which has been brought before them convinces them to their understandings that the subject of the patent was in public use and operation at that time—at the time when the patent itself was granted by the Crown. If it was in public use and operation, then the patent is a void patent, and amounts to a monopoly, if it was not, the patent stands good.” (1 *Web. P. C.* 508.)

(i) *MORGAN v. SEAWARD.* [1837]

Patent for “certain improvements in steam-engines, and in machinery for propelling vessels.” It was proved that, before the date of the patent, Galloway, the patentee, ordered an engineer, under an injunction of secrecy, to make two pairs of paddle-wheels upon the principle of the patent. The wheels when completed were packed at the engineer’s factory, and sold to, and exported by, the plaintiff, who was the assignee of the patent, and the managing director of a foreign company, by whom the paddle-wheels were used *abroad*. The plaintiff paid the engineer for the wheels. The question before the court was, whether the invention, at the date of the patent, was new in the legal sense of that word. Parke, B., delivering the judgment of the court, said:—“The words of the statute are, that grants are to be good ‘of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others, at the time of the making of such letters patent and grants, did not use.’ . . . The



word 'manufacture' in the statute must be construed in one of two ways; it may mean the machine when completed, or the mode of constructing the machine. If it mean the former, undoubtedly there has been no use of the machine, as a machine, in England, either by the patentee himself or any other person; nor indeed any use of the machine in a foreign country before the date of the patent. If the word 'manufacture' be construed to be the mode of constructing the machine, there has been no use or exercise of it in England in any sense which can be called public." (2 *M. & W.* 544; 1 *Web. P. C.* 187; *M. & H.* 55; 1 *Jur.* 527.)

(j) *CARPENTER v. SMITH.* [1842]

Action for the infringement of a patent for certain improvements in locks. It was proved that a lock, substantially the same as the plaintiff's, had been put upon a gate in a public place, and used by Mr. Davies for many years before the date of the patent. At Nisi Prius, Abinger, C.B., said: "I think what is meant by 'public use and exercise,' as has been held by my predecessors before (and I think one's own common sense leads one to adopt that definition), is this: a man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any other man having invented that before, and not made any use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious, who may afterwards make the same inventions, and apply them." (1 *Web. P. C.* 534.) The defendant subsequently moved for a new trial, on the ground of misdirection. The court, however, refused even a rule *nisi*, and held, that "the public use and exercise of an invention, means a use and exercise in public, not by the public." To invalidate a patent a prior user need not continue up to the time of taking out the patent. (9 *M. & W.* 300; 1 *Web. P. C.* 540.)

(k) *WALTON v. BATEMAN.* N. P. [1842]

Cresswell, J., said to the jury: "With respect to this not being a new invention, the nature of that objection is distinct and clear upon the face of it. It involves two questions for your consideration. First, was any article made before, answering the purposes and having the properties of that, which the plaintiff has made and claims as the patent? (1 *Web. P. C.* 616.) . . . Then even supposing that that article did embody the principle of the plaintiff's, so as to present to persons using it the properties, qualities, and advantages in principle of that article which the plaintiff makes, the question for you will be, whether that user is not to be considered rather in the nature of an experiment than of any public use of the article, so as to deprive the plaintiff of the fruit of this discovery in respect of this manufacture." (*Ib.* 619.)

(l) *THE HOUSEHILL COMPANY v. NELSON.* H. L. [1843]

Lord Lyndhurst, L.C., said: "If it is proved distinctly that a

machine of the same kind was in existence, and was in public use, that is, if use or if trials had been made of it in the eye and in the presence of the public, it is not necessary that it should come down to the time when the patent was granted. (1 *Web. P. C.* 709.) . . . . If it is discontinued, provided it has been once in public use, and the recollection of it has not been altogether lost, it will be sufficient to invalidate the letters patent, although the use may be discontinued at the time when the letters patent were granted. (*Ib.* 710.) . . . . It must not be understood that your lordships, in the judgment you are about to pronounce, have given any decision upon this state of facts, namely, if an invention had been formerly used and abandoned many years ago, and the whole thing had been lost sight of. That is a state of facts not now before us. Therefore, it must not be understood that we have pronounced any opinion whatever upon that state of things." (*Ib.* 717.)

(*m*) *STEAD v. WILLIAMS.* N. P. [1843]

Action for the infringement of a patent "for making or paving public streets and highways, and public and private roads, courts and bridges with timber or wooden blocks." The defendants proved that the porch of a private dwelling-house had been paved, prior to the date of the patent, in a manner similar to that described in the plaintiff's specification. Cresswell, J., told the jury that, if they thought this paving was essentially the same as that described in the plaintiff's specification, the patent would be, in point of law, invalid. "It was intended to be public, not to be made a matter of merchandise certainly, but merely for his own private use; but the knowledge of it exposed to the public an article in public use, and continued to be used down to the time in question. Therefore, if you think that is the same thing in substance as that which the plaintiff claims, I think that it was publicly used before, and that he cannot have his patent. Whether it had been used by one or used by five, I do not think it makes any difference." (2 *Web. P. C.* 136.)

(*m* \*) *STEAD v. ANDERSON.* N. P. [1846]

In this case, the facts, as regards user, were the same as in the case of *Stead v. Williams*. (See last case). Parke, B., in directing the jury, said: "As to the alleged user, the only question is, that a similar pavement had previously been laid down at Sir W. Worsley's. . . . If the mode of forming and laying the blocks at Sir W. Worsley's had been precisely similar to the plaintiff's, that would have been a sufficient user to destroy the plaintiff's patent, though put in practice in a spot to which the public had not free access." (2 *Web. P. C.* 149.)

(*n*) *HANCOCK v. SOMERVELL.* N. P. [1851]

In directing the jury upon the issue of novelty, Williams, J., said: "The defendants say that the invention had been substantially published and was in use, not in secret use, but in public use in England before the date of the patent; and, if that is so, it

would entitle the defendants no doubt to a verdict upon these novelty issues. Upon that part of the case the view that it seems to me ought to be taken by you is this: you will first consider whether the material was before the public,—it is not necessary it should be used by the public—if it is in public use, not in secret use. . . . If you should be of opinion the material was so before the public, in public use, before the date of the patent, then the question would be this: it is said on behalf of the plaintiff—first of all denying that there is any evidence of the material having been at all in public use before the date of the patent, that even if it were, so that although the material was before the public, yet the invention was not—that the invention required to be discovered. On the other hand, on the part of the defendant, what is said is this: that the material being in public use, the ready means of the invention were also necessarily before the public; because it is said that the article presented in itself such means of knowledge to the public as to enable any one of ordinary competence to re-produce the article. And if you should come to the conclusion upon the facts that the material was in use before the date of the patent, then the question resolves itself into this: What is your opinion as to whether the publication of the material was substantially a publication of the invention?" (*Newton's London Journal*, vol. 39, p. 158.)

(o) *HEATH v. SMITH.* [1854.]

Action for the infringement of a patent for certain improvements in the manufacture of iron and steel. The defendant pleaded (*inter alia*) that the invention was not new, but had been publicly and generally used in England before the date of the patent. It was proved at the trial that, before the date of the patent, five persons had used the process independently, three of them without concealment, and that all five had publicly and generally sold, for their own profit, the article thereby produced. Held, that, upon this evidence, the plea was proved. Lord Campbell, C. J., in the course of his judgment, said: "It is said that, according to judicial determinations, the user must be public. If we are to make this addition to the statute (21 *Jac.* 1, c. 3, s. 6), has there not been a public user within the meaning of the words? Can a patent be granted for a manufacture which other people have used, not indeed in the market-place, but without any concealment whatever? If this user without concealment does not constitute a public use, what does?" Erle, J., said: "If one party only had used the process, and had brought out the article for profit, and kept the method entirely secret, I am not prepared to say that then the patent would have been valid." (3 *Ell. & Bl.* 256; 2 *Web. P. C.* 268; 2 *C. L. R.* 1584; 18 *Jur.* 601; 23 *L. J., Q. B.* 166.)

(p) *In re ADAMSON'S PATENT.* Ch. [1856]

Adamson, whilst engaged in carrying into effect a contract for the erection of a pier, invented certain machinery, which he used on the works for several months before applying for a patent,

during which time it was open to the inspection of the public. *Held*, that the invention had been dedicated to the public, and that he was not entitled to the patent. Lord Chancellor Cranworth, in his judgment, said: "In this case the petitioner, by his own showing, had publicly used the invention for four months, not for the purpose of testing it by experiments, but in carrying out a contract in which he was engaged, before he took any steps to obtain a patent for it. . . . If the stage (the subject of the patent) had been raised simply for the purpose of testing the invention, though the inventor had been obliged to let it be seen by the public, the publicity so given to it would have formed no objection to the granting of the patent." (6 *De G. M. & G.* 420; 25 *L. J., Ch.* 456.)

(q) *BETTS v. MENZIES.* [1859]

Action for the infringement of a patent for making capsules. It was proved that between the time of the application for, and the issuing of the letters patent, the plaintiff manufactured a quantity of the capsules in the making of which he had discovered improvements. They were made by his own workmen, and were not sold before the patent was granted. The defendant having obtained a rule to set aside the verdict, it was held, that the manufacture of capsules by the plaintiff, prior to the grant, did not invalidate the patent. (1 *Ell. & Ell.* 990; 28 *L. J., Q. B.* 361; 5 *Jur., N. S.* 1164.) Lord Campbell, C.J., delivering judgment upon the point, said: "Under these circumstances, I am of opinion that the manufacturing of the capsules according to the new invention would not invalidate the patent. I quite agree that if you look at the section of the Statute of Monopolies which has been referred to (sect. 6) . . . the reservation which must be relied upon here is this, 'which *others* at the time shall not use.' Now, *others* had not used this before the patent was granted. It was used only by the inventor, the patentee himself, and the use of it by the servants and mechanics whom he employed must be considered to have been his use, and therefore it was not used by *others*. But still, if it could be shown that the effect was really to extend the time of the monopoly, that would be fatal. But the defendant has entirely failed in showing that, because any person might have used this manufacture lawfully, until the patent was sealed, and the fourteen years had begun to run, there was a period of more than fourteen years, during which the monopoly existed. That period was not in the slightest degree exceeded, and no inconvenience or grievance is caused to any one individual nor to the country, by saying that this manufacture of the capsules according to the new process before the patent was sealed, shall not invalidate the patent." (1 *Ell. & Ell.* 1008; 28 *L. J., Q. B.* 365; 5 *Jur., N. S.* 1065.)

(r) *HARWOOD v. THE GREAT NORTHERN RAILWAY COMPANY.* H. L.  
[1860-1865]

The plaintiffs were the executors of Wild, to whom a patent

had been granted for "improvements in fishes and fish joints for connecting the rails of railways." The fishes were made of iron, with a groove on the outer surface, for the purpose of preventing the square heads of the bolts, passing through them and the rail, from turning round, and also for the purpose of procuring greater strength with an equal weight of metal than could have been obtained from a fish of the same thickness throughout. Before these letters patent had been granted, grooved iron plates, with bolts let into the groove, had been used for the purpose of fastening timbers placed vertically upon one another, or placed horizontally side by side. In one case of a bridge, a channelled plate with bolts had been used for the purpose of fishing a scarf joint where the ends of two timbers met together, but it had not been used with the view either of fixing the heads of the bolts, or with the view of obtaining greater strength with an equal weight of metal. The Court of Queen's Bench held, that this was not a prior use which would invalidate the patent. (29 *L. J., Q. B.* 193; 6 *Jur., N. S.* 993.) Cockburn, C.J., thus expressed himself upon this point: "Now the question is, whether the accidental use of a particular piece of machinery, forming part of, or the whole of, the mechanical contrivance, which may be applied afterwards to some ulterior purpose, without any intention of producing the result, is such an anticipation—such a user—of the invention, as shall prevent a patent. I entirely concur with my brother Blackburn—that it turns upon what is the meaning of the language to be found in the Statute of Monopolies; that a man shall not have a patent for that which others do use at the time he takes out his patent. What is the meaning of that? Surely it must be construed to mean, what others have invented and used for the purpose for which the man who afterwards comes forward as the inventor, and claims to have a patent, and obtains a patent, intends to use it." (29 *L. J., Q. B.* 199.) Blackburn, J., in the course of his judgment, said: "The word 'manufacture' has been frequently considered, and it extends not only to principles that may be supposed to be patented, but to the modes of applying those principles, in practical use, in the result. . . . But when you look at the 'use,' it must be that kind of use which a man has when he uses a manufacture. I cannot think that a man can use a manufacture in the sense in which the words must be understood in this Act, and as they would be understood by any man using them, because accidentally, and without in the least degree intending it, he does that thing which, if it were habitually done on purpose, and for the purpose of trade, would be a manufacture. I cannot think there is a use, either public or private, in that sense, unless there be some knowledge and some intention. . . . I would not be understood to say, that I think it is at all essential for the public use of a manufacture that a man who really uses it intending to use it, should, at the time, have full knowledge of all the advantages that will arise from the user. I can easily imagine many cases in which he might use the thing as a manufacture, although there were many

incidental advantages which he was not aware of, and that user might prevent another person from taking out another patent for those incidental advantages afterwards." (29 *L. J.*, *Q. B.* 202.) On appeal to the *Exchequer Chamber* it was held, that the patent was bad, as, even without reference to the case of the bridge, the use of grooves in pieces of iron for holding materials together by means of bolts and nuts, had been given to the world, together with all its advantages, before the date of the patent in question. Willes, J., who delivered the judgment of the court, said: "We by no means say that prior use of an invention is to be of no avail because the principle upon which it acts was either unknown or misapprehended." (31 *L. J.*, *Q. B.* 198; 8 *Jur.*, *N. S.* 1126.) This judgment was affirmed in the House of Lords, upon the general question of prior use, without reference to the special point raised by the judgments of the judges in the Court of Queen's Bench. (11 *H. L. Cas.* 654; 35 *L. J.*, *Q. B.* 27; 12 *L. T. Rep.*, *N. S.* 771.)

(s) *BETTS v. NEILSON* : *BETTS v. DE VITRE*. Ch. [1868]

In order to establish the prior public use of a patented article, so as to invalidate the patent, it is not necessary to show that the article had been manufactured for sale. (*L. Rep.*, 3 *Ch.* 429; 37 *L. J.*, *Eq.* 321; 18 *L. T. Rep.*, *N. S.* 165.)

(t) *BARLOW v. BAYLIS*. [1870]

In an action for infringement of a patent for a machine for manufacturing nuts by a single operation, it was shown that a machine had been patented in 1852 for the same purpose by one Berry. The jury being asked whether Berry's ever was a machine or invention in this sense that a workman could from his specification and drawings make the machine described so that it would more or less badly do the work required of it, found that it would not. *Held*, that judgment was rightly entered for the plaintiff on the question of anticipation. (*Griff.* 44.)

(u) *BRERETON v. RICHARDSON*. [1884]

An improved method of driving a tricycle by means of pedals and cranks, which was the invention claimed, had been used by one, Jackson, on a tricycle, which was so well known in the neighbourhood of Malden as to be called Jackson's patent threshing-machine:—*Held*, to be a public user. Field, J.: "I quite understand that, if there were at this moment an axle running under an omnibus, which I could not see, it might or might not be a public user. I think it would be a public user." (*Griff.* 54; 1 *O. R.* 166 at p. 174.)

(v) *CROYSDALE v. FISHER*. [1884]

Whether a patent is anticipated by a specification, or by publication in a book, or by previous user, the principle is the same; because in each case it must be shown that some person has communicated to the public that which the patentee claims. But there

is a vast difference in the application of the principle; for, in cases of user, it does not profess that there is a publication to the world. The more, perhaps, as different modes of refinement and variations and improvements continue to multiply, the more does it happen that one portion of the manufacturing world does not know what is being done by another portion. Still more, does the public not know, with great nicety, what is going on in the laboratories or manufactories attached to any particular trade. In order to form a disclosure by user, then it is not necessary that the user should be by the public proper, provided only, that it is a user in public, as contra-distinguished from a mere experimental user, with a view of patenting a thing which may or may not be existing. (*Griff.* 73; 1 *O. R.* 17.)

(w) *ROWCLIFFE v. MORRIS.* [1885]

A patent, granted for improvements in frames for spring mattresses:—*Held*, to have been anticipated by prior use of different bedsteads. (3 *O. R.* 17.)

(x) *GUILBERT MARTIN v. KERR.* [1886]

Patent for a gauge glass, backed with a stripe of red enamel on a white enamel ground:—*Held*, to have been anticipated by the public use of similar gauge glasses, made under a patent for a gauge glass with a white or coloured enamel back. (4 *O. R.* 18; 3 *T. L. R.* 87.)

(y) *HUMPHERSON v. SYER.* C. A. [1887]

In an action for infringement of a patent for an improved waste water preventer, the defendant was the owner of a similar invention, for which he obtained provisional protection about six weeks before the date of the plaintiff's patent, and which he used publicly before the same date:—*Held*, that the plaintiff's patent was invalid, on the ground that the combination was the same as that which the defendant had publicly used, with a modification which was not the subject of a patent. Fry, L.J.: "Is it the fair conclusion from the evidence that some English people, under no obligation of secrecy arising from confidence or good faith towards the patentee, knew of the invention at the date when the plaintiff took out his patent. That appears to me to be the question." (4 *O. R.* 184, 407, at p. 414.)

(z) *MORGAN v. WINDOVER.* C. A. [1888]

If there is a complete anticipation by prior user the abandonment of it is nothing. (5 *O. R.* 296; 3 *T. L. R.* 748.)

(a) *PODMORE v. WRIGHT.* [1888]

Prior user by the defendants proved, of a machine for manufacturing the top notches of umbrellas patented by the plaintiff. (5 *O. R.* 380.)

(b) *BADHAM v. BIRD.* [1888]

The plaintiff's patent was for combined manhole covers and ventilators for sewers:—*Held*, to have been anticipated by prior user of articles similar in all essential points. (5 *O. R.* 238.)

(b) CHEETHAM *v.* OLDHAM AND FOGG. [1890]

The plaintiff's patent was for improvements in the manufacture of felt hats:—*Held*, to have been anticipated by hats made by a similar process and sold in the ordinary course of trade. (7 *O. R.* 116.)

*Secret Use.*

## (c) TENNANT'S CASE. [1802]

Action for the infringement of a patent for a method of making a bleaching liquor. The general ignorance of bleachers with respect to such bleaching liquor, until after the date of the plaintiff's patent, was proved. On the part of the defendant it was established, that a bleacher had used the same means of preparing his bleaching liquor for five or six years anterior to the date of the plaintiff's patent, but that he had kept his method a secret from all but his two partners, and two servants employed in preparing it; and a chemist at Glasgow deposed, that he had suggested to the plaintiff a material part of the method which formed the subject of the patent. Ellenborough, C.J., nonsuited the plaintiff on two grounds—first, that the process had been used five or six years prior to the date of the patent; and secondly, that the plaintiff was not the inventor of an indispensable part of the process. (Cit. *Dav. P. C.* 429; 1 *Web. P. C.* 125; 1 *Carp. P. C.* 177.)

(d) BENTLEY *v.* FLEMING. N. P. [1844]

If the inventor of a machine lend it to another in order to have its qualities tested, and that other use it for some weeks in a public workroom, this is not giving the invention such publicity as to deprive the inventor of his right to obtain letters patent for it. (1 *C. & K.* 587.)

(e) SMITH *v.* DAVIDSON. [1857]

Action for infringement. The jury found that the improvements used by the defenders, the same as those independently invented and patented by the pursuer, were invented by the defender Davidson before November 14th, 1853, the date of the pursuer's provisional specification. That Davidson did not use his invention for the purposes of his trade before November 14th, 1853; but that the machine invented by him was capable of being so used before that date. That Davidson used his invention for the purposes of his trade between November 14th, 1853, and February 1st, 1854.

*Held*, that neither the secret user before November 14th, nor the public user after, invalidated the pursuer's patent. The Lord President said: "In order to invalidate letters patent on the ground of previous use, it is necessary not only that the use shall have been prior to the date of the letters patent, but that it should be a public and not a secret use. Accordingly, in this case, the issue puts the question, 'Whether improvements substantially the same



as those mentioned in the letters patent and specification, were known and used within the United Kingdom prior to the date of the said letters patent? Now, 'known and used' means known to the public, and openly used. The jury have by their verdict fixed the nature and extent of the use. They find that, prior to 14th November, 1853, the machine invented by Davidson was capable of being used for the purposes of his trade, but was not so used until after that date, and they have not found that it was used for any other purpose before that date, nor does it appear that it had been published or made known before that time. Indeed it appears from the evidence that Davidson at that time contemplated applying for a patent, and, consistently with that, he could not do otherwise than avoid publication of his invention. His experiments were over, and the invention was complete and ready for publication and to be put in use, but it was not so published or used. In these circumstances, it cannot be held that, prior to the 14th of November, the improvements patented by the pursuer were 'known and used' in the sense of the issue, or in any sense which could be held as invalidating the letters patent." (19 *C. S.* 691.)

(f) *HILLS v. LONDON GASLIGHT COMPANY.* N. P. [1860]

Bramwell, B., at the trial at Nisi Prius, said to the jury: "If a person has invented anything which is the subject of a patent and has kept it to himself, or communicated it privately to one or two, in fact, has not made it public knowledge, if anyone else discovers that invention, it is new, that is to say, new in the sense that the first invention has not been published." And again: "If a man practises his invention privately, or by way of experiment only, such a practising would not be a publication of the invention, so as to prevent a person subsequently finding it out from being the inventor of new matter, the subject of a patent." (5 *H. & N.* 336.)

(g) *POUPARD v. FARDELL.* Ch. [1869]

A patent for improvements will not be bad on the ground of prior user, though the use of an article of the same kind be proved, with appendages exactly answering the words of the specification, if the appendages to the article previously used had a different object to that of the patented improvements, and did not produce the same effects. (18 *W. R.* 127.)

(h) *SAXBY v. GLOUCESTER WAGON COMPANY.* H. L. [1883]

The anticipation alleged consisted in drawings of a signalling apparatus made by the London and North Western Railway Company, and a working model made for use at a siding. All the company's servants were sworn to secrecy, and the drawings were seen only by them:—*Held*, that as the user was not for the purpose of experiment the secrecy made no difference, and that there had been publication. (2 *Griff.* 54.)

*Publication in a Book or Specification.*

(h) *R. v. ARKWRIGHT. Scire facias.* [1785]

Buller, J., said : "It is admitted that (this) is not a new discovery, for Emerson's book was produced, which was printed a third time in 1773, and that is precisely the same as this." (1 *Web. P. C.* 72.)

(i) *HILL v. THOMPSON.* [1818]

*Held*, that a book printed and published, prior to the grant of the patent, which in substance informed the public of what the specification of the patent professed to inform them, completely negatived the novelty of the alleged invention. (2 *B. Mo.* 424; 8 *Taunt.* 375; 1 *Web. P. C.* 239.)

(j) *CORNISH v. KEENE.* [1837]

The defendants put in evidence the specification of a prior patent obtained by the plaintiff, which, the defendants alleged, described the invention for which the patent in question was granted. Tindal, C.J., in addressing the jury, said : "Undoubtedly, if you could show under the hand of the plaintiff, or anybody's hand, that the secret had been publicly communicated to the world which was intended to be covered by the subsequent patent, there is an end of that patent; if the world at large had been informed by the specification of the colour, fabric and manufacture, which is intended to be effected by the subsequent patent, the subsequent patent must fall to the ground, otherwise a man would have nothing to do but to take out patent after patent when the former has nearly expired, and so afterwards procure to himself an unlimited privilege." (1 *Web. P. C.* 510.) On a motion for a new trial in the Court of Common Pleas, it was *Held*, that a patent will not be set aside for want of novelty by proof that *after* the date of the patent, although *before* the date of the *specification*, the invention was described or mentioned in the specification of some prior patent. (3 *Bing. N. C.* 570; 4 *Scott*, 337; 2 *Hodg.* 281; 1 *Web. P. C.* 513; 2 *Carp. P. C.* 371.)

(k) *HEURTELOUP'S PATENT.* [1836]

It would seem that the deposit of a foreign work in the British Museum, which work contained the specification of a French patent for an invention, in great part the same as that for which a patent had subsequently been obtained in England, was sufficient to vitiate the latter patent on the ground of want of novelty. (1 *Web. P. C.* 553.) (*Vide inf.* pp. 258 (q) and 259 (u).)

(l) *MORGAN v. SEAWARD.* [1837]

Alderson, B., referring to the case of *Dollond's* patent, cited in *Boulton v. Bull*, said : "If Dr. Hall had published his discoveries in a book, I apprehend that would have put an end to *Dollond's* patent." (2 *M. & W.* 554; 1 *Web. P. C.* 190.)

## (m) THE HOUSEHILL COMPANY v. NEILSON. H. L. [1843]

Lord Lyndhurst said: "If the machine is published in a book, distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice on trials for patents to read out of printed works, without reference to what has been done."

Lord Brougham: "It negatives being the true and first inventor, which is as good as negating the non-user. The book that is generally referred to is, the 'Repertory of Arts and Sciences.' It must not be a foreign book, but published in England." (1 *Web. P. C.* 718 n.)

## (n) JONES v. BERGER. [1843]

Maule, J.: "I think it is an objection to the patent, and not evidence simply of an objection, that there has been a previous patent and a specification enrolled, and therefore published being enrolled, containing the invention." (1 *Web. P. C.* 550; 6 *Scott, N. R.* 219.)

## (o) MUNTZ v. FOSTER. Ch. [1843]

The novelty of a patent is not impeached by a similar process, described in a previous specification, which will not, when carried out, produce the patented article. (2 *Web. P. C.* 94.)

## (p) MUNTZ v. FOSTER. N. P. [1844]

If a patentee has had his mind furnished with the material of his invention by a prior specification, and has merely put it into a *more detailed shape*, it would neither be a new invention, nor would he be the first and true inventor. (2 *Web. P. C.* 107.)

## (q) STEAD v. WILLIAMS. [1844]

Action for the infringement of a patent granted to the plaintiff for "making or paving public streets and highways, and public and private roads, courts and bridges, with timber or wooden blocks." Cresswell, J., directed the jury to consider: first, whether the publications relied on by the defendant came to the knowledge of the plaintiff; secondly, if they did, whether they disclosed that for which he claims a patent; for although he may have read those, if they do not disclose that which is the essential part of his patent, then it does not invade at all his privilege of having a patent right. Verdict for the plaintiff. (2 *Web. P. C.* 130.) A rule was subsequently obtained, and made absolute, for a new trial, on the ground of misdirection. The defendant's counsel contended that the mere fact of a prior publication is conclusive against the validity of the patent, though the patentee might have no knowledge of the existence of such prior publication. The Court of Common Pleas held that, "If the invention has already been made public in England, by a description contained in a work, whether written or printed, which has been publicly circu-

lated, in such case the patentee is not the first and true inventor within the meaning of the statute, whether he has himself borrowed his invention from such publication or not; because we think the public cannot be precluded from the right of using such information as they were already possessed of at the time the patent was granted. It is obvious that the application of this principle must depend upon the particular circumstances which are brought to bear on each particular case. The existence of a single copy of a work, though printed, brought from a depository, where it has long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia, or other work in general circulation. The question will be, whether upon the whole evidence there has been such a publication as to make the description a part of the public stock of information." (8 *Scott*, N. R. 472; 7 *M. & Gr.* 842; 2 *Web. P. C.* 142; 8 *Jur.* 933; 13 *L. J., C. P.* 220.)

(r) *STEAD v. ANDERSON.* [1847]

The first person who discloses an invention to the public is considered as the inventor. A knowledge and publication after the plaintiff's invention does not avoid a patent granted to the true and first inventor, who, having invented, obtained his patent before his invention was used. (16 *L. J., C. P.* 250; 2 *Web. P. C.* 151.) A prior invention, in order to avoid a patent, must have become known in the sense that it has become known to the people in the trade. (2 *Web. P. C.* 148.)

(s) *DOBBS v. PENN.* [1849]

A patent granted to A. for "improvements in the construction of racks and pulleys for window-blinds and other useful purposes," besides claiming a mode of making the frames, by constructing them in a particular manner of drawn open metal tubes, claimed a mode of fixing the pulley in the frame, by turning the knob of the spindle, upon which the pulley revolved, and thereby of screwing a piece of metal, made to slide within the frame, tight to the edge of the frame; by which means the pulley spindle became firmly fixed to the frame. By a patent previously granted to B., the same object was effected by a similar method, but with the addition merely of a piece of thin metal, called an escutcheon, which worked outside the frame; but the specification stated, that the pulleys might be made without the escutcheon. *Held*, that the two patents were substantially the same as to one of the things claimed, and therefore that A.'s patent was void. (3 *Exch.* 427.)

(t) *IN RE LAMENAUDE'S PATENT.* [1850]

Lord Brougham: "You may have a patent as the importer of a foreign invention, because that is the construction that the courts have put upon the statute that you are the *quasi* inventor, if you import it for the first time. But has it ever been said that such importation of a foreign invention is negatived by a book in this country stating the foreign invention? I am not aware that it has

been held to negative the right of an importer of a foreign invention that a book had stated it before." (2 *Web. P. C.* 169.)

(u) *R. v. STEINER. Scire facias.* [1851]

Lord Campbell, C. J., told the jury that if the improvement for which the patent was granted was contained in the specification of a prior patent, or was described in a book, published abroad but sold in England, the patent would be void. (40 *Newton's London Journal*, 71.)

(v) *BETTS v. MENZIES.* Ch. [1857]

Sir W. P. Wood, V.-C., said: "I conceive that the law is, that where an ingenious person makes, for instance, an improvement in the glasses of a telescope, or the wheels of a carriage, for his own use, and which he uses accordingly, but without publishing it anywhere, or if, on the other hand, he publishes in a book his invention which he has so made and used for his own private accommodation, much more when he takes out a patent for it, there can be no case for a subsequent patentee. . . . I think that if a man sits down and takes out a patent from his own conjectures, without ever having tried the experiment set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method prescribed by the earlier patent is practically useless." (3 *Jur., N. S.* 358.)

(w) *BETTS v. MENZIES.* H. L. [1859-1862]

At the trial of an action for the infringement of a patent for "a new manufacture of capsules, and of a material to be employed therein, and for other purposes," the defendant contended that the process which the plaintiff claimed as his invention was not new, as it had been discovered by one Dobbs, and by him disclosed to the world by two specifications, one of the date of 1804, and the other of 1820. Campbell, C.J., in summing up to the jury, said: "I ask you whether you think that a person of ordinary skill, reading Dobbs's specifications, and having no other information upon the subject, could at once proceed to make Betts's metal, not making experiments and getting out bit by bit, but whether it is stated enough to enable him at once to sit down and make Betts's metal?" The Court of Queen's Bench held, that this was not the proper question to be left to the jury, for though a workman might not in that way be able to make Betts's metal, still Dobbs's specifications, or something done under them, might have disclosed some part of that which the plaintiff claimed. Rule absolute for a new trial. (8 *Ell. & B.* 923.) At the new trial a verdict was found for the plaintiff. The defendant having obtained a rule to set aside the verdict, it was held, that the plaintiff's patent was invalid, as it appeared, on a comparison of Betts's and Dobbs's specifications, that the former claimed that which had been already described by the latter. (1 *Ell. & Ell.* 990; 28 *L. J., Q. B.* 361; 5 *Jur., N. S.* 1164.)

On appeal to the Exchequer Chamber judgment affirmed; Williams and Willes, JJ., however, differed from the rest of the court, holding that the plaintiff's patent was good, and not invalidated by Dobbs's; since Dobbs's patent was practically incapable of being carried into effect. (1 *Ell. & Ell.* 1020; 30 *L. J., Q. B.* 81; 6 *Jur., N. S.* 1290.) On appeal to the House of Lords the patent was held good. Blackburn, J., in the course of his judgment, said: "It seems to me that, if Dobbs had made it part of the public knowledge how to produce a new material, as a practical result, and Betts had afterwards claimed to have a patent for, amongst other things, producing that result, he would have claimed what was not new, but if Dobbs had not made it part of the public knowledge how to produce a result, then Betts would not have claimed anything already known." Lord Chancellor Westbury, after stating the facts, said: "To defeat a new patent, it must be clear that the antecedent specification disclosed a practical mode of producing the result which was the object and effect of the subsequent discovery. A barren general description, therefore, though containing some suggestive information, or involving some speculative theory, could not be treated as avoiding, for want of novelty, a subsequent specification or invention, unless it was ascertained that the antecedent publication involved the same amount of useful information. As to the two specifications in this case, it was clear that the first was a mere general suggestion, the other a specific practical invention. The one might lead to the other; but the latter alone complied with the conditions under which protection was given by the patent law. Here there was nothing to show that Dobbs's patent was capable of a practical application; and on the principle contained in the answer of the judges, it was clear that the decision of the two courts below ought to be reversed." (10 *H. L. Cas.* 117; 31 *L. J., Q. B.* 233; 9 *Jur., N. S.* 29; 11 *W. R.* 1; 7 *L. T. Rep., N. S.* 110.)

(x) *HILLS v. LONDON GASLIGHT COMPANY.* [1860]

The plaintiff in 1849 obtained a patent for the employment of the hydrated oxides of iron in purifying coal gas from sulphuretted hydrogen.

In 1840 one Croll took out a patent, in the specification of which, after speaking of the use of black oxide of magnesia for the purpose of removing the sulphuretted hydrogen, he said: "The same effect may be produced by the application of the oxide of zinc, and the oxides of iron." The court construed this as a claim for the use of the hydrated and anhydrous oxides of iron. And, further, that as there are many oxides of iron, the hydrated and anhydrous, the natural and artificial, some of which will, and some will not answer the purpose, it is a matter of investigation and experiment to see which will. Upon this ground it was held that Croll had not anticipated the plaintiff. (5 *H. & N.* 312; 29 *L. J., Ex.* 409.)

(y) *OXLEY v. HOLDEN.* [1860]

A provisional specification was filed on the 17th of March, and

afterwards abandoned by the inventor, who delivered another specification for the same invention on the 10th of April, in respect of which a patent was granted to him on the 12th of October, but dated as of the 10th of April. It was contended, that the filing by the plaintiff of the provisional specification of the 17th of March, and his afterwards allowing it to expire, was such a dedication to the public as prevented his obtaining a valid patent for the same invention on the subsequent application of the 10th of April. This objection was overruled, and Erle, C.J., in delivering the judgment of the Court of Common Pleas, said: "We are of opinion that a provisional specification abandoned does not become public by abandonment. The statute 15 & 16 Vict. c. 83, s. 29, authorizes the publication, but until that event it is not public. Furthermore, although the first provisional specification may afford an objection either to receiving a second for the same invention, or to granting a patent for the invention after the first specification has expired, there is no principle of law, and no enactment making the patent void, if it is so granted; and, on the contrary, sect. 24 enacts, that the patent dated as of the day the provisional specification was delivered in shall be of the same force and validity as if it had been sealed on that day. This patent is dated as of the 10th of April; on that day the protection given under the specification of the 17th of March existed, and the patent is valid by the operation of this section." (30 *L. J.*, *C. P.* 68; 8 *Com. B. Rep.*, *N. S.*, 666; 8 *W. R.* 626; 2 *L. T. Rep.*, *N. S.*, 464.)

(z) *HILLS v. EVANS.* Ch. [1862]

In giving judgment in this case, Lord Westbury, L.C., said: "The antecedent statement must (in order to invalidate a subsequent patent) be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments, and gaining further information before the invention can be made useful. . . . The information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and gives a specific rule of practical application. The reason is manifest, because much further information, and therefore, much further discovery, are required before the real truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore, and the refined and pure metal which is extracted from it." (31 *L. J. Ch.*, 463; 8 *Jur.*, *N. S.*, 529; 6 *L. T. Rep.*, *N. S.*, 93.)

(a) *LANG v. GISBORNE*. Ch. [1862]

An invention was described in a book published in France, copies of which were sent to England, to a bookseller, for sale:—*Held*, that this was a publication of the invention. The Master of the Rolls said: “In my opinion there are two modes by which an invention may be made public. One is by such user as would alone make it a part of the stock of public information, and the other is by the simple fact of what in law is called ‘a publication.’ I am of opinion that the true result of the cases is this:—that the observations to be found in them as to the circumstances which make an invention become a part of the stock of public information, apply to those cases where somebody has used the invention, not for the purpose of experiment, but for the purpose of really making use of it as a complete invention. . . . A publication takes place when the inventor of any new discovery, either by himself or by his agents, makes a written description of it, and prints it in a book, and sends it to a bookseller’s to be published in this country. I am of opinion that it is not at all necessary to establish the fact that one volume of that book has been sold, for I think that as soon as an inventor informs the public of what his invention consists, and prints it in a book, which he sends to a publisher to sell, from the moment that the book is exposed for sale in the bookseller’s shop, there becomes, in point of law, a complete publication of the invention.” (31 *Beav.* 135; 31 *L. J.*, Ch. 770; 8 *Jur.*, N. S., 736; 10 *W. R.* 639; 6 *L. T. Rep.*, N. S., 772.)

(b) *YOUNG v. FERNIE*. Ch. [1864]

Inventions in mechanics are as totally different from inventions in economical chemistry, as the laws and operations of mechanical powers differ from the laws of chemical affinities, and the result of analysis in the comparatively infant science of chemistry, with its boundless field of undiscovered laws and substances. Where, therefore, prior to the date of an inventor’s patent, something necessary for the useful application of a chemical discovery, for manufacturing purposes, remained to be discovered, which the plaintiff’s invention supplied, *held*, that the manufacture, with the materials and process in the specification, was a “new manufacture not in use” at the date of the patent. (4 *Giff.* 577; 10 *Jur.*, N. S., 926; 12 *W. R.* 901; 10 *L. T. Rep.*, N. S., 861.)

(c) *BETTS v. NEILSON*. *BETTS v. DE VITRE*. Ch. [1868]

The specification of a patent may describe the process to be adopted so insufficiently as to invalidate the patent, and yet disclose enough to show that what is claimed by a subsequent patent is not new. A prior publication will not invalidate a patent, unless it has imparted information so as to enable anyone working upon it to reckon with confidence on the result. (*L. R.*, 3 Ch. 429; 37 *L. J.*, Ch. 321; 18 *L. T. Rep.*, N. S., 165.) [Considered in *Plimpton v. Malcolmson*, *inf.* p. 251 (f).]



(d) *BOVILL v. COWAN*. [1868]

The plaintiff's invention, which was for improvements in the working of millstones, consisted in an exhaust just adequate to suck away the accumulation of hot air round the stones, carrying away and utilising the stive, leaving the meal to descend through the spout clear, and free from clamminess, and leaving the air of the mill case of the same density as the external air. This was alleged to be anticipated by three French patents published previously by deposit in the British Museum. Cairns, L.C. (affirming Romilly, M.R.): "It is not suggested that any person, either in this country or elsewhere, was ever led by reading any of the specifications of these French patents to adopt a process the same as the plaintiff's, and all that (the defendant's witness) says of them is that the text and drawings contain description clear and sufficient for a millwright of ordinary skill to construct and carry into effect a fit and proper means for exhausting the stive without carrying away the meal and exhausting the dusty air, when the same has been blown through the grinding surfaces of the millstones, and also for passing the dust or stive through suitable porous fabrics. In one sense I have no doubt this is the case. I think it very probable that a skilled workman, if informed of the injurious effect of an unremoved plenum round the millstones, and desired to remove that plenum by an exhaust which would remove it, and do nothing more, might use or adjust the machinery described in these French patents in a way that would effect that end; but the real question is, do these French patents profess to set forth as their discovery the removal of the plenum in this sense, and do they describe a process designed and fitted on the face of it to attain this end? I am clearly of opinion they do not." (2 *Griff.* 45, at p. 46.)

(e) *NEILSON v. BETTS*. H. L. [1871]

Per Lord Colonsay:—It is not enough that there has been, in a former patent, a general disclosure of the object to be attained, unless there is a specification clearly pointing out the mode of attaining it. (*L. R.*, 5 *H. L.* 2; 40 *L. J.*, *Ch.* 317; 19 *W. R.* 1121.)

(f) *PLIMPTON v. MALCOLMSON*. M. R. [1876]

Jessel, M. R., referring to the issue of novelty, said: "The cases cited may be rather used as illustrations of what will amount to sufficient evidence than as deciding anything in principle, beyond this, that it must be sufficiently known." (*L. R.*, 3 *Ch. D.* 557.) Referring to *Stead v. Anderson* (2 *Web. P. C.* 149), his lordship continued: "The case goes to this, that a book must be made public to such an extent as to be generally known among persons practising in such matters. It is, therefore, not merely publication, though, as a general rule, according to the *Househill Coal Company v. Neilson* (*Web. P. C.* 718, *n.*), when you say a book is published, and nobody contests it, you assume that several copies have been printed and circulated, unless somebody asserts the contrary. But, as regards the law, you must go a step further. Does that doctrine, therefore, apply to a case of this kind? There

is one copy of the book, which is all that has ever been printed and published, and that copy of the book was always kept in the back parlour of the bookseller's shop, and never was seen, so far as the evidence went. Would that satisfy the doctrine? Clearly not." (*Ib.* 558.) "If it were shown that no copy had ever got into the hands of the public, and the public knew no more about it than seeing the back of the book in the bookseller's window, and every copy could be accounted for, and that none had been sold though exposed for sale, that would not be a sufficient publication to avoid a subsequent patent." (*Ib.* 562.)

"What is required as regards prior description? I should have thought, independently of authority, that no prior description ought to invalidate a patent, unless you could make the thing from the description. I mean, unless a person of ordinary skill in the trade could make it from the description. But it has been alleged that something less will do. As I read the authorities, that is not so. The question has been before the House of Lords in the case of *Neilson v. Betts* (*L. R.*, 5 *H. L.* 1.) The judgment of Lord Westbury and Lord Colonsay comes to this—that the description in the book must be equivalent to a specification. I may say that this is entirely in accordance with the case of *Hill v. Evans* (4 *D. F. & J.* 300), and the case of *Betts v. Menzies* (10 *H. L. Cas.* 117); and, even if I differed from them, which I do not, I should be bound by those decisions. On the other hand, there is a decision of *Betts v. Neilson* (*L. R.*, 3 *Ch.* 431), which says that less will do; that the principle having been disclosed, although a workman could not make the machine (that is, the substance of it), that would be sufficient to avoid the patent. All I can say is, that I do not think that is fair to a patentee, and I should not have so decided had the matter been *res integra*; but it is not *res integra*, and I have no right to depart from what has been laid down by the House of Lords and the Court of Appeal in the three other cases." (*Ib.* 567.) His lordship also held, that such prior description, like a specification, must be intelligible to an "ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him." (*Ib.* 569.)

(g) *STONER v. TODD.* M. R. [1876]

Where a provisional specification contains an imperfect description of an invention, part of which was omitted in the final specification:—*Held*, that there was no prior publication of the part omitted so as to vitiate a subsequent patent for a similar invention on the ground of want of novelty. (*L. R.*, 4 *Ch. D.* 58.)

Jessel, M.R.: "When we find in the final specification that, in the description of one of the subordinate matters of the invention, one of the details has been abandoned, that is a notification to the public that the inventor could not work it, or thought it useless, and has consequently omitted it altogether. Therefore I do not consider that the insertion of a sketch in this provisional specification gives such information to the world as to amount to publication. At the same time I exclude from consideration those cases

in which the provisional specification contains as complete a description of the invention as the final specification, and I confine my remarks to those cases in which there is a mere sketch. I am not one of those who think that inventors are to be deprived of the fruits of their labours by previous sketches of inventions by others. There are very few inventions that have not been in some way anticipated or preceded by some notion or trial that has not been successfully prosecuted. This may be illustrated by the invention of the steam-engine, and by the discovery of the circulation of the blood. There is nothing that is entirely novel. Therefore the Court should be slow to listen to those who say that the same invention has been published before in a sketch like this which is more or less perfect." (*Ib.* 60.)

(h) PLIMPTON *v.* SPILLER. C. A. [1877]

On the 25th August, 1865, a patent for improvement in the construction of skates was granted to the agent of the inventor, who was a resident in America, and to whom the patent was afterwards assigned. Two years previously an American book, containing a brief description of the invention (but not sufficiently particular to enable persons to manufacture the skates), and five weeks previously an American book of illustrations, containing a drawing of the invention, were sent to the library of the Patent Office in London. This book of illustrations was not entered in the book of donations or in the catalogue, but it was placed on a bookshelf in a room open to the public, and was seen there by a librarian before the plaintiff's patent was taken out:—*Held* (affirming the decision of the Master of the Rolls), that there was no prior publication of the invention in this country. (*L. R.*, 6 *Ch. D.* 412.)

James, L.J., in delivering judgment, said: "As a matter of fact, it is impossible to say that this American book ever was in the library in any sense in which it could be construed to be accessible to the public, or that portion of the public which consists of persons conversant with this particular subject. . . . That being so, it is not necessary to go further, but I should, if it were necessary, desire much further time to consider whether, even if it were proved that the book, one copy of which had been sent over as a present from a gentleman in *America*, was on the shelf in the library between the 20th July and the 25th August, that would be a sufficient publication, and would be such an addition to the stock of common knowledge in this country as would have prevented a man from being the first and true inventor of this patent; such an addition to the stock of common knowledge as a man was not entitled (to use the language of one of the cases) to deprive the public of." (*Ib.* 429.)

Brett, L.J., in delivering judgment, said: "The real question to be decided by the Court with regard to this matter is whether the invention was before the patent in question known to the public in the sense that the Master of the Rolls has described, *i.e.*, not known to all the public, but known to a sufficient number, so

that you may properly say it was known in *England*. In order to prove or disprove that fundamental proposition, you may show by way of evidence that there has been a prior invention, and that it has become as a fact, although it has never been written, known to the people in the trade. That is what Baron Parke says, in *Stead v. Anderson* (2 *Web. P. C.* 148), that it has become generally known in the sense that it has become known to the people in the trade. That is only one form of evidence which may be given in proof of the fundamental proposition. Another mode of proving the fundamental proposition is to show that a description of the invention has been published. But then, to show that, it is not sufficient merely to show that it has been published in one sheet or book. As Baron Parke himself says: 'Published means offered or dedicated to the public.' He then goes on to say that the question with regard to that is, was the invention published or offered to the public to such an extent as that it was generally known among engineers or persons interested in the matter? The mere fact of its being dedicated, the mere fact of its being published, is not sufficient, it must be so far published as that you may fairly say it is known to a sufficient number of the public." (*Ib.* 434.)

(i) *PATTERSON v. THE GAS LIGHT AND COKE COMPANY.* H. L. [1877]

The plaintiff, one of the three gas referees appointed by the Board of Trade, under the City of London Gas Act, 1868, obtained a patent, while acting as such referee for "improvements in the purification of coal gas," and subsequently filed a bill against the defendants to restrain them from infringing the same. The application for the patent was dated the 9th of March, 1872, and the first publication of the invention was in an official report published by all the referees jointly, which bore date January 31, 1872, but was kept back from the official authorities, the Board of Trade, until the 26th of March following, and was generally circulated a few days after. The gas referees were required by the above Act of Parliament to prescribe and certify the maximum amount of impurity in each form with which gas supplied by a company shall be allowed to be charged; and the referees had, in accordance with their duty as prescribed by the Act of Parliament, included in their report instructions and suggestions for the guidance of gas companies. *Held* (affirming the Court of Appeal), that the whole of what was contained in the report was public property, before the report was sent in to the Board of Trade, and consequently, that from the time when the report was framed, *i.e.*, the 31st of January, 1872, at least, there was no consideration for the patent, as the subject of it had ceased to be a *new* manufacture before the date of the patent. (*L. R.*, 3 *App. Cas.* 239.)

Lord Blackburn: "The consideration for a patent is the communication to the public of a process that is new. In *Hindmarch* on Patents, it is laid down that 'if the public once become possessed of an invention, by any means whatever, no subsequent

patent for it can be granted, either to the true or first inventor himself, or any other person, for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he could give.' This is, in my opinion, a correct statement of the law.

"It is not necessary that the invention should be used by the public as well as known to the public. If the invention and the mode in which it can be used has been made known to the public by a description in a work which has been publicly circulated (*Stead v. Williams*, 7 M. & G. 818, 842), or in a specification duly enrolled (*Bush v. Fox*, 5 H. L. Cas. 707; *Betts v. Menzies*, 10 H. L. Cas. 117), it avoids the patent, though it is not shown that it ever was actually put in use. It is true that the later case establishes that 'an antecedent specification ought not to be held to be an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practical mode of producing the result which is the effect of the subsequent discovery.' (Per Lord Westbury, C., 10 H. L. Cas. 154.) But all difficulty on that score is, in this case, removed by the statement in the 37th paragraph of the bill of complaint already cited. If the date of the patent had been after the circulation of the report amongst the gas companies, instead of being, as it was, a few weeks earlier, the case would, it seems to me, have been quite unarguable. The date of the patent was, however, before the contents of the report were known to the gas companies, though several weeks after they were known to the whole of the referees and their secretary; and, as I have already pointed out, from the moment the referees became aware of what was in the report, it became the property of the public, and they were bound to make it known. The appellant, indeed, contends that he made it known to the referees only confidentially. I do not pause to inquire whether this was the fact or not, for I think it immaterial. I do not mean to throw any doubt on the doctrine in *Morgan v. Seaward* (2 M. & W. 544), that a disclosure to assistants or partners of an invention whilst it is being perfected, under an obligation to keep it secret till the patent is taken out, is not a disclosure to the public, for such persons could not make the invention known without a breach of duty. But, in the present case, the disclosure was to paid public officers, who could not keep it secret without a breach of duty. They were bound to make it known, and even if they, in breach of their duty, kept it back, the invention was not the less the property of the public from the time the referees knew it, which was at least as early as the date of the report." (*Ib.* 244.)

(j) BAILEY v. ROBERTON. H. L. [1878]

A patent for "improvements in preserving animal substances," in which the invention consists in preserving *fresh* meat by dipping it into a solution of bisulphite of lime, is anticipated by a prior patent for "improvements in preserving organic substances," in which the invention consists in preserving meat already par-

tially preserved, either by salting, drying or smoking, or the like, by dipping it into a like solution.

Lord Blackburn : " Could it be said, you have dipped a ham into bisulphite of lime, and so stopped the putrefaction ; but I say you shall not dip a leg of fresh pork into it. I think you cannot do better than take the old illustration. The old illustration was, you cannot take out a patent, saying : You have eaten soup with a spoon, I will take out a patent for eating pea soup with a spoon. You have taken out a patent for sweeping an old carpet with a new broom, I will take out a patent for sweeping a new carpet with an old broom. I quite agree there may be cases in which there is real invention and discovery, though an apparent application of an old principle ; the best case for illustration is one in which, I believe, the patent was granted, but the invention was not found practicable. About thirty years ago an ingenious man, seeing the plastic nature of the dough of flour, and knowing that the Neapolitans spin all kinds of macaroni out of it very ingeniously, came to the conclusion that if he could only manage to take red hot iron almost melting he, by an analogous process, could spin gas pipes, but the principle failed in practice ; as might be supposed, it was rather a difficult thing to do. Nobody would have doubted, if he had succeeded in it, that it would have been a very great invention. But there is no such invention here ; it is merely saying the exact mode in which R. has been preserving his semi-cured meat is to be prohibited to him when it is applied to meat which is not cured at all. I must say it strikes me that would not be a good patent at all." (*L. R.*, 3 *App. Cas.* 1079.)

(*h*) UNITED TELEPHONE COMPANY *v.* HARRISON, COX, WALKER, AND COMPANY. [1882]

An instrument which was alleged to be an anticipation of an invention patented in 1876, for improvements in electric telephony and telephonic apparatus was described with plates in a paper written in German in a scientific journal called the 'Zeitschrift' of the German-Austrian Telegraph Union, published in 1862, in Berlin. A copy of the 'Zeitschrift' was in the library of the Patent Office in London, and another copy was in the library of the Institute of Civil Engineers, where it was accessible to all the members, more than 3000 in number, and to friends introduced by them. It was, however, entered in the catalogue only under the head of Journals, not under the head of Telephones or Telegraphs. A telegraphic engineer gave evidence that before the date of the patent he had seen the description in the 'Zeitschrift,' and that though he could not read German, he was able from his knowledge of the technical words used, with the assistance of the plates, to understand the substance of the invention. *Held*, that there was evidence from which it ought to be inferred that the description in the journal must be considered to have been within the knowledge of persons skilled in such matters in this country. But *held*, on the facts, that the description was not an anticipation of the patented invention. (21 *Ch. D.* 720.)

(l) DAVIS *v.* FELDMAN. C. A. [1884]

Another way of stating the question whether a specification is an anticipation of a particular invention in a material part, is to try the question: "Would the patentee by using his patented invention be infringing the patent which did or would have resulted from the completion of the prior specification?" (*Griff.* 75; 1 *O. R.* 193.)

(m) PHILPOTT *v.* HANBURY. [1884-5]

Grove, J.: "My opinion is that there is not the same necessity for accurate description of how an invention shall be carried into effect for the purpose of anticipating an invention, as there is for the purpose of sustaining a patent in the hands of a patentee, because in the latter case a description ought to be given which ought not to merely inform the minds of every skilled person or scientific person in the trade, but should inform the minds of ordinary persons who are accustomed to work at the trade. Therefore I think that there is a distinction, but I am willing to rest my definition or description of what anticipates a patent on this, that there must be a publication, which, when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it perhaps to those in the trade who are most skilled, the higher class of skilled workmen), would enable them to understand it. If it be such it anticipates the patent. If it is a mere suggestion, if it is so erroneous in the description that they cannot by reasonable application of the mind find out what it means, it does not anticipate the patent." (*Griff.* 185; 2 *O. R.* 33, at p. 43.)

(n) JENSEN *v.* SMITH. [1885]

It was alleged that the plaintiff's patent for improvements in lubricators, wherein the lubricant was forced through a pipe by a screw actuated by a cap, had been anticipated by a lubricator having a top through which a screw passed, and a piston inside actuated by the screw:—*Held*, that assuming that the plaintiff's patent had been valid the alleged anticipation would have been an infringement of it, and that, therefore, there was not sufficient invention in it. (*Griff.* 136; 2 *O. R.* 249.)

(o) POOLEY *v.* POINTON. [1885]

The specification which was alleged to be an anticipation was so clogged with superfluous apparatus that the patented process never obtained currency in England. Pearson, J.: "It may be said that inasmuch as his apparatus was so costly and so cumbersome that it prevented the use of his process, that he had described no way by which that process could be effectually used, and that accordingly his patent must be considered as a dead letter, and did not stand in the way of any person who should take out a patent for a similar principle shown in the process easy and without cost." But whether this was so or not the judge held that the plaintiff in his patent had not got any further than the prior specification, and that, therefore, the patent was bad. (*Griff.* 199; 2 *O. R.* 167, at p. 171.)

(p) *LAWRENCE v. PERRY.* [1885]

A patent for improvements in lead and crayon holders was alleged to have been anticipated by various specifications, one of which was only provisional. North, J.: "I have felt some difficulty in seeing how the plaintiff's invention can be useful if it only differs from an earlier one by an ingredient which does neither harm nor good." (2 *O. R.*, p. 184.) It was alleged "that no case has occurred yet in which the description contained in a provisional specification has been held sufficiently precise to destroy a later patent for a like subject. Be this as it may there is nothing in that remark relevant to the present case. . . . In this case I am clearly of opinion that Wiley's provisional specification does contain quite a sufficient description of the nature of the invention, and also of the manner in which it is to be performed to bring the case within the ruling of Lord Westbury in *Hills v. Evans*. I find a clear description how to construct an instrument which is completely covered by the first claiming clause of the plaintiff's; and this is, in my opinion, quite sufficient to prevent there being subsequent first and true inventors within the realm of the instrument so described even if the description in the provisional specification of other alternative forms of instrument were mere sketches only." (*Griff.* 143; 2 *O. R.* 180, at p. 187.)

(q) *OTTO v. STEEL.* C. A. [1886]

A French treatise was placed in the British Museum in 1863. The Museum Catalogue is kept with reference to author's names; books are arranged according to subject matter; readers can under guidance search for books on particular subjects:—*Held*, that there was no prior publication in England of matter contained in the treatise so as to avoid a patent taken out in 1876. (31 *Ch. D.* 241; 55 *L. J. Ch.* 196; 54 *L. T. Rep.*, N. S. 157; 34 *W. R.* 289; 3 *O. R.* 109.)

(r) *LISTER v. NORTON.* [1886]

The defendant in an action for infringement alleged want of novelty on the ground that the patentee had filed a provisional specification on the 24th July, 1880, the provisional specification of the completed patent being filed on the 21st January, 1881, and had so used and published the invention between these dates as to distinguish this case from *Oxley v. Holden*, and to invalidate the patent:—*Held*, that there was evidence of user during this period, but that this user in public was covered by the grounds on which *Oxley v. Holden* was decided, and was protected by the first provisional specification. (*Griff.* 148; 3 *O. R.* 199.)

(s) *FLETCHER v. ARDEN.* [1887]

The plaintiff's patent was for an improved gas-cooking apparatus:—*Held*, that it had been anticipated by an apparatus from which it differed only in the substitution of a hinge or a pivot for a slide as a means of attaching certain deflector plates. (5 *O. R.* 46.)



## (t) MOSELEY v. THE VICTORIA RUBBER COMPANY. [1887]

Chitty, J. (following *Hills v. Evans*): "The information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent." (4 O. R. 252.) The defendants relied on four specifications covering a period of fourteen years, and the latest nearly twenty years before the plaintiff's patent. No one had produced from them an article such as that produced by the plaintiff's process:—*Held*, no anticipation. (4 O. R. 241.)

## (u) HARRIS v. ROTHWELL. C. A. [1887]

In December, 1878, and February, 1880, specifications in German with drawings of two patents were deposited in the free library at the Patent Office, and the Commissioners' Journal, amongst the list of patents granted in Germany, contained entries of these patents with notes that the specifications might be consulted in the library of the office. In April, 1880, a patent was obtained for a similar invention:—*Held*, that there was evidence from which to infer prior publication in this country, and that this inference was not affected by the prior specifications being in German. Lindley, L. J.: "*Primâ facie* a patentee is not the first inventor of his patented invention if it be proved that before the date of his patent an intelligible description of his invention, either in English or in any other language commonly known in this country, was known to exist in this country either in the Patent Office or in any other library to which the public are admitted, and to which persons in search of information on the subject to which the patent relates would naturally go for information. But if, as in *Plimpton v. Malcolmson*, *Plimpton v. Spiller*, and *Otto v. Steel*, it be proved that the foreign publication, although in a public library, was not in fact known to be there, the unknown existence of the publication is not fatal to the patent." (35 Ch. D. 416, at p. 431; 56 L. J. Ch. 459; 56 L. T. 552; 35 W. R. 581; 3 T. L. R. 553.)

## (v) EHRLICH v. IHLEE. C. A. [1888]

Where the only anticipation alleged is by description in a specification or otherwise, it must be such as would enable any competent person to make from it the machine for which protection is claimed. (5 O. R. 437.)

## (w) KAYE v. CHUBB. H. L. [1888]

*Semble*: A worthless and abandoned patent may be an anticipation of a subsequent invention if it describe such invention in terms which fully and sufficiently disclose it and the manner in which it is to be practised. (5 O. R. 641.)

## (x) HERBURGER SCHWANDER ET CIE. v. SQUIRE. C. A. [1889]

An invention which was merely the adjustment in a beneficial manner of the distance between two of the working parts of a known machine:—*Held*, to be anticipated by a drawing in a previous

specification which showed the same position of the parts, though the subject of that invention was the substitution of metal for wood. (5 O. R. 393.) Esher, M.R.: "I should say that if a person has drawn a picture of a machine without describing it at all and published that picture in a book, and that picture was one which any machinist would understand and could make a machine from that picture alone, although the man had not claimed the thing by a patent or as subject matter of a patent, if he had published it so as to be generally known, then a person cannot take out a patent in respect of a machine made substantially like that, which would be an infringement of it if it had been patented." (6 O. R. 194.)

(y) THOMSON v. BATTY. [1889]

In the plaintiff's patent the third claim was for the employment in compasses of a large bowl filled or partially filled with a viscous fluid, and the fluid operated to retard the vibrations of the bowl in which it rested, which operated to steady the compass bowl. In the alleged anticipation the viscous fluid was directly in contact with the compass bowl and prevented its shifting its place:—*Held*, that as in the plaintiff's patent the fluid steadied the compass bowl not by pressing against it, but by friction against the vessel in which it was itself contained, there was no anticipation. (6 O. R. 84.)

(z) WINBY v. MANCHESTER STEAM TRAMWAYS. [1889]

"Where the only anticipation alleged is by description in a specification or otherwise, it must be such as would enable any competent person to make from it the machine for which protection is claimed:"—*Held*, that there was no anticipation where the patent was for improvements in points for tramways where the tongue was actuated vertically instead of horizontally by a spring, and was automatic; and the alleged anticipation was for improvements in points in railways, and the tongue was worked vertically instead of horizontally, but was held by blocks while the train passed over it. (6 O. R. 359.) Sent down by the Court of Appeal for a new trial on question of infringement. (7 O. R. 30.)

(a) KING, BROWN AND COMPANY v. ANGLO-AMERICAN BRUSH CORPORATION. [1889]

The plaintiffs, whose customers had been repeatedly threatened by the defendants with proceedings in respect of compound wound dynamo machines, alleged to be infringements, commenced an action to have the defendants' patent declared void on grounds of variance, want of novelty, and improper amendment. The defendants' patent claimed practically (1) the form of commutator described (as to which the court held that there was a fatal variance between the specifications); and (2), the series-shunt machine, which the defendants alleged had been patented, and used by Varley. *Held*, that Varley's patent did sufficiently describe a series-shunt machine to enable a workman to make one. Lord

Trayner: "But even assuming the fact to be that from Varley's description alone the ordinary skilled workman could not have constructed a series-shunt machine, that is by no means conclusive. A specification may so insufficiently describe the process or the machine patented as to render the patent invalid. It may, nevertheless, contain sufficient description to disclose or publish the invention so as to prevent its being validly patented by another subsequently."

*Held*, further, that a machine constructed under Varley's patent was in fact a series-shunt machine, and that as it was used to illustrate certain operations in a diving-tank before the public, this was a sufficient publication. (6 O. R. 414.)

(b) AMERICAN BRAIDED WIRE COMPANY v. THOMSON. H. L. [1889]

A patent, which consisted substantially in the application of tubular sections of braided hard wire to bustles, was alleged to be anticipated by a specification which described certain applications of braided wire to satchels, handles, and other articles, and mentioned that the material might be applied to bustles; and by another specification, for the application of braided hard wire to cushions—but there had not been any use of braided hard wire within the realm. *Held*, that this invention was not anticipated. (5 O. R. 113; 6 O. R. 518.)

(c) DEUTSCHE NAHMASCHINEN FABRIK v. PFAFF. C. A. [1889]

The plaintiff's patent was for an improvement in sewing-machine shuttles, and consisted in the interposition of springs between the point and heel of the shuttle and the driver in order to avoid noise, and moderate the tension of the thread. In the sewing machine, which was alleged to be an anticipation, there was one spring only, viz., at the heel. *Held*, that there was not sufficient invention in the improvement to support the plaintiff's patent. (7 O. R. 16.) Affirmed by the Court of Appeal, after hearing the defendant's evidence, on the ground that the patentee had only varied the strength of a spring in a well-known machine. (7 O. R. 251.)

(c\*) CHEETHAM v. OLDHAM AND FOGG. [1890]

The plaintiff's patent was for improvements in the manufacture of felt hats:—*Held*, that it was anticipated by a patent which had attained a similar object, namely the utilisation of the fur dust. (7 O. R. 116.)

### Publication by Experiment.

(d) BRAMAH v. HARDCASTLE. N. P. [1789]

The plaintiff had made two or three of his patent machines before the date of his patent, but it was admitted that that circumstance would not of itself avoid the grant. (*Holroyd*, 81; 1 *Web. P. C.* 44, n.)

(e) JONES *v.* PEARCE. N. P. [1832]

The plaintiff obtained a patent, dated 1826, for "an improved method of making carriage wheels." The defendant proved that Mr. Strutt, in 1814, had wheels constructed upon the same principle as the patent, but differing from it in the details of construction. These wheels were used on a cart for a year, but subsequently getting out of order were laid aside. Patterson, J., referring to the novelty of the invention, said to the jury: "It is not necessary to show that it was actually in use at the moment of taking out the patent. The circumstance of ceasing to use it would not make it new. The question is, was there really an invention by Mr. Strutt in use, known to others? If you should think his was an abortive attempt, and a failure, or a mere experiment which did not answer, then it would not invalidate the plaintiff's patent." (1 *Carp. P. C.* 529.) . . . "It is for you to say, if on the whole of this evidence, either on the one side or the other, it appeared this wheel constructed by Mr. Strutt's order in 1814, was a wheel on the same principles, and in substance the same wheel as the other for which the plaintiff has taken out his patent, and that was used openly in public, so that everybody might see it, and had continued to use the same thing up to the time of taking out the patent, undoubtedly then that would be a ground to say that the plaintiff's invention is not new, and if it is not new, of course his patent is bad, and he cannot recover in this action; but if, on the other hand, you are of opinion that Mr. Strutt's was an experiment, and that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and that the plaintiff's invention, which came afterwards, was his own invention, and remedied the defects, if I may so say, although he knew nothing of Mr. Strutt's wheel, he remedied the defects of Mr. Strutt's wheel, then there is no reason for saying the plaintiff's patent is not good." (*Ib.* 530; 1 *Web. P. C.* 122.)

(f) GALLOWAY *v.* BLEADEN. N. P. [1839]

Tindal, C.J., thus laid down the law with regard to the novelty of an invention: "A mere experiment, or a mere course of experiments, for the purpose of producing a result which is not brought to its completion, but begins and ends in uncertain experiments, that is not such an invention as should prevent another person, who is more successful, or pursues with greater industry the chain in the line that has been laid out for him by the preceding inventor, from availing himself of it, and having the benefit of it." (1 *Web. P. C.* 525.)

(g) GIBSON *v.* BRAND. N. P. [1841]

Tindal, C.J.: "It would not be sufficient to destroy the patent to show, that learned persons in their studies had foreseen, or had found out this discovery, that is afterwards made public, or that a man in his private warehouse had by various experiments endea-

voured to discover it and failed, and had given it up." (1 *Web. P. C.* 628.)

(h) *THE HOUSEHILL COMPANY v. NEILSON.* H. L. [1843]

Trials of an incomplete invention, by way of experiment, are not evidence of a prior use for the purpose of invalidating a patent. (9 *C. & F.* 788; 1 *Web. P. C.* 673.)

(i) *Re NEWALL AND ELLIOT.* [1858]

A necessary and unavoidable disclosure of an invention to others, if made in the course of mere experiments, is not such a publication as will avoid the subsequent grant of a patent, though the same disclosure, if made in the course of a profitable use of an invention *previously ascertained to be useful*, would be a publication; but an experiment performed in the presence of others, which not only turns out to be successful, but actually beneficial in the particular instance, is not necessarily a publication, so as to constitute a gift of the invention to the world. (4 *C. B., N. S.* 269; 4 *Jur., N. S.* 562; 27 *L. J., C. P.* 337.)

(j) *HILLS v. THE LONDON GASLIGHT COMPANY.* [1860]

Action for the infringement of a patent, obtained in 1849, for the purification of coal gas by means of *hydrated* oxides of iron. In 1840, C. had obtained a patent for the purification of gas, and claimed the use of all oxides of iron for that purpose. It was proved at the trial that the *hydrated* oxides alone would answer the purpose. In working for the purpose of completing the specification of his patent, C. had used oxides of iron for the purification of gas, and the gas purified by him to the extent of 20,000 feet a day, had for many days been mixed with the ordinary gas, and supplied to the public from the mains of a gas company. He had renovated the material by exposing it to heat on the top of some retort beds. The oxides were originally in a hydrated state, and the heat used by him while so working was not sufficient to render them anhydrous; but, not knowing the difference between hydrated and anhydrous oxides, and supposing that a better result would thereby be obtained, he directed in his specification that the material should be raised to a red heat, which would render the oxides anhydrous. The jury having found that what C. did was in the nature of an experiment, and was not a publication to the world, the Court held that it did not invalidate the plaintiff's patent. Bramwell, B., in delivering the judgment of the Court, said: "The word 'experiment' in the cases referred to has been used, not as the sole test upon a matter of this sort, but it has been used as indicating a class of practice. There is no particular virtue in the word 'experiment,' and it has been used for the purpose of showing that, if there has not been a user of an invention of a substantial character, but rather of an experimental character, or of a character analogous to an experiment, why then, although the thing has been done before, it does not preclude a person from taking out a patent for it; so that although what Croll did may not have been

strictly in the nature of an experiment, being something more,—it may or may not have been so,—still the jury have so found it, and we cannot grant a new trial.” (5 *H. & N.* 312; 29 *L. J.*, *Exch.* 409.)

(k) *BOVILL v. GOODIER* N. P. [1866–71]

Byles, J.: “There may have been a great many experiments in many cases before the real thing was found out; nay, sometimes what turns out to be the real thing has often been used, but only by way of experiment, and then given up. That is not an anticipation of a patent. A man must have brought his invention, or his invention of a combination, to a successful issue, so that the thing can be done, and it must be done, not as a mere experiment. . . . If he had a machine which did do the thing, and he did not do it, and knew nothing about it, this being a patent for a process, that is not an anticipation.” In this case, the patent being for an improved method of working millstones, by which the exhaust was made just sufficient to suck away the accumulated hot air, a witness stated, that he had seen machinery before the date of the patent, which could be worked so as to exhaust the hot air, and no more. Byles, J., said: “Of course, it can be; because, if a man has a powerful exhaust, he can exhaust to a very small degree so as to produce less effect, or to a larger degree, to go up to the plenum and go beyond it and suck up the stive to the meal spout. He may do all that, but the question here is did they invent, or even know of that precise point at which you are to stop? . . . This is a patent for a process, and as if there be a patent for a medicine composed of several ingredients, and one of them is very hurtful in one dose and very beneficial in another, the amount of the dose is the very essence of the invention, so here the quantity of air you suck up is the essence of the invention.” (2 *Griff.* 47, at p. 48; *Bovill's Pat.*, p. 186.)

(l) *SAXBY v. GLOUCESTER WAGGON COMPANY.* H. L. [1883]

The invention, which was the subject of the plaintiff's patent, related to railway signalling. Prior to the date of the patent, Edwards, who had been in the plaintiff's service, was employed by the L. & N. W. R. in the manufacture of signalling apparatus, and, in the course of his employment, caused drawings to be made of the invention by his own clerks, and those of the railway company. From these drawings a working machine was made, for use in a siding, but was not, in fact, used, and the drawings were submitted to the locomotive committee, but were not approved:—*Held*, that, as this was done, not with a view of taking out a patent, but with a view to working the invention, there was a publication; and that, as the invention belonged to Edwards, and not to the company, it was immaterial that the servants of the company to whom the disclosure was made were bound to secrecy. (2 *Griff.* 54; *Good. P. C.* 417.)

(m) *USEFUL PATENTS COMPANY v. RYLANDS.* [1885]

Before the provisional specification was filed, the intending patentee sent a tool for cutting grooves in bottles, substantially

the same as the alleged infringement, to the defendant Rylands. In fact, the patentee intended that Rylands alone should use it, and should keep it secret. Rylands had two other similar tools made by permission of the patentee, and turned out, at least, 600 dozen bottles as samples:—*Held*, that this was all experimental, and that there was no publication. (*Griff.* 234; 2 *O. R.* 255.)

(n) *WINBY v. MANCHESTER STEAM TRAMWAYS.* [1889]

A model of an invention for improved points, similar to that patented by the plaintiff, had been made a year before the patent, by manufacturers at Stoke-upon-Trent, for a Mr. Ayton, and had been left for some time in the sheds of the North Staffordshire Tramways Company. Later, it got into the possession of the City Contract Corporation, who sent it to the defendants' solicitors. No points had ever been made from the model:—*Held*, that this was only experimental, and not publication. (6 *O. R.* 359.) Ordered, to go down for a new trial on the question of infringement. (7 *O. R.* 30.)

*Publication by Sale.*

(o) *WOOD v. ZIMMER.* N. P. [1815]

Gibbs, C.J.: "The public sale of that, which is afterwards made the subject of a patent, though sold by the inventor only, made the patent void." (1 *Holt, N. P. C.* 60; 1 *Web. P. C.* 44; 1 *Carp. P. C.* 294.)

(p) *MORGAN v. SEAWARD.* [1837]

Parke, B., said: "It must be admitted, that if the patentee himself had, before his patent, constructed machines for sale as an article of commerce for gain to himself, and been in the practice of selling them publicly, that is, to any one of the public who would buy, the invention would not be new at the date of the patent. This was laid down in the case of *Wood v. Zimmer*, and appears to be founded on reason. For if the inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another take out a patent, he might have practically a monopoly for a much longer period than fourteen years. Nor are we prepared to say, that if such a sale was of articles that were only fit for a foreign market, or to be used abroad, it would make any difference; nor that a single instance of such a sale as an article of commerce, to any one who choose to buy, might not be deemed the commencement of such a practice, and a public use of the invention, so as to defeat the patent." (2 *M. & W.* 559; 1 *Jur.* 528; 1 *Web. P. C.* 194.)

(q) *LOSH v. HAGUE.* N. P. [1838]

The publicly making and selling an article to one individual, though there be no demand or use for it by the public, will vitiate a subsequent patent. (1 *Web. P. C.* 205.)

(r) *GIBSON v. BRAND.* N. P. [1841]

Tindal, C.J., said: "If you perceive on the evidence, that the thing which is now sought to be protected by the patent has been used, and for a considerable period, and used so far to the benefit of the public as to be sold to anybody that thought proper to purchase it of those who made it, then it becomes a material question, whether such mode of user is not in your judgment a public using of the article, of the process, or of the invention, before the letters patent were granted." (1 *Web. P. C.* 628.)

(s) *CARPENTER v. SMITH.* N. P. [1841]

Action for the infringement of a patent for certain improvements in locks. It was proved that seven and a half dozen of the locks had been manufactured before the date of the patent, and exported to America. Abinger, C.B., said: "Here you have an article, manufactured by an English manufacturer, and sold, and, in my opinion, if it was sold even for the assumed purpose of being sent to America, I cannot but think that that would be destructive of the novelty of the plaintiff's invention. And here let me be clearly understood; I do not mean to say, that if a man in America employs an agent to see if he can get an article manufactured in England by a particular model, and chooses to take out a patent for it himself, but not with a view of making it public at all, I do not mean to say that that man is to be considered as not entitled to the invention afterwards, because he employs a workman to assist him in it, or, that if he had failed entirely, that some other man might make the invention in England; but where a model is sent to a workman, who sells seven and a half dozen, and sells them for a certain price, I must say I think the invention was used and publicly exercised." (1 *Web. P. C.* 536.)

(t) *HANCOCK v. SOMERVELL.* N. P. [1851]

An invention may come into public use by being handed about the country for the purpose of attracting customers, although no actual sale has taken place. (*New. Lon. Jour.*, vol. 39, p. 158.)

(u) *MULLINS v. HART.* N. P. [1852]

The prior deposit of articles, of novel manufacture, in a warehouse for sale, although no sale takes place, is a sufficient publication to defeat a patentee's claim to novelty in the invention of similar articles. (3 *Car. & K.* 297.)

(v) *HONIBALL v. BLOOMER.* N. P. [1854]

If an article, subsequently patented, be, even in a single instance, sold in the regular way of business, although it turns out a failure, the patent cannot be supported. (2 *Web. P. C.* 200.)

(w) *OXLEY v. HOLDEN.* [1860]

The manufacture of a patent article for the purpose of sale, and offering it for sale, although no sale is actually effected, is a user



of the invention. And *semble*, per Byles, J., that it is equally a user, though the article is made merely as a sample. (8 C. B., N. S., 666.)

(w) HOLLINS v. CAPPER & Co. [1888]

The defendants proved that they had sold to three persons before the date of the patent teapots similar to those of which the plaintiff complained as infringements. The judge directed the jury that the defendants had proved anticipation. (5 O. R. 289.)

Question for the Jury.

(x) CORNISH v. KEENE. [1837]

Tindal, C.J., in delivering the judgment of the Court, said: "The question raised for the jury was this: whether the various instances brought forward by the defendants amounted to proof that before or at the time of taking out the patent, the manufacture was in public use in England; or whether it fell short of that point, and proved only that experiments had been made in various quarters and had been afterwards abandoned? This question is, from its nature, one of considerable delicacy; a slight alteration in the effect of the evidence will establish either the one proposition or the other, and the only proper mode of deciding it is by leaving it to the jury." (1 *Web. P. C.* 519; 2 *Hodg.* 294; 3 *Bing. N. C.* 588.)

(y) ELLIOTT v. ASTON. N. P. [1840]

The question of public use is for the jury; as, whether the instances adduced show a manufacture to have been in public use. (1 *Web. P. C.* 222.)

(z) MUNTZ v. FOSTER. N. P. [1844]

It is for the jury to say whether, on reading a prior specification and comparing it with the plaintiff's specification, the plaintiff has borrowed his invention from such prior specification. (2 *Web. P. C.* 107.)

(a) SPENCER v. JACK. [1864]

In a suit for an injunction to restrain the infringement of a patent, the Court directed four issues to be tried at law, one amongst them being "whether the invention was a new manufacture." The judge at common law, in the course of the trial of the issues, expressed his opinion that a question of law would arise, whether there was upon the facts a sufficiency of invention to warrant the granting of a patent. The judge, nevertheless, went on with the trial, and put two questions to the jury:—"Is the invention new?" and, "Is it a substantial improvement?" The jury found for the plaintiff in the affirmative upon both issues. Upon the cause coming back to equity, the Master of the Rolls took up the point of law reserved, without considering the verdict of the jury, and, on the motion of the defendants,

granted a new trial:—*Held*, on appeal, that the judge in equity ought to have considered the verdict of the jury, and that, had he done so, the only point of law remaining would have been this,—whether a combination of things previously well known, which combination could be rightfully denominated a substantial improvement, could be the subject of a patent?—the answer to which must have been in the affirmative. The order of the Master of the Rolls, directing a new trial, was consequently reversed. (11 *L. T. Rep., N. S.*, 242.)

**Oath.** Law Officers may examine witnesses on. See Patents Act, 1883, sect. 38, p. 379.

### Objections,

to grant of patent, pp. 38 to 51  
to extension, pp. 128 to 130  
notice of. See under Practice, pp. 299 to 317.

**Obstructive** patent cannot be supported, p. 429 (*q*).

### Offences,

falsely representing that article sold is patented. Patents Act, 1883, sect. 105, p. 268

unauthorised use of Royal Arms. Patents Act, 1883, sect. 106, p. 268

article not to be marked “patent” before acceptance of complete specification, p. 268 (*c*).

**PATENTS ACT, 1883.** 105. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented, if he sells the article with the word “patent,” “patented,” or any word or words expressing or implying that a patent has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

106. Any person who, without the authority of Her Majesty, or any of the Royal family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

(*c*) **REG. v. WALLIS.** [1886]

The defendant was selling a lamp with “patent” on it when he had only lodged a provisional specification, which had been accepted:—*Held*, in the Mansion House Police Court, that sect. 14 of the Act of 1883 (see p. 396) did not justify this, and a penalty imposed under sect. 105. (3 *O. R.* 1.)

(*d*) **REG. v. CRAMPTON.** [1886]

The defendant sold several electric bells marked “patent” before the patent had been granted, and the magistrate followed *Reg. v. Wallis*, and imposed a penalty. (3 *O. R.* 367.)

**Officers.** Appointment of. Sect. 83 of Patents Act, 1883, provides that the Board of Trade may appoint the comptroller, and examiners, and other officers.

**Old Machine.** Application of, to new use. See pp. 522 to 532

„ „ Addition to : See pp. 518 to 522.

**Omission,** in Specification, pp. 436 (*g*), 439 (*n*)

„ of part of process. See pp. 513 (*d*), 514 (*i*), 515 (*j*).

### Opposition,

to amendment. See under Amendment.

to grant. See Application for Letters Patent, Opposition, pp. 38 to 51

to extension. See Extension, pp. 107, 140 (*q*), (*r*), 141, 142.

### Order,

of performing process, change in, p. 514 (*g*)

for injunction, form of, p. 351 (*e*)

construction of, p. 352 (*f*)

of Privy Council, revocation of, p. 105 (*i*).

**Particulars** of Breaches. See pp. 294 to 299

of Objections. See pp. 299 to 317.

**Parties,** to action. See pp. 286 to 290.

### Partnership,

what agreement creates, pp. 207 (*i*), (*k*), 208 (*n*)

interest creates, p. 206 (*g*)

in prospective patents for particular object, p. 207 (*j*)

right severally to use patent under, p. 208 (*m*)

estoppel in cases of, pp. 91 (*q*), (*s*), (*t*), 338 (*s*)

disclosure of an invention to partner, p. 254 (*i*)

partner of licensee not estopped, p. 92 (*u*)

right to use patent after dissolution of, p. 208 (*o*).

### Patent,

definition of. Patents Acts, 1883, sect. 46, p. 269

extent of, sect. 16, p. 269

form of, schedule 1, p. 270

date of, sect. 13, p. 80, sect. 26 (8), p. 402 and sect. 103, p. 61

term of, sect. 17, p. 559

to be for one invention only, sect. 33, p. 269

test of unity of invention is common purpose, p. 271 (*d*), (*e*), (*f*).

Patents Act, 1883, sect. 46. In and for the purposes of this Act, "patent," means letters patent for an invention.

Sect. 16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.

Sect. 33. Every patent may be in the form in the First Schedule to this Act, and shall be granted for one invention only, but may contain more than one claim ; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

## FORM OF PATENT.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting: Whereas John Smith of 29, Perry Street, Birmingham, in the county of Warwick, Engineer, hath by his solemn declaration represented unto us that he is in possession of an invention for "Improvements in Sewing Machines," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief: And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (herein-after together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention: And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention: And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: and to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said Patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything herein-before contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in

*To be for One Invention Only.*

The general object of the invention is the test by which to decide whether a provisional specification should be refused on the ground that it contains more than one invention. If you have a particular general object—*e.g.*, to make rails rest more securely, and you describe two or three cognate devices for carrying it into effect, they are all one invention; but if there is no common purpose and no connection between them except that both are used in connection with rails, there would be two inventions. (*Griff.* 265.)

Hearson applied for a patent for "improvements in apparatus for rapidly heating flowing water, *a part of which improvements is applicable to other purposes:*"—*Held*, that the part italicised in the title, and the corresponding part in the provisional specification, must be omitted. (*Griff.* 266.)

Application for a patent for "improvements in the art of producing and utilizing induced electrical currents for telegraphy and other purposes:"—*Held*, that the patentee might elect either to protect his appliance for all purposes or to protect the improved telegraphic apparatus described; and the words "for telegraphy and other purposes," and the description of the telegraphic apparatus, were struck out. (*Griff.* 267.)

**Patentee,**

Patents Act, 1883, sects. 4, 34, and 46, p. 272.

of invention new in England, p. 272 (g)

known but not published, p. 272 (*h*)

communicated by British subject, p. 277 (b)

simultaneous discoveries, p. 272 (*i*)

servant while in employ of master, pp. 273 (*k*), 276 (*w*)

may employ professional assistance, p. 273 (l)

must be able to claim the merit of the invention, pp. 275 (*v*), 276 (*y*)  
official inventing in course of his duty, p. 276 (*z*).

*Importer of Foreign invention—*

may take out patent in his own name, pp. 276 (*x*), 278 (*e*), (*g*), 279 (*h*)  
although holding in trust for foreigner, p. 278 (*d*)  
where the communicant is a British subject, p. 278 (*e*)  
must not take patent as for original invention, p. 145 (*l*)  
unless he has sufficiently improved it, pp. 278 (*e*), 279 (*h*).

*Who may be.*

PATENTS ACT, 1883, Sect. 4. (1.) Any person, whether a British subject or not, may make an application for a patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

Sect. 46. In and for the purposes of this Act, "Patentee" means the person for the time being entitled to the benefit of a patent.

Sect. 34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

*True and First Inventor.*

(*g*) *EDGEBERRY v. STEPHENS.* [1691]

A grant of a monopoly may be to the first inventor, by the 21 Jac. 1; and, if the invention be new in England, a patent may be granted, though the thing was practised beyond sea before; for the statute speaks of new manufactures within this realm; so that, if it be new here, it is within the statute; for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study, it is the same thing. (2 *Salk.* 447; *Comb.* 84; *Dav. P. C.* 36; 1 *Web. P. C.* 35; 1 *Carp. P. C.* 35.)

(*h*) *DOLLOND'S PATENT.* [1758]

Patent for a new method of making the object-glasses of refracting telescopes. Before the date of the patent Dr. Hall had made and used object-glasses, of a precisely similar construction in his own observatory, but had not made any publication of their mode of construction or use:—*Held*, that this was not such a prior use as to invalidate the patent. (*Cit. in Boulton v. Bull*, 2 *H. Bl.* 469, 470, 487; *Dav. P. C.* 170, 171, 172, 199; 1 *Web. P. C.* 43; 1 *Carp. P. C.* 28.)

(*i*) *FORSYTH v. RIVIERE.* [1819]

If several persons simultaneously discover the same thing, the party first communicating it to the public, under the protection of letters patent, becomes the legal inventor. (*Chitty's Prerog. Crown*, 182; 1 *Web. P. C.* 97; 1 *Carp. P. C.* 401.)

(j) *R. v. WHEELER*. Sci. fac. [1819]

Abbott, C.J., delivering the judgment of the Court, said: "If the patentee has not invented the matter or thing of which he represents himself to be the inventor, the consideration of the royal grant fails, and the grant consequently becomes void. And this will not be the less true, if it should happen that the patentee has invented some other matter or thing, of which, upon a due representation thereof, he might have been entitled to a grant of the exclusive use." (2 *B. & Ald.* 349.)

(k) *BARBER v. WALDUCK*. N. P. [1823]

Action for the infringement of a patent for an improvement in making hats. One of the plaintiff's witnesses proved that he had made the improvement, which was the subject of the patent, while employed in their workshop. Holroyd, J., ordered a nonsuit. (*Cit.* 1 *C. & P.* 567; 1 *Carp. P. C.* 438.)

(l) *BLOXAM v. ELSEE*. N. P. [1825]

Action for the infringement of a patent for "a machine for making paper in single sheets without seam or joinings." The principle of this invention consisted in receiving the pulp to be made into paper upon an endless wire web, stretched upon revolving cylinders, so that the paper was moved forward as fast as it was formed. The patentee discovered the principle of this invention, but the mechanical details necessary for carrying the invention into complete effect were numerous and complicated, and therefore he engaged Mr. Donkin, an engineer, to give him his professional assistance, and several parts of the machine were suggested to the patentee by Mr. Donkin. It was objected by the defendants that the patentee, under these circumstances, could not be the inventor; but it was answered that Mr. Donkin was merely acting as the patentee's servant, and the objection was not sustained. (1 *C. & P.* 567; 1 *Web. P. C.* 132, n.; 1 *Carp. P. C.* 434.)

(n) *LEWIS v. MARLING*. [1829]

Action for an infringement of a patent for certain improvements on shearing machines. It was proved by the defendant, that the specification of a similar machine had previously been enrolled in America, that a model of an exactly similar machine had been exhibited to three or four persons in England, and that a manufacturer in England had commenced the construction of a machine from the American specification. Bayley, J., said: "If it had been shown that the plaintiff had seen the model, and had borrowed from it, he would not have been the true inventor, and would, therefore, have misled the Crown; but if I made a discovery, and am enabled to produce an effect from my own experiments, judgment, and skill, it is no objection that some one else has made a similar discovery by his mind, unless it has become public. So, if I introduce a discovery, *bonâ fide* made, I

may have a patent for it, though a person might have received privately a communication from abroad, which would have enabled him to have made the machine." (1 *Web. P. C.* 493.)

(o) *MINTER v. WELLS.* N. P. [1834]

Action for the infringement of a patent for "improvements in the construction, making, or manufacturing of chairs." The patentee claimed "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counterbalance to the pressure against the back of such chair, as above described." The defendants contended that the invention was made, not by the patentee, but by a person by the name of Sutton. Alderson, B., in summing up to the jury, said: "He (the patentee) claims under the patent, stating it in his petition to the Crown, that he is the true inventor of the machine in question; and if it could be shown that he was not the true inventor, but that some one else had invented it, the Crown is deceived in that suggestion, which was the foundation on which it granted the patent; and then the law is, that a patent obtained under such circumstances would be void, and no action could be maintained against a party for the infringement of the patent, by reason of the suggestion to the Crown not being true." (1 *Web. P. C.* 127; 1 *Carp. P. C.* 622.)

(p) *CORNISH v. KEENE.* N. P. [1835]

Action for the infringement of a patent, which was held invalid for want of novelty. Tindal, C.J., in summing up to the jury, said: "Sometimes it is a material question to determine whether the party who got the patent was the real and original inventor or not, because these patents are granted as a reward, not only for the benefit that is conferred upon the public by the discovery, but also to the ingenuity of the first inventor; and, although it is proved that it is a new discovery so far as the world is concerned, yet if anybody is able to show that although that was new—that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from A. or B., or taken it from a book that was printed in England, and which was open to all the world—then, although the public had the benefit of it, it would become an important question whether he was the first and original inventor of it." (1 *Web. P. C.* 507.)

(q) *LOSH v. HAGUE.* N. P. [1838]

Abinger, C.B.: "If a man claims by his patent a number of things, as being the inventor of them, whether they consist of improvements or original inventions, and it turns out that some of them be not original and not improvements, his patent is void." (1 *Web. P. C.* 203.)

(r) *GIBSON v. BRAND.* N. P. [1841]

Tindal, C.J., in summing up to the jury in this case, said:



"A man may publish to the world that which is perfectly new in all its use, and has not before been enjoyed, and yet he may not be the first and true inventor: he may have borrowed it from some other person, he may have taken it from a book, he may have learnt it from a specification, and then the legislature never intended that a person who had taken all his knowledge from the art of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill. There is some distinction, although perhaps not a very broad one, between the plea which alleges the plaintiffs were not the first and true inventors, and that on which I conceive the principal question between the parties will turn—the third in order, viz., whether the subject-matter of this patent was known in England at the time the letters patent were granted." (1 *Web. P. C.* 628.)

(s) *WALTON v. POTTER.* N. P. [1841]

Tindal, C.J.: "Though the matter may not have been used, the party is not entitled to his patent unless he is the first and true inventor; therefore, if the subject-matter of the patent has been discovered, has been published in a dictionary, for example, though it has not been reduced into practice, if a man merely adopts it, the merit is so small that his patent for it would be worth nothing." (1 *Web. P. C.* 592.)

(t) *WALTON v. BATEMAN.* N. P. [1842]

Cresswell, J.: "The party obtaining the patent must be the true and first inventor in this country. If he import from a foreign country that 'which others at the time of the making of such letters patent and grants did not use,' it will suffice." (1 *Web. P. C.* 615.)

(u) *STEAD v. WILLIAMS.* N. P. [1843]

Cresswell, J., in directing the jury, said: "Then comes this question, that, long before the patent was granted, the invention was publicly known in this country. Now, as to its being publicly known in this country, I take it that there is a great difference between the knowledge of it as a thing that would answer, and was in use, and the knowledge of it as a mere experiment that had been found to be a failure and thrown aside. If you are dealing with an article of merchandise, or with an article of ordinary use—if a person has had a scheme in his head, and has carried it out, but, after a trial, has thrown it aside, and the thing is forgotten and gone by—then, another person re-introducing it, may, within the meaning of this Act, be the inventor and the first user of it, so as to justify a patent." (2 *Web. P. C.* 135.)

(v) *MUNTZ v. FOSTER.* N. P. [1844]

Tindal, C.J.: "First of all, it is said that the manufacture which is described in this patent is not a new one. In the next

place it is said, even if it is a new one, that the plaintiff is not the true and first inventor. Now these two objections go very nearly to the same point; they are not precisely the same, there may be a difference between them, but it will be very much the same train of reasoning that will apply to the one as to the other. It may be very true that the manufacture might be a new manufacture, not known in this kingdom till the time of the patent, and yet it might also be true that Mr. Muntz might not be the first and true inventor; because, although a man may take it from an old book, or from some description that he has got elsewhere, where it has been worked, although not generally known, . . . yet if he had taken it from Collins's specification, . . . he would not be entitled to that benefit which the statute of James intended, namely, for the merit of having by experiment, or by imitation, or by his sagacity, made a discovery himself; but would only be clothing himself with a discovery which would be the result of another man's labour." (2 *Web. P. C.* 102.)

(w) *ALLEN v. RAWSON.* [1845] .

In this case, Tindal, C.J., said: "It would be difficult to define how far the suggestions of a workman, employed in the construction of a machine, are to be considered as distinct inventions by him, so as to avoid a patent incorporating them taken out by his employer. Each case must depend upon its own merits. But, when we see that the principle and object of the invention are complete without it, I think it is too much that a suggestion of a workman, employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void." (1 *C. B.* 574.)

(x) *NICKELS v. ROSS.* [1849]

A party availing himself of information from abroad is an inventor within 21 Jac. 1, c. 3, s. 6. (8 *C. B.* 679.)

(y) *In re HONIBALL'S PATENT.* [1855]

A first and original inventor means a person who could claim the merit of first invention, without reference to the user. (9 *Moo. P. C. C.* 378.)

(z) *PATTERSON v. THE GAS LIGHT AND COKE COMPANY.* H. L. [1876-7]

The plaintiff, one of the three gas referees appointed by the Board of Trade, under the City of London Gas Act, 1868, obtained a patent while acting as such referee, for "improvements in the purification of coal gas;" and subsequently filed a bill against the defendants to restrain them from infringing the same. The application for the patent was dated March 9, 1872, and the first publication of the invention was in an official report, published by all the referees jointly, which bore date January 31, 1872, but was kept back from the official authorities until the 26th of March

following, and was generally circulated a few days after. The official report of the referees contained instructions and suggestions for the guidance of gas companies; and the gas referees are required by the above Act of Parliament to prescribe and certify the maximum amount of impurity in each form with which gas supplied by a company shall be allowed to be charged.

James, L.J., on appeal from V.-C. Bacon, said: "Although it is not necessary for the determination of this suit to pronounce any final decision on this point, we deem it right to say that we think it, at the very least, very questionable whether it can be competent for a member of an official commission or committee to take out a patent for the subject matter of their official investigation, for the results of such investigation embodied in their official report to the public authorities, or to treat as piratical infringers those who have followed the suggestions and directions contained in such report. . . . The consideration for every patent is the communication of useful information to the public. What consideration is there when the information was already the property of the State?" (2 *Ch. D.* 832.)

In the House of Lords Lord Gordon said: "The public not only received no consideration for the patent, but the subject of it was actually the property of the public. I entertain, therefore, the gravest doubt whether the appellant was not legally precluded from obtaining the patent, and whether it is not altogether void." (3 *App. Cas.* 251.)

(a) *CHEAVIN v. WALKER.* V.-C. B. [1876]

A patent may be granted jointly to an adult and a minor. (5 *Ch. D.* 858.)

(b) *MARSDEN v. THE SAVILLE STREET FOUNDRY.* C. A. [1878]

The communication, made in England by one British subject to another, of an invention does not make the person to whom the communication is made the first and true inventor within the meaning of the statute 21 Jac. 1, c. 3, so as to enable him to take out letters patent for the invention.

Jessel, M.R., in delivering judgment, said: "This is a mere experiment. From the time of the passing of the statute 21 Jac. 1, c. 3, down to the present time, no one, so far as I know, has contended in a court of law, much less has any court of law allowed, the validity of such a contention as that a communication made in England by one British subject to another British subject can be patented by the receiver of a communication, so as to make the receiver the true and first inventor within the meaning of the patent laws. It has been argued that, before the statute of James, such patents were valid and were allowed by the judges, and that the statute merely restricts the duration of the patent, and does not destroy the right as it previously existed. Even supposing that were so, the statute defines who are considered to be worthy recipients of the grant of such a monopoly, as it was then called, and the definition so given has been allowed ever since. It is

difficult to say, *à priori*, on what principle a person who did not invent anything, but who merely imported from abroad into this realm the invention of another, was treated by the judges as being the first and true inventor. . . . It has never been declared by any judge or authority that there is such a principle, and, not being able to find one, all I can say is, that I must look upon it as a sort of anomalous decision, which has acquired by time and recognition the force of law." (*L. R.*, 3 *Exch. D.* 203-4.)

(c) *KURTZ v. SPENCE.* [1888]

The question who is first and true inventor is a question of fact, which is not concluded by the grant of letters patent. A subsequent patentee is at liberty to prove himself first and true inventor. Two partners, *Held*, to be the first and true inventors, though many stages in the discovery were due to a subordinate agent alone, and although one partner devoted himself mainly to the commercial business of the firm. (5 *O. R.* 179.)

*Importer of Foreign Invention.*

(d) *BEARD v. EGERTON.* [1846]

A patent granted to a British subject, in his own name, for an invention communicated to him by a foreigner, the subject of a state in amity with this country, is not void, although such patent be in truth taken out, and held by the grantee, in trust for such foreigner. (3 *C. B.* 97.)

(e) *MILLIGAN v. MARSH.* [1856]

When a patent is taken out as for an original invention, the subject of the patent being in fact a communication from a British subject resident abroad, the patent is void. *Seemle*, that an agent in this country of an inventor abroad receiving a confidential communication of an invention, not in a practically useful state, may take out a patent for his own benefit, if he, pursuing the idea thus thrown out, discovers a practical way of carrying it into effect. (2 *Jur.*, *N. S.* 1083.)

(f) *PLIMPTON v. MALCOLMSON.* *M. R.* [1876]

There is no law which says that if a man from abroad communicates to A., who communicates to B., B. may not take out the patent. When the patent is for an invention communicated from abroad, the patentee need only tell the public what he himself knows; the patent is not void because the original inventor knew something more, which he did not communicate to the public. (*L. R.*, 3 *Ch. D.* 552.)

(g) *In re WIRTH'S PATENT.* *L. C.* [1879]

Letters patent might be granted to an alien resident abroad for an invention communicated to him by another alien also resident abroad. (*L. R.*, 12 *Ch. D.* 303.)

**(h) *In re* AVERY'S PATENT.** [1887]

Avery, a subject of the United States, employed an attorney, who in turn appointed one Lindsay to take out a patent in England for Avery's invention. Lindsay took out a patent in his own name for the invention, together with some improvements of his own, without stating in the specification that it or any part of it was communicated from abroad; and made a statutory declaration that he was the true and first inventor. The Court declined to express an opinion whether the patent was or was not void, the case being decided on another ground. (36 *Ch. D.* 307.)

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*Practice—Parties to the Action.*

(i) **BOULTON v. BULL.** N. P. [1795]

When a patentee has assigned part of his patent he may join with his assignee in bringing an action. (2 *H. Bl.* 464.)

(j) **GEORGE v. BEAUMONT.** Ch. [1815]

Damages may be recovered against infringers, not only by the patentees but also by all who have obtained licences from them. Per Lord Eldon, L.C. (27 *Rep. Arts, 2nd Series*, 252.)

(k) **BLOXAM v. ELSEE.** [1827]

The assignees of a bankrupt patentee may maintain an action for infringement of a patent. (6 *B. & C.* 169.)

(l) **DEROSNE v. FAIRIE.** N. P. [1835]

Per Abinger, C.B.: A mere licensee can maintain no action for the infringement of the patent for which he has a licence. (1 *Web. P. C.* 155.)

(m) **WESTHEAD v. KEENE.** [1838]

Where a company had been formed for the purchase of the plaintiff's patent, and no written contract had been signed, and no assignment had been executed by the plaintiff, but the company claimed some equitable interest in the patent, a demurrer to a bill, to which the company had been made defendants, on the ground of misjoinder of parties, was overruled. (1 *Beav.* 287.)

(n) *CHANTER v. LEESE*. Ex. Ch. [1839]

In suing upon an agreement between A., B. and C. of the one part, and D. of the other part, for royalties under an exclusive licence, founded upon a consideration to part of which A., B. and C. were each conducting parties, the action should be brought by all the parties to the agreement of the first part jointly. (1 *H. & H.* 224; affirmed in Ex. Ch., 5 *M. & W.* 698.)

(o) *SPILSBURY v. CLOUGH*. [1842]

When a patentee assigned a third of his patent to A., and then entered a disclaimer, and subsequently assigned the remaining two-thirds of his patent to B., the two assignees, A. and B. may sue for an infringement committed after the date of the disclaimer. (2 *Gale & Dav.* 17.)

(p) *ELECTRIC TELEGRAPH COMPANY v. BRETT*. [1851]

The assignees of a patent may maintain an action for infringement. (10 *C. B.* 838.)

(q) *CALDWELL v. VANVLISSENGEN*. Ch. [1851]

Foreigners coming into this country are subject to actions for injuries done by their infringing on the sole and exclusive right granted by the Crown to patentees of inventions, in conformity with the law and constitution of this country. (9 *Hare*, 415.)

(r) *DENLEY v. BLORE*. N. P. [1851]

The person physically using a patented invention, and not the person giving instructions and plans which include its use, is the party to be sued for an infringement; the contractor, for instance, and not the architect, in the case of a contrivance employed in house-building. (38 *Lon. Jour.* 224.)

(s) *SMITH v. THE LONDON & NORTH WESTERN RAILWAY COMPANY*. [1853]

Where A. and B. are tenants in common of a patent assigned to them, if B. dies, actions for infringements committed in B.'s lifetime survive to A., who is entitled at law to recover the whole damages. (2 *Ell. & B.* 69; 17 *Jur.* 1071.)

(t) *DUNNICLIFF v. MALLETT*. [1859]

It is competent to the assignee of a separate and distinct portion of a patent to sue for an infringement of that part, without joining one who has an interest in another part,—the damages to be recovered in the action accruing to the former alone. (7 *C. B.*, *N. S.* 209; 6 *Jur.*, *N. S.* 252; 29 *L. J.*, *C. P.* 70; 8 *W. R.* 260.)

Erle, C.J., in delivering judgment, said: "The question is, whether an assignment of part of a patent is valid. I incline to think that it is. It is every day's practice, for the sake of economy, to include in one patent several things which are in their nature perfectly distinct and severable. It is also every day's practice by disclaimer to get rid of part of a patent which turns out to be old. Being, therefore, inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no

reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action. (7 *C. B.*, *N. S.* 227.)

(*t*) *DAVENPORT v. RICHARDS.* [1860]

Where one only of several joint-owners of a patent, amongst whom any damages recovered would be divisible is made the plaintiff, the bill, if not demurred to, is sufficient. (3 *L. T. Rep.*, *N. S.* 503.)

(*u*) *WALTON v. LAVATER.* [1860]

The assignee of a patent may maintain an action for an infringement, even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee. (8 *C. B.*, *N. S.* 162; 29 *L. J.*, *C. P.* 275; 6 *Jur.*, *N. S.* 1251; 3 *L. T. Rep.*, *N. S.* 272.)

(*v*) *BETTS v. NEILSON.* [1865]

Where the principals of a firm, which had infringed a patent, were out of the jurisdiction, and not amenable to the process of the court, the court restrained the managers who, though out of the jurisdiction, had appeared to the bill. (6 *N. R.* 221.)

(*w*) *RENARD v. LEVINSTEIN.* Ch. [1865]

An exclusive licensee of a patent has a right to use the name of the patentee in an action for infringement. (2 *H. & M.* 628.)

(*x*) *BETTS v. DE VITRE.* Ch. [1868]

The directors of a company are personally responsible for the infringement of a patent by their workmen, notwithstanding such infringement may be in contravention of orders. (*L. Rep.*, 3 *Ch.* 441; 37 *L. J.*, *Ch.* 325; 16 *W. R.* 529.)

(*y*) *HASSALL v. WRIGHT.* [1870]

The assignee of a patent may maintain a suit against the assignor, and subsequent licensees from the assignor with notice of the assignment, to restrain them from using the patent, although at the time of the institution of the suit the assignment has not been registered. *Seemle*, that registration of the assignment of a patent relates back to the date of the assignment, so as to entitle the assignee to maintain a suit to restrain an infringement instituted between the dates of the assignment and the registration. (*L. R.*, 10 *Eq.* 509; 18 *W. R.* 821.)

(*z*) *ADAMS v. NORTH BRITISH RAILWAY COMPANY.* [1873]

A general agent of the patentees of an American invention agreed with the plaintiff, that the plaintiff was to have the sole agency and control of the working of the patent in England upon certain terms, including a share of royalties and profits:—*Held*, that the plaintiff was a mere agent for the sale of the invention, and was in no such position as gave him the right to file a bill,

which was in the form of a patentee's bill for infringement. (29 *L. T. Rep., N. S.*, 367.)

(a) *SHEEHAN v. GREAT EASTERN RAILWAY COMPANY.* [1880]

One of several co-owners of a patent has a right to sue alone for the recovery of profits due for the use of the patent. An objection, by a defendant, that other persons should have been joined as plaintiffs, should be made promptly, and not postponed to the hearing, when no impediment exists to raising the objection at once. (16 *Ch. D.* 59.)

(b) *BRIGGS v. LARDEUR.* [1884]

In a defence to an action for infringement, the defendants alleged that they had, since action brought, sold their business to a company, and obtained an order at Chambers to add the company as defendants. On appeal, to Pearson, J., the order was discharged. (*Griff.* 55; 2 *O. R.* 13.)

(c) *EDISON AND SWAN v. HOLLAND AND THE JABLOCKHOFF COMPANY.* [1886]

In an action for infringement of a patent for incandescent lamps, the defendants, having shown that the lamps in question had been supplied by the Brush Company, and that, after action commenced, the Jablockhoff Company had obtained an indemnity from the Brush Company, applied for leave to issue a third party notice to the Brush Company:—*Held*, by Bacon, V.-C., that, the notice should issue; and, on an application by the Jablockhoff Company for directions, *Held*, by Kay, J., that the Brush Company, admitting their liability to indemnify, should have liberty to appear at the trial, and should be bound by the decision of the Court on any question as to the indemnity arising between them and the defendants, but no further. (3 *O. R.* 395.)

*Held*, subsequently, that as the third parties had not been made defendants, nor put on terms to submit to any judgment, excepting as stated above, the Court had no power to grant an injunction against them; but, that as they had appeared on the appeal, there was power to make them pay the costs of the appeal. (6 *O. R.* 243.)

(d) *WASHBURN AND MOEN MANUFACTURING COMPANY v. CUNARD STEAMSHIP COMPANY, AND PARKES AND SONS.* [1889]

The plaintiffs, who are patentees, commenced an action against the Cunard Line, to restrain them from dealing with goods in their possession at Liverpool, which were alleged to be infringements of the plaintiffs' patent. The Cunard Company stated, that they were carriers of the goods to Liverpool, under a bill of lading, to the order of Parkes and Sons, of Dublin. Leave was then given to add Parkes and Sons as defendants, and to serve them out of the jurisdiction; and this having been done, Parkes and Sons moved to set aside the service:—*Held*, by Stirling, J., that, the action was properly brought against the Cunard Company; that if Parkes and Sons had been within the jurisdiction, they as consignees, and

(as it turned out) owners, would have been properly added as defendants; and that it followed, that they were parties who might be served out of the jurisdiction. (6 *O. R.* 398.)

(e) *VAN GELDER, APSIMON AND COMPANY v. SOWERBY BRIDGE UNITED DISTRICT FLOUR SOCIETY.* C. A. [1890]

In an action by assignees of a patent, for an injunction and damages for infringement, the defendants took a preliminary objection, that the plaintiffs were not the legal owners of the patent, as they had assigned the patent to mortgagees by a deed duly registered, which gave power to license the use of, or sell the patent, after the mortgagors had made default:—*Held*, by Kekewich, J., that the mortgagors alone could not maintain the action, and, that unless they paid the costs thrown away, and got the mortgagees' consent to be joined as co-plaintiffs, the action must be dismissed. (6 *T. L. R.* 150; 59 *L. J.* 292; 7 *O. R.* 41.) *Held*, by the Court of Appeal, that this judgment must be reversed and that the mortgagor was entitled to sue alone. Liberty was reserved to the defendants to apply to the Court below to have the mortgagees made co-defendants, in case it should appear that the defendants would be subject to any danger from their absence. (*W. N.* 1890, p. 109; 7 *O. R.* 208.)

*Practice—Pleading.*

(f) *KAY v. MARSHALL.* [1836]

It is sufficient for the plaintiff to state on the face of the bill that he has done all that is required by the patent, and it is unnecessary for him to set out the specification. (2 *Web. P. C.* 39; 1 *M. & C.* 373.)

(g) *KAY v. MARSHALL.* M. R. [1836]

Motion for leave to file a double plea. The bill was filed to restrain the infringement of the plaintiff's patent. The defendants disputed the validity of the patent on the grounds that so far as the invention was new it was useless, and that so far as it was useful it was not new. Leave granted. (1 *Keene*, 190.)

(h) *WESTHEAD v. KEENE.* [1838]

A bill filed by a patentee, to restrain the piracy of his patent and for an account, did not distinctly state the specification, or explain the nature of the invention for which the patent right was claimed. The Court (not without some doubt) *Held*, on the authority of *Kay v. Marshall*, that the bill was not demurrable. (1 *Beav.* 287; 2 *Web. P. C.* 36 (n.).)

(i) *CURTIS v. CUTTS.* [1839]

Where a bill is filed to restrain the infringement by the defendant of letters patent, a sufficient case to justify the injunction must be stated by the plaintiff on the face of the bill, and he must not depend solely on the admissions contained in the defendant's answer for the granting or continuing of the injunction. If the



answer deny the invention to be new, and also the enjoyment under the letters patent, and state (as is the fact) that the specification is imperfectly set forth in the bill, the Court will dissolve an injunction previously obtained, on affidavit, giving the plaintiff liberty to bring an action, although the defendant admits by his answer that he has made machines upon the principle comprised in the letters patent. (8 *L. J.*, *Ch.* 184.)

(i) *YOUNG v. WHITE.* [1853]

The fact that a medal has been granted to the plaintiff as the inventor, is not admissible in evidence on the plea that he is not the true and first inventor. (23 *L. J.*, *Ch.* 190.)

(j) *SARAZIN v. HAMEL.* [1863]

Whether, under a bill to restrain the infringement of a patent, it was necessary to allege that the patentee had duly paid the instalments of stamp duties necessary to keep the patent alive, under the 16 & 17 Vict. c. 5, s. 2, *quære.* (32 *Beav.* 145.)

(k) *AMORY v. BROWN.* [1869]

In a bill to restrain an infringement of a patent, an express averment of the novelty of the invention protected by the patent is not necessary. (*L. R.*, 8 *Eq.* 663; 38 *L. J.*, *Ch.* 593.)

Sir W. M. James, V.-C., said: "I was at first struck at the absence of an averment as to the novelty of the invention, and I doubted whether such an averment was not necessary to support a bill in restraint of an infringement of a patent. But on looking at the form of a declaration at law for damages for the infringement, I find that it contains no allegation of the novelty of the invention. The allegation of the grant and production of the letters patent throws upon the defendant the onus of disputing the novelty, and therefore I think the bill sufficient without it." (8 *L. R. Eq.* 664.)

(l) *HOLSTE v. ROBERTSON.* C. A. [1876]

The Court will at any time during the progress of a patent suit allow the defendant to raise a fresh issue on the discovery of facts which could not with due diligence have been discovered before. (*L. R.*, 4 *Ch. D.* 9.)

(m) *LIARDET v. HAMMOND ELECTRIC LIGHT COMPANY.* C. A. [1883]

The plaintiffs had entered into an agreement with the defendant company to sell certain electrical patents to them upon terms, one of which was that the purchasers should be bound to keep the manufacture of the accumulators to which one of the patents related in their own power, and should themselves manufacture the same. In an action for specific performance of the agreement and damages the defendants pleaded that it was an implied term of the agreement that the patents, and more especially the patent as to the accumulators of which the defendants were bound to keep the manufacture in their own power, should be good and valid, and that they were not good or valid:—*Held*, by the Court

of Appeal, that there was no implied warranty in the agreement, that the patents were valid, and that the plea must be struck out as embarrassing. (31 *W. R.* 710.)

(n) *UNITED TELEPHONE COMPANY v. MOTTISHEAD.* [1886]

The defendants denied the validity of the patent and denied infringement, and moved for an order that the issue as to infringement be tried first. Kay, J., said that unless the defendants admitted the validity of the patent this could not be done. (*Griff.* 230; 3 *O. R.* 213.)

(o) *EDISON ELECTRIC LIGHT COMPANY v. SHIPPEY.* [1887]

The defendant by his statement of defence had admitted the plaintiffs' title and the validity of the respective patents, but denied infringement. At the trial the defendant, who appeared in person, applied for leave to amend his defence by putting in issue the validity of one of the patents and the title of the plaintiffs thereto. Leave refused. (4 *O. R.* 471.)

(p) *UNITED TELEPHONE COMPANY v. TASKER.* [1888]

In 1884 the plaintiffs brought an action against the defendants for infringement, but in consequence of evidence given on behalf of the defendants on interlocutory proceedings discontinued it. In 1888 the plaintiffs issued a writ for the same object. The statement of claim in this new action contained an allegation that since discontinuing the former action the plaintiffs had found that the defendant's evidence, which led to its discontinuance, was false, and in a subsequent paragraph a claim, not on the writ, that this action might be treated as supplemental to the previous action. Both these paragraphs were ordered to be struck out. (*W. N.* 1888, 222.)

(q) *BADISCHE ANILIN UND SODA FABRIK v. DAWSON.* [1889]

In an action for infringement the defendant set up in his defence that colouring matter stated to be an infringement was purchased from persons with whom the plaintiffs have agreed not to take proceedings in respect of the said goods. It was proved that the defendant sold the product in question:—*Held*, that the onus was on him to prove this plea, and as he called no witnesses judgment was given against him. (6 *O. R.* 387.)

(r) *PHILIPS v. THE IVEL CYCLE COMPANY.* [1890]

Kekewich, J. (referring to the distinction drawn in *Holliday v. Heppenstall* between evidence to prove anticipation and evidence to prove prior common knowledge): "It would probably be necessary for those who draw pleadings and particulars of objection, which are part of the pleadings in patent cases, to consider whether some improvement of the common form is not now required. The common form, which is adopted in these cases, is to deny novelty—i.e., to allege in the particulars of objection that the said alleged invention was not new at the date of the said patent. It occurs to me that that has hitherto been under-

stood as being very little more than introductory to what invariably follows: some statement of the different publications which are relied upon as anticipation. I think there are some words to be found in the case to which I have referred supporting the notion, and certainly it is a notion to my mind well founded, that if the defendant intends to depend for resistance to the plaintiff's claim upon common knowledge as distinguished from anticipation, it will be found convenient, if not necessary, to plead that distinctly." (7 O. R. 77, at p. 82.)

Every effort should be made in a patent action to confine the pleadings to the real points at issue. Accordingly where the defendants had denied infringement with the view of compelling the plaintiff to explain how they had infringed, they were not allowed any costs of that issue. (*Ib.* 85.)

(s) LAW v. ASHWORTH. [1890]

In an action to restrain threats made by patentees, the plaintiffs in their statement of claim alleged the invalidity of the defendants' patent, and delivered particulars of objection. The defendants applied before putting in their defence for further and better particulars (a) of the alleged threats; (b) of the objections to the patent:—*Held* (a) that they were entitled before defence to particulars of the alleged threats, but not to the names of customers whom the plaintiffs had in consequence thereof promised to indemnify; (b) that the patent being for a machine, the particular machine or part of a machine alleged to be an anticipation must be pointed out. (7 O. R. 86.)

(s<sup>1</sup>) MACDOUGALL BROTHERS v. PARTINGTON. C. A. [1890]

In an action on a contract relating to a patent the plaintiff limited his claim to relief in respect of that contract, but the defendant included in his pleas the ordinary defences to an action for infringement:—*Held*, that the latter must be struck out as embarrassing. (7 O. R. 216.)

### *Practice—Consolidation of Actions.*

(t) DILLY v. DOIG. [1794]

Loughborough, L.C.: "I do not remember any case upon patent rights, in which a number of people have been brought before the Court as parties, acting all separately upon distinct grounds; it has always been against a particular defendant." (2 Ves. jun. 487.)

(u) FOXWELL v. WEBSTER. [1863]

One hundred and thirty-four suits were instituted against as many defendants by a patentee for infringement of his patent, and interrogatories were served. Seventy-seven defendants, combining together amongst themselves so as to make four bodies in all, moved, before putting in any answer, that the plaintiff might be directed to proceed with one suit only until it should have been determined, or until the validity of the patent should have been

finally determined, or until further order; and that the proceedings in the other suits might in the meantime be stayed, or that the time for answering and producing documents might be enlarged, the moving defendants undertaking to be bound by the result of the selected suit so far as the question of the validity of the patent was concerned. The Court, upon terms, and the plaintiff not opposing, made an order with a view of trying before itself the question of validity in the first instance, before entering upon the question of infringement. (4 *De G., J. & S.* 77.)

(v) *BOVILL v. CRATE.* [1865]

Wood, V.-C.: "After getting information of case after case of infringement, the plaintiff might select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others who were *in simili casu*, and say to them: 'Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you will not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind?' I do not think any Court could complain of a patentee for taking the course I am suggesting." (*L. R.*, 1 *Eq.* 391.)

(w) *THOMAS v. WINTER.* [1867]

The defendant was one of twenty-six against whom the plaintiff brought separate actions for infringement of the patent of a sewing-machine. A consolidation order was made by consent, and the plaintiff was authorized to select one action for trial, the defendants undertaking to be bound and concluded by the result of that action. Provision was made by the order for security for plaintiff's costs in case of an appeal. In the case selected by the plaintiff the decision both at the trial and in banc were in favour of the plaintiff, and the defendant neglected to prosecute an appeal to the Exchequer Chamber:—*Held*, upon application by the present defendant, who was not in the action tried, to be allowed to carry the case decided to a superior Court,—that the fact of the neglect to appeal was not sufficient ground for the Court's exercising its equitable jurisdiction, in amending or revoking the consolidation order. (17 *L. T. Rep.*, N. S., 148.)

#### *Practice—Particulars of Breaches.*

PATENTS ACT, 1883, sect. 29 (1). In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the Judge, at any subsequent time, particulars of the breaches complained of.

Sub-sect. [6]. On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

[For the remaining sub-sections, see p. 299.]

(x) *PERRY v. MITCHELL.* [1840]

The Court has power, irrespective of any statute to that effect, to order the plaintiff, in an action for the infringement of a patent, to deliver particulars in writing of the infringements on which it is intended to rely. (1 *Web. P. C.* 269.)

Patent for the manufacture of improved pens. The specification described thirteen different kinds of improvements, referring to them by numbers. The Court ordered the plaintiff to give the defendant particulars by the number of the pen on which infringements were alleged. (*Ib.*)

(y) *THE ELECTRIC TELEGRAPH COMPANY v. NOTT.* [1847]

In an action for infringing a patent, the Court has a general power to order a particular of the alleged infringement. But, where the specification claimed a combination of numerous improvements (in electric telegraphs), the Court refused to compel the plaintiffs to give the defendants such particulars, conceiving that from the nature of the patent, the plaintiffs would be thereby put to great difficulty and embarrassment, and that, under the circumstances (the matter having been debated in Chancery upon a motion for an injunction), the defendants must be taken to possess adequate information upon the subject. (4 *C. B.* 462; 16 *L. J.*, *C. P.* 174.)

(z) *TALBOT v. LA ROCHE.* [1854]

In an action for infringement of a patent for "improvements in obtaining pictures or representations of objects," the court refused to compel the plaintiff in his particulars of breaches to specify particularly the persons and occasions, or the particular parts of the specification alleged to have been infringed, although the declaration merely averred an infringement in general terms. (15 *C. B.* 310; 2 *C. L. Rep.* 836.)

Jervis, C.J.: "If the two processes described in the specification are wholly distinct from each other, and the defendant's process may be an infringement of the one and not of the other, he ought to have better particulars. But, if the whole is substantially one process, he is not entitled to them. . . . We must not make the particulars more complicated than the specification." (*Ib.* 320.)

(a) *JONES v. LEES.* [1856]

In an action by a patentee against his licensee on a covenant to pay for roving machines made with the plaintiff's invention, and to make none without,—breach, first, in not paying for roving machines made with the invention; and, secondly, in making machines without it; the defendant having, in answer to interrogatories, admitted the making of many hundreds of roving machines, but not with the plaintiff's invention, and having declared that he could not state to whom they were sold, nor give any further information about them, without disclosing

his own evidence; and the plaintiff claiming in respect of all the machines the defendant had made, under one or other of the covenants, and asserting that he had seen some of them which had his invention applied :—*Held*, that the defendant was entitled to such particulars as should describe those portions of the machines to which the plaintiff contended that his invention had been applied, so as to enable the defendant to understand, as far as possible, the nature of the machines as to which he was to be charged under either of the covenants, and that it was no answer to the application for such particulars that the defendant's answer to the interrogatories was insufficient to enable the plaintiff to furnish the particulars, for if the answers were insufficient, they should have been objected to. (25 *L. J.*, *Exch.* 241.)

(b) *THE PATENT TYPE FOUNDRY COMPANY v. RICHARDS.* [1860]

Upon an order for the delivery of further particulars of breaches, the plaintiffs enumerated certain instances, and added, "and the plaintiffs state these particular instances by way of example only, and not so as to preclude them from proving any of the infringements mentioned in the former particulars of breaches :"—*Held*, that this clause should be struck out of the particulars. (2 *L. T. Rep.*, *N. S.* 359.)

(c) *NEEDHAM v. OXLEY.* Ch. [1863]

Particulars of breaches delivered with view to a jury trial of a patent case in this Court are sufficient, if, taken together with the pleadings, they give the defendant full and fair notice of the case to be made against him. (1 *H. & M.* 248.)

Sir W. Page Wood, V.-C., said: "The object of having these particulars delivered is to give the defendant fair notice of what the complaint against him is, not to tie the plaintiffs down to the precise terms of any verbal definition, or to make the trial of the issue turn upon a point of form." (*Ib.* 51.)

(d) *CURTIS v. PLATT.* H. L. [1866]

The plaintiffs are bound by the particulars of breaches delivered. (35 *L. J.*, *Ch.* 852.)

(e) *WREN v. WELLD.* [1869]

The plaintiffs carried on the business of machine makers, and in their business sold machines to certain persons. The defendant wrote letters and made verbal statements to such persons, alleging that the machines so sold were infringements of a patent which he had obtained for such machines, and making claims in respect of such alleged infringement and the use of the machines.

An action having been brought by the plaintiffs in respect of the injury caused by these letters and statements, the defendant pleaded not guilty,

The Court ordered him to deliver particulars to the plaintiffs, showing in what part or parts the machines of the plaintiffs mentioned in the declaration were an infringement of the

defendant's patents, and pointing out by reference to line and page of his specifications what part of the inventions therein described he alleged to have been infringed. (*L. R.*, 4 *Q. B.* 213; 38 *L. J.*, *Q. B.* 88; 20 *L. T. Rep. N. S.* 277.)

(f) *BATLEY v. KYNOCK.* [1874]

Although, upon the trial of questions in a patent suit, the plaintiff's particulars of breaches should give the defendant full, fair and distinct notice of the case intended to be made against him, it is not necessary, in the case of an alleged infringement of a patent for improvements in a particular article (*e.g.*, cartridges), for the particulars to point out the precise portions of the specification alleged to have been infringed when the thing alleged to be an infringement has been made an exhibit. (*L. R.*, 19 *Eq.* 229.)

(g) *FINNEGAN v. JAMES.* [1874]

The practice in equity ought in patent suits as nearly as possible to conform to the practice at common law, and the plaintiff ought to state the particulars of breaches, either in his bill or in a separate document delivered with it. (*L. R.*, 19 *Eq.* 72; 44 *L. J. Ch.* 185.)

(g\*) *LAMB v. NOTTINGHAM MANUFACTURING COMPANY.* [1874]

The form of order used in this case for delivery of further particulars of breaches is set out. (Seton on Decrees, Ed. 4, p. 349.)

(h) *ADAIR v. YOUNG.* V.-C. B. [1879]

Where, in an action to restrain the infringement of a patent, the defendants do not confine themselves to meeting the case opened by the plaintiff, but open and call evidence to prove an entirely different case, the plaintiff is entitled to call evidence in reply; and, notwithstanding the 41st sect. of 15 & 16 Vict. c. 83, to give instances of infringement not included in his particulars of breaches delivered in the action. (*W. N.* 1879, p. 8.)

(i) *SYKES v. HOWARTH.* Fry, J. [1879]

The plaintiff in his particulars of breaches alleged that the defendant had at divers times infringed the patent by the manufacture, sale and use of the patented machine, and particularly in the cases of S. and S. The defendant having admitted, in answer to interrogatories, manufacture for and sale to H., and the defendant not having applied for amended particulars according to the case of *Hull v. Bollard* (25 *L. J.*, *Ex.* 304):—*Held*, that evidence of the transactions with H. tendered by the plaintiff must be received. (*L. R.*, 12 *Ch. D.* 826.)

Fry, J.: "I find the case of *Hirst* is within the literal meaning of the particulars. If I had found that the case of *Hirst* was likely to create surprise, or likely to introduce any point not raised by *Smith's* or *Shaw's* case, I should probably have given an opportunity to the defendant to bring any fresh evidence." (*Ib.* 830.)

(j) UNITED TELEPHONE COMPANY *v.* HARRISON, COX, WALKER & CO. [1882]

Where at the trial of an action for infringement, the Court is of opinion that there has been an infringement, but holds on a legal ground that the patent is void, it will not give the plaintiff a certificate under sect. 43 of the Patent Act of 1852, that breaches of the patent by the defendant have been proved. (21 *Ch. D.* 720; 51 *L. J. Ch.* 705.)

(k) TILGHMAN'S SAND BLAST COMPANY *v.* WRIGHT. [1884]

On a summons for better particulars of breaches, Pearson, J., gave the plaintiffs leave to add general words, as in *Talbot v. Laroche*, when they gave an exhibit, and said they did not mean to confine themselves to that; and that was considered sufficient. The case of the Patent Type Founding Company against Richards was different, because in that case the defendants were manufacturers. (*Griff.* 216; 1 *O. R.* 103.)

(l) RUSSELL *v.* HATFIELD. [1885]

The chief clerk having made an order for better particulars of breaches, the plaintiff appealed, and Pearson, J., said that as the defendant had full knowledge of all his own sales, the application should stand over until he had given the plaintiff discovery, and it being pointed out that the plaintiff had not applied for discovery, the defendant was given liberty to apply. (*Griff.* 204; 2 *O. R.* 144.)

(l\*) BADISCHE ANILIN UND SODA FABRIK *v.* LEVINSTEIN. C. A. [1885]

Although holding the patent invalid, the Court gave the plaintiffs the costs occasioned by the issues raised by the particulars of breaches. (29 *Ch. D.* 418.)

(m) LEDGARD *v.* BULL. P. C. [1886]

The sole object of sect. 34 of the Indian Act, corresponding to sect. 41 of the English Patent Act of 1857, is to give the defendant fair notice of the case he has to meet; and it is quite immaterial whether the information be given in the plaint or in a separate paper. Under a plea of want of novelty, the Court requires the particulars to condescend upon the particular instances, the matter there not being within the knowledge of the patentee. But it is otherwise in particulars of breaches, for the defendant must know whether and in what respects he has been guilty of infringement. The plaintiff in this case pointed out a particular kiln, constructed and used by the defendant, and in his plaint referred to his three patents, and indicated in the case of each the distinctive features alleged to have been appropriated by such construction and use. *Held*, to be sufficient particulars of breaches. (11 *App. C.*, 648: *sub. nom.*, *Petman v. Bull*, 3 *O. R.* 390.)

(n) UNITED TELEPHONE COMPANY *v.* FLEMING. [1886]

The particulars of breaches were so worded as to cover two



valve telephones, supplied by third parties under a guarantee of indemnity. The third parties submitted that they were perfectly willing to defend these valve telephones, and ultimately the plaintiffs amended their particulars so as to exclude them, and the third parties were discharged from the action. (3 O. R., 268.)

(o) *ELSEY v. BUTLER.* [1886]

The plaintiff delivered particulars of breaches, alleging that the defendant had infringed by the production in a twist lace machine of lace fabrics in the manner described in the specification, p. 3, l. 22 to p. 9, l. 39, or in a manner only colourably differing therefrom; and by the use of the improved combination of apparatus therein described, and also in particular by the production in a twist lace machine, of fabric known as double tie Swiss net, in the manner described in the specification, p. 6. l. 57, to p. 7. l. 38, or in a manner only colourably differing therefrom. A summons for further and better particulars, or for leave to administer interrogatories, was dismissed. (*Griff.* 96; 1 O. R. 189.)

(p) *WALTER C. CHURCH ENGINEERING COMPANY v. WILSON.* (1886)

The plaintiffs said that they complained, "in particular and by way of illustration of the following" specified sales, and an application for better particulars was dismissed. Grove, J.: "I have seldom got much information from particulars of objections or particulars of breaches." (*Griff.* 236; 3 O. R. 123, at p. 126.)

(q) *CHEETHAM v. OLDHAM.* [1888]

When the invention is not difficult to describe, and the claims in the specification are short and defined, it is enough in the particulars of breaches to refer to the claims alleged to have been infringed, and references by page and line need not be given. (5 O. R. 624.)

*Practice—Particulars of Objections.*

PATENTS ACT, 1883, Sect. 29, Sub-s. (2) The defendant must deliver with his statement of defence, or by order of the Court or a Judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

(3) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty must state the time and place of the previous publication or user alleged by him.

(4) At the hearing no evidence shall, except by leave of the Court or a Judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5) Particulars delivered may be from time to time amended, by leave of the Court or a Judge.

(6) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

*Particulars of Objections, generally.*

(r) *BULNOIS v. MACKENZIE*. [1837]

In actions for infringing a patent, the notice of objection delivered by the defendant under 5 & 6 Will. 4, c. 83, s. 5, is not conclusive at his peril; but the court, under its general jurisdiction, may model its proceedings and order a fuller and further notice. The jurisdiction of the Court as to these questions is analogous to that of set off. It is for the Court to decide upon the sufficiency of the notice; this power is not created by the statute. (1 *Web. P. C.* 260; 4 *Bing. N. C.* 127.)

The notice of objections is meant to afford more specific information than the pleas. (1 *Web. P. C.* 263.)

(s) *FISHER v. DEWICK*. [1838]

Application to the Court for an amended notice of objections. Tindal, C.J., in delivering judgment, said: "The object of the statute (5 & 6 Will. 4, c. 83) was not, indeed, to limit the defence, but to limit the expense to the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence. Under the fifth section, therefore, it was intended that the defendant should give an honest statement of the objections on which he means to rely. . . . If he (the defendant) would, in the Scotch phrase, condescend upon the parts to which he objects there would be an end to the difficulty." (1 *Web. P. C.* 267.)

Coltman, J. "The defendant is not precluded from bringing forward any number of objections, but he must state with precision what they are."

(t) *LOSH v. HAGUE*. [1838]

The defendant had omitted, on pleading, to give to the plaintiff a notice of any objections on which he meant to rely at the trial, and a summons was subsequently taken out before a judge at chambers for leave to deliver such notice *nunc pro tunc*.

This summons being opposed, on the ground that a judge had not the power to grant the application, the word "other" in the section showing conclusively that unless some objections, one at least, had been given in, the authority under the statute could not be exercised, the matter came before the Court.

Parke, B.: "The Court has power to grant the defendant leave to plead *de novo*. Therefore, let the pleas already pleaded be considered as if pleaded *de novo*, and let the objections be then added, and considered as if delivered along with the pleas." (1 *Web. P. C.* 203 (n).)

Abinger, C. B., in addressing the jury at the trial at *nisi prius*, said: "I never conceived those objections were intended to be urged before the jury; I thought they were merely to apprise the plaintiff of what he was to be prepared to meet." (1 *Web. P. C.* 203 (n).)

## (u) GILLET v. WILBY. N. P. [1839]

It is not sufficient to state an objection in a notice of objections unless there be a plea to which it can be applied. (1 *Web. P. C.* 270.)

## (v) NEILSON v. HARFORD. [1841]

If the objections are not sufficiently specific, the plaintiff's course is to apply to a judge at chambers for an order for the delivery of a more specific notice; but if he omits to do so, he cannot object to the generality of the notice at the trial: the only question then is, whether the notice is sufficiently large to include the objections relied on by the defendant. (8 *M. & W.* 806; 1 *Web. P. C.* 331.)

Parke, B., delivering the judgment of the Court, said: "The Act (5 & 6 Will. 4, c. 83, s. 5) must be construed to mean that a mere copy of the pleas will not be a sufficient compliance with its provisions. It was passed after the new rules had required the several defences to be pleaded, and must, therefore, be considered as having intended to give to a plaintiff some additional advantage beyond the information which the record would give him. But that did not mean to say, nor do we think the Common Pleas meant to decide, that it would not be sufficient in some cases to give notice in the terms of the plea itself; the objection may be so completely and so fully expanded on the record, that a mere transcript of the plea itself may be sufficient; in other cases the plea may be so general in its language as to be insufficient as a notice, if transcribed from the plea merely. Each case must depend on its peculiar circumstances." (1 *Web. P. C.* 370.)

## (w) WALTON v. BATEMAN. N. P. [1842]

The notice of objections should be drawn with reference to the pleas, or notice given of the pleas to which the objections are to be applied. (1 *Web. P. C.* 616.)

## (x) MACNAMARA v. HULSE. N. P. [1842]

Lord Abinger, C.B.: "Whatever objections the defendants may have given you notice of, they cannot go beyond their pleas. I apprehend that the statute (5 & 6 Will. 4, c. 83) does not make the notice of objections stand in the place of pleas." (2 *Web. P. C.* 128 (n).)

## (y) RUSSELL v. LEDSAM. [1843]

To an action for infringement it was pleaded that the report of the Judicial Committee of the Privy Council and the letters patent thereupon were procured by fraud and misrepresentation! —*Held*, that the notice of objections delivered under 5 & 6 Will. 4, c. 83, s. 5, ought to state the species of fraud or misrepresentation relied on. (11 *M. & W.* 647.)

## (z) JONES v. BERGER. [1843]

The notice of objections must point out the defence with

greater particularity than the record. The Court will see that the objection is stated with reasonable particularity, according to the circumstances of the case. (1 *Web. P. C.* 544; 5 *M. & G.* 208.)

(a) *R. v. MILL. Sci. fac.* [1850]

The notice of objections is not part and parcel of the record, so as to be incorporated with the issues raised, and show that those specific objections are in issue. (1 *L. M. & P.* 695; 10 *C. B.* 379.)

(b) *BETTS v. WALKER.* [1850]

In an action for infringing a patent, if the defendant's notice of objections under stat. 5 & 6 Will. 4, c. 83, s. 5, is too general to give such information as the plaintiff is entitled to, it is no answer to a motion for better notice that the notice is as specific as the pleas. (14 *Q. B.* 363.)

(c) *HULL v. BOLLARD.* [1856]

In an action for the infringement of a patent, if the particulars of objections, delivered with the pleas pursuant to the 15 & 16 Vict. c. 83, s. 41, are too general, the party who means to object to them must procure an order for better particulars. (1 *H. & N.* 134; 25 *L. J. Exch.* 304.)

(d) *CHOLLET v. HOFFMAN.* [1857]

The requirements of the statutes 5 & 6 Will. 4, c. 83, and 15 & 16 Vict. c. 83, as to the notices by the defendant, are confined to notices affecting the validity of the patent; and the defendant may, therefore, object to the want of registration of an assignment of the patent to the plaintiff, although it is not specially mentioned in his notices of objections. (7 *Ell. & Bl.* 686; 26 *L. J., Q. B.* 249.)

(e) *CURTIS v. PLATT.* [1863]

The principle upon which the Court proceeds in regulating the form of particulars of objections on the trial of a patent case, is to guard against a surprise upon a plaintiff by production on the trial of evidence of prior user or publication of which he has no notice. Therefore it will require the defendant, in stating those instances on which he intends to rely, to put the plaintiff in possession of all he himself knows, so far as to enable him to identify the instances alleged. (8 *L. T. Rep., N. S.* 657.)

(f) *RENARD v. LEVINSTEIN.* [1864]

On the trial of a suit in equity to restrain the infringement of a patent, the Court, sitting without a jury, will not use the same strictness in matters of pleading as would be necessary in a trial before a jury; but will follow that course of procedure which it deems best in order to diminish the expense, and hasten the determination of the suit. Therefore, although a defendant gave

no notice of objection to the patent on the ground of prior publication up to the time of proving the cause, and only gave notice of such objection after the plaintiff's case was closed and the defendant's had been opened, the Court then allowed a motion by the latter to amend his particulars of objection by an allegation of prior publication in a given document. Costs of motion and extra costs thereby incurred to be paid by the defendant in any event. (11 *L. T. Rep.*, *N. S.* 505; 13 *W. R.* 229.)

(g) *DAW v. ELEY*. [1865]

The defendant will not be allowed, in the course of the hearing before the Court without a jury, to introduce evidence of a prior user not disclosed by the particulars of objection, although such evidence may have only come to his knowledge since the delivery of the particulars of objection. *Semble*, that the Court will give the defendant leave, on short notice of motion, to amend his particulars of objection, so as to introduce such newly discovered evidence. (*L. R.*, 1 *Eq.* 38.)

(h) *BOVILL v. GOODIER*. [1865]

The defendant will not be required to deliver particulars of his objections to the patent, where replication has been filed and the Court has refused to direct issues. (*L. R.*, 1 *Eq.* 35; 35 *L. J.*, *Ch.* 174; 35 *Beav.* 264. But see *Finnegan v. James*, *L. R.* 19 *Eq.* 72.)

(i) *DAW v. ELEY*. [1865]

A plaintiff in a patent case, where the novelty of the invention is denied by the answer, has no right to a discovery of the particulars on which the defendant relies as showing a user of the thing patented prior to the date of the patent. (2 *Hem. & M.* 725.)

(j) *MORGAN v. FULLER*. [1866]

In a suit to restrain the infringement of a patent for improvements in the construction of carriages, the alleged invention consisting of a particular mode of opening and closing the heads of carriages, particulars of objections stating that head-joints similar to those used in the plaintiff's alleged invention had been, before the date of the patent, commonly used *by carriage builders generally throughout Great Britain*, and that head-joints, similar to those described in the specification, had been actuated in their motions in the way described, before the date of the patent, *by various carriage builders in or near London, Liverpool, Manchester and Southampton, and various other of the principal towns of Great Britain*, were held insufficient.

*Semble*, that where the objection points to the public use of a particular preparation, the words "by various makers in or near London," might be sufficient.

*Semble* also, if the defendant could not give the names of the carriage builders *in or near London, &c.*, he would be required to specify the class or classes of carriages with respect to which the

alleged prior user had taken place, and that might have been held sufficient. (*L. R.*, 2 *Eq.* 297.)

(*k*) *BOVILL v. SMITH.* [1866]

In a suit to restrain an infringement of a patent which is contested on the ground of anticipation by prior use, the plaintiff is not entitled to discovery from the defendant in answer to a general interrogatory as to the instances of prior user on which he relies. (*L. R.*, 2 *Eq.* 459.)

(*l*) *PENN v. BIBBY.* [1866]

Particulars of objections filed by a defendant were ordered to be amended by the insertion of words specifying "the persons by whom, the places where, the dates at, and the manner in which," there had been the alleged user prior to the date of the plaintiff's patent.

In complying with this order, the defendant was permitted, in his amended particulars, to preface his statement of the specific instances of alleged prior user with the words "amongst other instances," in order to give him an opportunity of applying for leave to re-amend by inserting any further instances of prior user which he might discover. (*L. R.*, 1 *Eq.* 548.)

(*m*) *BOVILL v. GOODIER.* [1867]

The object in directing issues to be tried at law is to ascertain the real state of the facts: and therefore the Court in a patent case will allow further particulars of prior user of the invention to be brought forward on proper notice. (36 *L. J.*, *Ch.* 360.)

(*n*) *FINNEGAN v. JAMES.* [1874]

A plaintiff in a patent suit ought either to state in his bill the particulars of the breaches complained of, or to deliver along with his bill a written statement of such particulars, which statement need not be filed. A defendant in a patent suit ought to set forth in his answers the particulars of any objections on which he relies. (*L. R.*, 19 *Eq.* 72; 44 *L. J.*, *Eq.* 185.)

(*o*) *FLOWER v. LLOYD.* C. A. [1876]

In a patent suit the form of order requiring the defendant to furnish further and better particulars of objections should follow the words of sect. 41 of the Patent Law Amendment Act, 1852, but under such order the defendant must furnish full and sufficient particulars. (45 *L. J.*, *Ch.* 746.)

Under such an order the defendants delivered an amended notice of objections that the process had been used by three persons whose names and addresses they gave, and by other persons in Birmingham and London. Field, J., said: "If defendants knew that their processes have been used by other persons in London and Birmingham besides those specified, they must know the persons by whom they have been used, and must give more specific informa-

tion. I do not say that they need give the name and address of every such person, but they must give fair information." (20 *Sol. J.* 860.)

(p) BAIRD *v.* MOULE'S PATENT EARTH CLOSET COMPANY. [1876]  
AND AVELING *v.* McLAREN. [1880]

Forms of orders made giving defendants leave to amend their particulars of objections to the validity of the plaintiff's patent, and providing for the plaintiff to have time to elect whether he would discontinue and for the costs. (17 *Ch. D.*, 139( *n.* ).)

(q) EDISON TELEPHONE COMPANY *v.* INDIA RUBBER COMPANY. [1881]

In granting the defendant in a patent action after issue has been joined, and a day fixed for the hearing, leave to amend his particulars of objection, the Court will place the plaintiff in the same position as to discontinuing the action or disclaiming a portion of his invention as he would have been in if the original particulars had contained the proposed amendments. (17 *Ch. D.*, 137.)

(r) CROPPER *v.* SMITH. H. L. [1885]

A patentee having gone into liquidation his trustee assigned the patent. The patentee afterwards went into a trade partnership with S. The assignees brought an action against the patentee and S. for an injunction and damages for infringement committed by the partnership. The defendants having obtained leave to be treated as having severed in their defence delivered particulars of objections which commenced thus: "Take notice that at the trial of this action the defendants will deny that they have infringed the letters patent in the statement of claim, and the defendant S. will rely on their objections to the validity, &c." *Held*, reversing the decision of the Court of Appeal, that under 15 & 16 Vict. c. 83, s. 41, it was not necessary for every one of two or more defendants defending in the same interest to deliver particulars of objections, and that the patentee was not precluded from setting up at the trial the invalidity of the patent on the ground of want of novelty and insufficiency of the specifications. (10 *App. Cas.* 249.)

(s) MOSS *v.* MALINGS. [1886]

During the trial the defendant asked to be allowed to apply for a postponement and leave to amend his particulars of objections on the ground that since the cross-examination of the plaintiff he had discovered some new facts which showed want of novelty. The application was refused on the ground that defendant had not shown that he could not with reasonable diligence have discovered the new facts sooner. (33 *Ch. D.* 603; 35 *W. R.* 165.)

(t) EERLICH *v.* IHLEE. [1886]

In granting the defendant leave to amend his particulars of objections, the Court will impose such terms as will place the plaintiff in the same position as if the particulars as amended had been delivered with the defence, even if the plaintiff was aware of

the alleged anticipation before the action was brought. (56 *L. T.* 819.)

(u) *UNION ELECTRICAL POWER AND LIGHT COMPANY v. ELECTRICAL STORAGE COMPANY.* C. A. [1888]

The defendants threatened the plaintiffs' customers with proceedings for infringement of any of their patents for electric accumulators. The plaintiffs asked for an injunction to restrain such threats, and alleged that all the patents were bad. The defendants applied for particulars of objections. Ordered, that on the defendants giving a list of the patents on which they intended to rely, the plaintiffs should within three weeks deliver particulars of objections to the validity of those patents. (38 *Ch. D.* 325.)

(v) *BRITAIN v. HIRSCH.* C. A. [1888]

Sect. 29, sub-sect. (4) gives the Court at the trial a discretion to allow evidence beyond the particulars of objections independently of the power of amendment under sect. 29, sub-sect. (5). (5 *O. R.* 226.)

(w) *PARKER v. MAIGNEN'S FILTRE RAPIDE COMPANY.* [1888]

Leave to amend particulars of objections on eve of trial given on terms. (5 *O. R.* 207.)

(x) *DARRAH v. PURSER.* [1889]

Leave to amend particulars of objections was given to the defendant by Bristowe, V.-C., and the order was drawn up as in *Edison v. India Rubber Company.* (6 *O. R.* 365.)

(y) *LAW v. ASHWORTH.* [1890]

The particular machine or part of a machine alleged to be an anticipation must be pointed out. (7 *O. R.* 86.)

(z) *SMITH v. LANG.* C. A. [1890]

In an action to restrain threats, and for a declaration that the patent (which was for improvements in the construction of wire ropes) was invalid, the plaintiff alleged that the invention was previously published by the manufacture, sale, use, or public exhibition of wire ropes made by W. from the year 1832 to 1862: — *Held*, that this was too vague, and that further and better particulars ought to be given. (7 *O. R.* 148.)

(a) *PASCALL v. TOOPE.* [1890]

At the trial the defendant's witnesses gave evidence of instances of prior user which were different from those set out in his particulars. At the plaintiff's request Kay, J., adjourned the case for three weeks, to give him an opportunity of meeting those instances, but declined to make an order such as that made in *Edison v. India Rubber Company* (*sup.* 305 (q)). (7 *O. R.* 125.)



*As to true and first Inventor.*

(y) FISHER v. DEWICK. [1838]

On the delivery of amended particulars pursuant to an order of the Court, a summons for further amended particulars was taken out and heard before the Lord Chief Justice Tindal at chambers. His Lordship, after time taken to consider, made the following alteration: The words "that the plaintiff was not in possession of the said alleged improvements before or at the date of the letters patent," were struck out of the objection, that the plaintiff was not the true and first inventor of the whole or of any part of the said improvements. (1 *Web. P. C.* 551 (n).)

(z) RUSSELL v. LEDSAM. [1843]

To an action for the infringement of a patent, the defendant pleaded: That the patentee was not the true and first inventor: *Held*, that the notice of objections delivered under 5 & 6 Will. 4, c. 83, s. 5, need not state *who* the first inventor was, or under what circumstances the invention had been previously used. (11 *M. & W.* 647; 12 *L. J., Exch.* 439.)

Parke, B., in delivering the judgment of the Court, said: "The principal point discussed was, whether or no it was necessary in an objection on the ground that the patentee was not the first inventor, or that the invention was not new, that the defendant should state who was the first inventor, or when, and in what place and under what circumstances it was used before. This point is not new, for it has been already before this Court and also before the Court of Common Pleas, in the case of *Bulnois v. Mackenzie*. In that case the Court of Common Pleas would not require those particulars to be given, and their example has been followed by this Court in the case of *Heath v. Unwin*. In the subsequent case, however, of *Jones v. Berger*, the Court of Common Pleas deviated from their former decision in *Bulnois v. Mackenzie*, and compelled the defendant to give the name of the first inventor. On consideration of the matter, however, we think that we ought to abide by the cases of *Heath v. Unwin* and *Bulnois v. Mackenzie*, and that no particulars of the circumstances under which this invention may have been previously used should be required from the defendant; and we are fortified in this view by the decision of the Court of Queen's Bench in the case of *Reg. v. Walton*, in which they adopted the same view. That was originally an application to the Master of the Rolls, which afterwards came before the Court of Queen's Bench, which we find, on inquiry, to have determined this point the same way." (11 *M. & W.* 651.)

*As to prior User.*

(a) BULNOIS v. MACKENZIE. [1837]

It is doubtful whether under the words (5th section of 5 & 6 Will. 4, c. 83) "notice of objection" the Court can require a defendant to furnish the names of those who are alleged to

have used the plaintiff's invention. Application refused on the ground that it might prejudice the defendant. (4 *Bing. N. C.* 132.)

(b) *FISHER v. DEWICK.* [1838]

An objection stated that "a particular improvement had been used by A. B., &c. (giving names and addresses), and divers other people within this kingdom and elsewhere;" the judge at chambers struck out the words "and divers other people," adding that "if the defendant discover other persons not named in the objections, he has the power of applying to a judge to add such persons." (1 *Web. P. C.* 551 (n).)

(c) *GALLOWAY v. BLEADEN.* [1839]

Coltman, J., ordered names, addresses, and descriptions to be given, and the words "divers other persons" to be struck out. (1 *Web. P. C.* 268 (n).)

(d) *CARPENTER v. WALKER.*

The objection stated the making of locks similar to the subject of the patent by the defendant and others, several years before the date of the letters patent, and their sale to divers persons, and among others to one S. T., of, &c. On summons to strike out the words "to divers persons, and among others," or to state the names and descriptions of the others besides S. T., to whom sales were made, the parties were referred to the Court, who refused the application. (1 *Web. P. C.* 268 (n).)

(e) *REG. v. WALTON. Sci. fac.* [1842]

On *sci. fac.* to repeal a patent, the prosecutor having, while the record was in Chancery, filed notice of objections, under 5 & 6 Will. 4, c. 83, s. 5, namely, that other persons than the patentee had used the invention in England before grant of the patent, the Court of Queen's Bench, on motion supported by an affidavit stating that the defendant had no other means of gaining the information required, and was afraid of being taken by surprise at the trial, refused to order delivery of a particular stating the names and addresses of such persons. (2 *Q. B.* 969.)

(f) *HEATH v. UNWIN.* [1842]

It is not sufficient notice of an objection to say that the invention was wholly or in part used before, but it ought to point out what portions were previously in use. (10 *M. & W.* 684; 1 *Web. P. C.* 551; 2 *D. N. S.* 482; 6 *Jur.* 1068; 12 *L. J., Ex.* 46.)

(g) *RUSSELL v. LEDSAM.* [1843]

To an action for the infringement of a patent, the defendant pleaded: That the invention was not, when the letters patent were granted, a new invention:—*Held*, that the notice of objections delivered under 5 & 6 Will. 4, c. 83, s. 5, should specify

whether the defendant objects to the patent generally as not new, or to part only, and, if so, to what part. (11 *M. & W.* 647; 1 *D. & L.* 347; 7 *Jur.* 585; 12 *L. J., Exch.* 439.)

(h) *JONES v. BERGER.* [1843]

The words "and elsewhere" should be omitted, the places to be specified should fresh evidence arise. The notice of objections is sufficient if it limits the inquiry to a particular species and class of persons, who are using it in a particular trade. (1 *Web. P. C.* 549.)

Maule, J., said: "It seems to me to be a reasonable particularization if it (the notice of objection) points out to the party who is to sustain the patent sufficiently the nature of the inquiry that the objector intends to rely on as to the patent. It seems to me not unreasonable to say 'at Nottingham and elsewhere;' for the nature of the fabric being specified, and the particular kind of starch also specified, it might well be, as my brother *Bompas* has argued forcibly, that there might be fabrics of that kind in the market, which could be shown to have been made of that kind of starch, though you may not be able to trace where they came from. I don't think it worth while to differ from my Lord Chief Justice in that respect." (1 *Web. P. C.* 550.)

The defendant should specify books or publications intended to be relied on. (1 *Web. P. C.* 548.)

(i) *BENTLEY v. KEIGHLEY.* [1844]

In case for infringing of a patent for improvements in machinery, the notice of objections delivered pursuant to 5 & 6 Will. 4, c. 83, s. 5, stated that the invention was known to and used by A. and B., and others, before the grant. The Court refused to require the defendant to strike out the words "and others." Maule, J., in the course of the argument, said: "The plaintiff may know one person, and he may know that there are others who have used the article. Suppose the patent to be for an improvement in shipping, and the defence relied on were, that it had been used before, the defendant would not be bound, in his particular, to state the names of all the owners of all the ships in which he had seen the alleged improvement applied. But, if he states that the invention had been published to the world in a certain magazine or journal, and also in other books and writings, he ought to specify all the books and writings." (7 *M. & G.* 652; 8 *Scott, N. R.* 372; 1 *D. & L.* 944; 13 *L. J., C. P.* 167.)

(j) *HOLLAND v. FOX.* [1853]

Where the defendant in an action for infringement of a patent states in the particulars of objection delivered with his pleas that the invention of the plaintiff had been used before, *inter alia*, at Sheffield, Birmingham and London, the Court made an order, under the 15 & 16 Vict. c. 83, for further and better particulars. (1 *C. L. Rep.* 440; 1 *W. R.* 448.)

*(k) PALMER v. COOPER.* [1853]

The 41st section of the 15 & 16 Vict. c. 83, requires the defendant in an action for the infringement of a patent, to deliver with his pleas the particulars of any objections on which he means to rely at the trial: and when he intends to rely upon a prior user or publication, the particulars must state the place or places at which, and in what manner, the invention has been used or published prior to the date of the patent; and in the absence of such statement, the defendant will be precluded from giving evidence of such prior user or publication. The plaintiff's particulars of breaches cannot be called in aid of the defective particulars of objections. Although a judge at chambers has power to order the amendment of the particulars, he cannot introduce into such order any terms relative to the admissibility of evidence at the trial under such particulars which are inconsistent with the provisions of the 41st section. (9 *Exch.* 231; 2 *C. L. R.* 430; 23 *L. J.*, *Exch.* 82.)

Parke, B.: "The defendant's particulars ought to give the plaintiff such information as will enable him to make the necessary inquiries at the places named." (9 *Exch.* 236.)

Alderson, B.: "I think that the present residence of the parties who have been the users of the invention ought to be stated, as otherwise the plaintiff would not know where to go for his evidence." (*Ib.*)

*(l) PALMER v. WAGSTAFFE.* [1853]

Where, in an action for the infringement of a patent, the defendant relies on a general user of the supposed invention, it is sufficient to state, in his particulars of objection, under 15 & 16 Vict. c. 83, s. 41, that the invention was used by manufacturers generally at a particular place, without naming any person or specifying any manufactory. (8 *Exch.* 840; 17 *Jur.* 581; 22 *L. J.*, *Exch.* 295.)

Alderson, B.: "A defendant may rely either on a specified user by certain persons named, or on a general user by all persons at a particular place. In the former case, if he proves a user by any one of the persons named, that will support his objection; but if he rests his case on a general user, proof of a user by one person will not do. In fact, the plaintiff has no reason to complain of the generality of the statement, for the more general it is, the more the defendant must prove under it." (8 *Exch.* 842.)

*(m) HULL v. BOLLARD.* [1856]

The 15 & 16 Vict. c. 83, s. 41, does not prevent defective particulars from being available at the trial, and the plaintiff cannot resist the admission of evidence which is within the literal meaning of the particulars, on the ground that the statement is too general, and that the particulars do not give the required information as to the place in which the invention

is alleged to have been used. (1 *H. & N.* 134; 25 *L. J., Exch.* 304.)

Pollock, C. B.: "It is true that the statute contains a proviso that the place or places at which the invention is alleged to have been used shall be stated, but that proviso does not prevent particulars not containing such statement from being available, if not objected to on that ground before the trial." (1 *H. & N.* 137.)

(m\*) GROVER AND BAKER SEWING MACHINE COMPANY *v.* WILSON.  
[1870]

The defendant had been ordered to give amended particulars stating pages and lines of the prior specifications relied on, and the parts of the machines alleged to have been used before, and afterwards obtained leave to add other specifications and other names of prior users. *Held*, that he ought to have given pages and lines and the parts of the machines in the additional particulars. (*W. N.* 1870, p. 78.)

(n) WILSON *v.* GANN. V.-C. H. [1875]

In a patent suit which had been set down for hearing, an application made by the defendant, after notice given to the plaintiff, for leave to produce at the hearing of the cause the evidence as to prior user of a new witness discovered since the closing of the evidence, was allowed. (23 *W. R.* 546.)

(o) FLOWER *v.* LLOYD. C. A. [1876]

In a patent suit the form of order requiring the defendant to furnish further and better particulars of objections used to follow the words of section 41 of the Patent Law Amendment Act, 1852, and require the defendant to state in his particulars merely "the place or places at, or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the patent," but under such an order the defendant must furnish full and sufficient particulars. (45 *L. J., Ch.* 746.)

The defendant gave the names and addresses of three persons, and stated that the patented process had also been used by "other persons in London and Birmingham." The plaintiff took out a summons, which was adjourned into Court, asking that the words in inverted commas might be struck out, on the ground that the notice of objection was not in compliance with the order or with the statute 15 & 16 Vict. c. 83.

It was contended on behalf of the defendants that, on the authority of *Bentley v. Keighley* (7 *Man. & Gr.* 652), and *Palmer v. Wagstaffe* (8 *Exch.* 840), it was sufficient, under an order to specify the places where the process had been used, to give the names of the towns.

Field, J.: "I cannot follow the cases that have been cited. We have advanced in our ideas since they were decided. If the defendants knew that their processes have been used by other

persons in London and Birmingham besides those specified, they must know the persons by whom they have been used, and must give more specific information. I do not say that they need give the name and address of every such person, but they must give fair information. If they can give no further information, the words in question are useless and too indefinite, and must be struck out." (*Solicitors' Journal*, 1876, p. 860.)

(p) PLIMPTON v. SPILLER. Field, J. [1876]

The defendants alleged by their objections that the invention was, before the date of the alleged patent, patented in the United States of America, and the said prior American patent was surrendered before the defendants made and used the said invention. That "before the date of the alleged letters patent the alleged invention had been published in England in the Commissioners of Patents Journal of the 6th of February, 1863, and in the Scientific American of the 24th of January, 1863, and in sketches and drawings deposited in the Patent Office Library in July, 1865:"—*Held*, that the defendant must give better particulars. They must state the date of the American patent, the name of the patentee, and the date of the alleged surrender. The pages of the publication mentioned in the above objections must be specified, but not the lines, and the drawings must be identified in writing, whether contained in books or not. The last part of the order to be in the terms of *Flower v. Lloyd*. (20 *Solicitors' Journal*, 1876, p. 860.)

(q) SUGG v. SILBER. C. A. [1877]

Under notice of objection by a defendant, that the invention was not new, he can at the trial show that one of two inventions described in the specification is not new, and that the patent is therefore bad. (2 *Q. B. D.* 493.)

(r) BIRCH v. MATHER. [1883]

In a patent action the plaintiff is entitled under the 41st section of the Patent Law Amendment Act, 1852, to have the names and addresses of the persons mentioned in the particulars by whom it is alleged that prior user was made as well as the places where the prior user has taken place. (22 *Ch. D.* 629.)

(s) LONDON & LEICESTER HOSIERY COMPANY v. HIGHAM.

Defendant was ordered to state what portions of the specifications alleged as prior publications were alleged to anticipate the plaintiff's patent, with a reference to pages and lines of such specifications, and also what portions of plaintiff's inventions are alleged to have been published prior to the letters patent with reference to the claiming clauses of the specifications of such letters patent. (*Lawson's Patents*, pp. 75, 330.)

(t) BOYD v. HORROCKS. [1886-8]

Allegations of prior user by named persons in given years held sufficient. (3 *O. R.*, 285; 5 *O. R.* 562.)

## (u) FOWLER v. GAUL. [1886]

It is not sufficient for a defendant to say, I impeach the patent on the ground of want of novelty, and then to state the time and place of the previous publication or user alleged by him and no more. He must state on what grounds he disputes it, and if one of those is want of novelty, he must state reasonably on what grounds in respect of want of novelty he disputes it, and the time and place of the previous publication or user alleged. In this case the want of novelty suggested was the prior publication of two specifications and of two provisional specifications. It is unreasonable to fling at the head of the plaintiff the two specifications alone, it being perfectly within the knowledge of the defendant, and not within the knowledge of the plaintiff, what parts he intends to rely on; and, if there are several things, which in nine cases out of ten there are, it is right that he should be called upon to say, "I say that the thing shown in every part of that is an anticipation," or "in the diagram so and so," or "in paragraph so and so," or "in the explanation given in pages so and so from some line to some other line," just sufficiently to enable the plaintiff to know in what respect he is to be attacked. (*Griff.* 99; 3 O. R. 247.)

## (v) HARRIS v. ROTHWELL. [1886]

Order for better particulars of objections to be given, stating to what claim in the plaintiff's specifications each of the objections was pointed, and referring to the particular parts of the specifications and publication on which the defendant relied as anticipations. (*Griff.* 109; 3 O. R. 243.)

## (w) BOYD v. FARRAR. [1887]

In an action for damages and an injunction in respect of infringement of a patent for complicated machinery, the defendant delivered particulars of objections, stating that prior to the date of the patent (1), articles made according to the supposed invention were publicly exhibited in use by Messrs. H. at their (named) works in May, 1887, and (2), the supposed invention was published in certain specifications which were enumerated with references to pages and lines where the alleged anticipations were to be found:—*Held*, that the defendant ought to specify the particular machines or articles alleged to be anticipations, but not the parts of the plaintiff's machine anticipated thereby, as the plaintiff must be taken to know his own invention; and further, as to (2), that the defendant must state with reference to each specification which parts of the plaintiff's invention, by reference to claiming clauses of the plaintiff's specification were alleged to be anticipated thereby. (*W. N.*, 1887, 157; 57 *L. T.* 866; 5 O. R. 33.)

## (x) HOLLIDAY v. HEPPENSTALL. C. A. [1889]

It is not necessary or proper for a defendant who relies on general public knowledge, to state in his particulars of objections

the books which contain that knowledge, but such general public knowledge must be proved by ordinary evidence with a reference to well-known books if necessary. But, of course, if a defendant relies on any publications as anticipations, he must state what publication he relies on, and that he relies on it as an anticipation, and not as showing the state of general public knowledge, and he ought to state the nature of the alleged anticipation, and to specify where in particular it is to be found, without, in an ordinary case, being obliged to give actual pages and lines. (6 O. R. 320.)

Defendants in an action for infringement of a patent for a dyeing process, alleged want of novelty and anticipation, and being called on for particulars, referred to about twenty specifications and a voluminous collection of extracts from books. Ordered that the defendants should strike out the publications on which they relied as showing general knowledge which prevented the process being an invention, and should state the nature of the anticipations alleged, and should point out which parts of the specifications they relied on as showing such anticipations. (*W. N.*, 1889, p. 66.)

*As to Specification.*

(y) *FISHER v. DEWICK.* [1838]

On the objection, "that the invention for which the said letters patent were granted is more extensive than, and did not correspond with, the invention described in the specification," his Lordship remarked, "I think the attention of the plaintiff should be called to the particular part or parts." His Lordship made the same remark on an objection of discrepancy between the drawings and specification. (1 *Web. P. C.* 551 (n).)

(z) *NEILSON v. HARFORD.* [1841]

A statement in the notice of objections, "that the specification is calculated to deceive," is sufficient to let in evidence as to any particular passage being false. (1 *Web. P. C.* 324 (n).) Where the objection simply states the specification to be insufficient, if the plaintiff is contented to take that as notice, any objection may be made at the trial to show that the specification is insufficient. (*Ib.* 332.)

(a) *HEATH v. UNWIN.* [1842]

It is a sufficient notice to state "that the invention is not properly set forth in the specification," for the legislature never intended that the defendant should argue his case in the statement of objections, which he delivers in compliance with the Act. (10 *M. & W.* 687; 12 *L. J., Ex.* 48.)

(b) *JONES v. BERGER.* [1843]

The objection that the plaintiff's specification did not "sufficiently distinguish between what was old and what was new," held sufficient, as the objection was to an omission in the specification. The



allegation that the plaintiff did not state in his specification "the most beneficial method with which he was then acquainted, of practising his said invention," held sufficiently precise. (5 *M. & G.* 208.)

(c) *LEAF v. TOPHAM.* [1845]

In an action for the infringement of a patent, the defendant, pursuant to sect. 5 of 5 & 6 Will. 4, c. 83, delivered a notice of objections, one of which stated that the patentee did not, by the specification in the declaration mentioned, sufficiently describe the nature of the supposed invention; and the other stated that he had not caused any specification sufficiently describing the nature of the supposed invention to be duly enrolled in chancery:—*Held*, that the last objection was not sufficiently precise; and the Court ordered an amendment, which was made by inserting the word "other" before "specification." (14 *M. & W.* 146; 14 *L. J., Exch.* 231.)

Parke, B.: "I think the meaning of the last objection is too obscure. It may either mean, that there is no specification existing among the rolls of the Court, or that that which has been enrolled is defective in not sufficiently describing the invention." (14 *M. & W.* 148.)

(d) *ANGLO-AMERICAN BRUSH LIGHT COMPANY v. CROMPTON.* C. A. [1886]

In an action for infringement, a defendant gave notice of an objection, that there was a variance between the provisional and complete specification. Ordered to deliver further and better particulars, so as to inform the plaintiff of the scope and nature of the objection, and to show in what the alleged difference consists. (35 *W. R.* 125; 34 *Ch. D.* 152.) Order affirmed on appeal. (4 *O. R.* 27; *W. N.* 1886, 188.)

(d\*) *CROMPTON v. ANGLO-AMERICAN ELECTRIC LIGHT COMPANY.* C. A. [1887]

In an action for infringement, the defendant denied the validity of the patent, and stated the objection that the specification did not sufficiently describe the nature of the invention, and how it was to be performed. Being ordered to furnish further particulars, he repeated the above, with this addition, "inasmuch as it does not contain a sufficient direction to enable workmen skilled in the manufacture of electrical machinery to make a dynamo electric machine," with the property claimed. Kay, J., ordered further particulars, and the Court of Appeal declined to interfere with that order. (35 *Ch. D.* 283; 4 *O. R.* 197.)

*Certificate that particulars of objection have been proven or were reasonable and proper.*

(e) *HONIBALL v. BLOOMER.* [1854]

In an action for the infringement of a patent, the 43rd section of the 15 & 16 Vict. c. 83, made the certificate of the judge who tried the cause, that the defendant's particulars of objections had

been proved by the defendant, a condition precedent to his right on taxation to any costs in respect of such particulars, even in the case of a nonsuit. (10 *Exch.* 538; 1 *Jur.*, *N. S.* 188; 24 *L. J.*, *Exch.* 11.)

Pollock, C.B., said: "With respect to the costs of the issues, there is no doubt that, where the plaintiff is nonsuited, the defendant is entitled to all the costs of the issues, that is to say, of the pleadings and evidence necessary to support them. But as these particulars are the creatures of this statute, and the costs of this particular class of proceedings are declared by the legislature to be no part of the general costs of the cause, and that in the absence of a certificate they shall not be recoverable, they are not recoverable." (10 *Exch.* 542.) (But see *Parnell v. Mort, Liddell & Co. inf.* p. 316 (i).)

(f) *GREAVES v. THE EASTERN COUNTIES RAILWAY COMPANY.* [1859]

The plaintiff having abandoned his action before trial: *Held*, that the defendants were entitled to the costs of the particulars, and of the evidence in support of them, for sect. 43 of 15 & 16 Vict. c. 83 did not apply except when the cause came on for trial. (1 *Ell. & Ell.* 961; 28 *L. J.*, *Q. B.* 290.)

(g) *GERM MILLING COMPANY v. ROBINSON* (No. 2.) [1885]

On an application for a certificate that particulars are reasonable and proper under sect. 29, sub-sect. 6, of the Patents Act, 1883, it is not enough that such particulars do not appear to be otherwise than reasonable and proper, but the Court must be satisfied that they are reasonable and proper; and for the purpose of determining this question the Court will rely solely upon knowledge derived from the trial of the action, and where an action comes to an end without both sides being heard will not allow additional evidence to be called. The Court will not grant a certificate to a party who is not entitled to any costs of the action. (55 *L. T.* 282; 1 *T. L. R.* 38; 2 *T. L. R.* 785.)

(h) *CROPPER v. SMITH AND HANCOCK.* [1885]

The defendant Smith delivered three objections, the first only of which was relied on by Hancock in his particulars. The House of Lords held that the first two objections failed, but that the third was sufficient to invalidate the patent, and that Hancock was not shut out from the benefit of that decision. Pearson, J., being applied to by both defendants as judge of first instance for a certificate, certified that the defendant Smith had established his third objection. (*W. N.* 1885, p. 11.)

(i) *PARNELL v. MORT, LIDDELL AND COMPANY.* C. A. [1885]

The Judge of the County Palatine Court held the patent invalid for an objection appearing on the face of it, but stated that the defendants ought to have the costs of the witnesses brought to support their particulars of objections. *Held*, that the Vice-Chancellor had power to allow the costs, as the Palatine Court was not affected by 15 & 16 Vict. c. 83 nor fettered by analogy.

Bowen, L.J. : " I entertain some doubt as to *Honiball v. Bloomer*, but the point will probably never occur again." (29 *Ch. D.* 325.)

(j) *ROWCLIFFE v. MORRIS.* [1886]

Where a successful defendant did not apply at the trial for a certificate that he had proved his particulars of objection, but moved for one six months afterwards, he was given a certificate but no costs of the motion. (3 *O. R.* 145.)

(k) *BADHAM v. BIRD.* [1888]

The certificate as to particulars of objection was limited to those which were put to the plaintiff in cross-examination. (5 *O. R.* 238.)

(k\*) *Longbottom v. Shaw.* [1888]

A certificate of particulars of objection which the defendant, not being called on, had had no opportunity of proving, was refused. (5 *O. R.* 502.)

(l) *ODDY v. SMITH.* [1888]

The defendant succeeded on the grounds of no infringement and no subject-matter, and a certificate as to other particulars of objection which were thereby rendered unnecessary was refused. (5 *O. R.* 509.)

(m) *GOULARD AND GIBBS PATENT.* [1888]

On a petition for revocation the judge was of opinion that there was no power to give a certificate as to particulars of objection. (5 *O. R.* 537.)

(n) *COLE v. SAQUI AND LAWRENCE.* C. A. [1888]

The Court of Appeal in reversing a decision in favour of a patent has jurisdiction to grant a certificate under sect. 29, subsect. 6 of the Patents Act, 1883, that the defendant's particulars of objection were reasonable and proper. (*W. N.* 1888, 229.)

(o) *THOMSON v. BATTY.* [1889]

Where the defendant gives in his particulars a long list of anticipations, and counsel only mentions one or two in court, the Court seldom fails to exercise the power of giving the plaintiffs the costs in any event, and on the higher scale, of the alleged anticipations which have not been proved. (6 *O. R.* 84.)

(p) *GRIFFIN v. FEAVER.* [1889]

In an action for infringement where the patent was challenged on the ground *inter alia* of anticipation, and (the plaintiff's first witness being unable to distinguish one of the alleged anticipations) judgment was given for the defendant without hearing further evidence, Kekewich, J., gave a certificate that the particulars of objection as to prior user were reasonable, having first ascertained from the defendant's counsel that he was prepared to prove them if they had been required. (6 *O. R.* 396.)

(q) *Longbottom v. Shaw*. [1889]

In this case the Court of first instance decided on the specification alone that the patent was bad for want of subject-matter, and the Court of Appeal took the same view. To each Court application was made for a certificate that the particulars of objections were reasonable, and each Court refused to grant one on the ground that the statute did not require the Court to hear objections (which were not necessary as it turned out) for the mere purpose of giving costs. On taxation the taxing-master allowed the defendants the costs governed by the particulars of objections. *Held*, by Kay, J., that no costs of the particulars could be allowed. (6 *O. R.* 510.)

(r) *Boyd v. Horrocks*. C. A. [1889]

The Court of first instance found that there was infringement and that the patent was valid. The Court of Appeal reversed the finding as to infringement and, therefore, declined to go into the question of validity. *Held*, that the action must be simply dismissed with costs, and the Court would not consider whether the defendants were entitled to a certificate of objections or the plaintiffs to the costs of some of the issues. (6 *O. R.* 152, 528.)

(r\*) *Morgan v. Windover*. [1890]

The House of Lords having decided against the patent, the Court of first instance gave a certificate limited to the objections brought forward at the trial. (25 *N. C.* 103.)

(s) *Philips v. The Ivel Cycle Company*. [1890]

Particulars of objection need not be proved in order to obtain a certificate; it is for the judge to read them and say whether they are reasonable and proper; a certificate was given for particulars which led the way to the anticipations which proved fatal to the patent. (7 *O. R.* 77; 42 *L. T.* 392.)

(s\*) *Deutsche Nähmaschinen Fabrik v. Pfaff*. C. A. [1890]

The Judge of first instance not having heard evidence, the Court of Appeal heard the defendant's evidence, and, without finding that all the objections were proven, gave a certificate that they were reasonable and proper. (7 *O. R.* 257.)

*Practice,—Discovery and Interrogatories.*

(t) *Swinborne v. Nelson*. [1853]

The plaintiff's right to discovery and to production rest on the same principle. A defendant who submits to answer must answer fully; he cannot by denial of the plaintiff's title escape answering. Discovery of title-deeds and of professional communications forms an exception. The plaintiff and defendant had both patents for making gelatine. The plaintiff instituted his suit for redress against an alleged infringement of his patent, and the bill contained searching questions, requiring the defendant to set forth all the articles manufactured by him, the names and addresses

of his customers, the prices and the profits, &c. The defendant denied all infringement. He said he had made his articles according to his own and not according to the plaintiff's patent, and he declined to give an account of such articles:—*Held*, that, notwithstanding his denial, he was bound to do so. (16 *Beav.* 416.)

(u) SMITH v. THE GREAT WESTERN RAILWAY COMPANY. [1854]

Where, in an action for an infringement of a patent, the plaintiff seeks, under sect. 6 of 14 & 15 Vict. c. 99, to discover by an examination of the defendant's books the amount of damage sustained by him by the infringement of his patent by the defendant, the Court will not compel the defendant to grant such inspection, unless a *prima facie* legal right be established by the plaintiff; and it is not enough for the plaintiff to show that he has been injured in his patent, and that it is probable the amount of such injury will be ascertained by the examination asked for. (3 *W. R.* 69.)

(u\*) TETLEY v. EASTON. [1856]

Where a defendant does not deny the infringement, it is no ground for his refusing to answer interrogatories, that the answers would expose persons to whom he had sold the patented articles to actions. (18 *C. B.* 643; 25 *L. J. C. P.* 293.)

(v) DE LA RUE v. DICKINSON. [1857]

When a defendant by his answer denies the fact of infringement, he is protected from making any discovery immaterial to that question, and which when that question is decided would be given under the decree. And it is not necessary to set up a defence of this nature by plea. (3 *K. & J.* 388.)

(w) JONES v. PRATT. [1861]

The plaintiff, in an action commenced in 1861 for damages for an infringement of his patent, granted in 1841, applied to be allowed to administer interrogatories to the defendant before delivery of declaration, asking, *inter alia*, for particulars of the number of machines manufactured, altered or sold by the defendant between the years 1841 and 1855, when the patent expired. The application was made on affidavits by the plaintiff's agent, that he had ascertained and believed that many machines, containing infringements of the plaintiff's patent, had been made and sold, without the leave of the plaintiff, by the defendant, between the said years, and that answers to the interrogatories would disclose many more breaches of the plaintiff's patent than had as yet been discovered, and that the discovery sought by the interrogatories was essential for the drawing the declaration in the action. The Court refused to allow the interrogatories to be delivered *before* declaration, but intimated that the plaintiff might probably be entitled to deliver them after issue joined, and that he would then be at liberty to amend the particulars of the breaches he would be bound to deliver with his declaration, in accordance with the answers the defendant might give. (30 *L. J.*, *Exch.* 365; 6 *H. & N.* 697.)

(x) *HOWE v. M'KERNAN*. [1862]

The plaintiff complained that the defendant had sold, under the plaintiff's name, sewing-machines which had not been manufactured by him, and he sought a discovery of all the machines sold by the defendant, the price, the profit, the names of the purchasers and other particulars. The defendant refused to answer, saying, that he would thereby disclose the names of his customers and the secrets of his trade:—*Held*, that he was bound to answer. (30 *Beav.* 547.)

(y) *FOXWELL v. WEBSTER*. [1863]

The defendant will not be excused from answering fully, and at once, on the ground that the validity of the patent will require to be established by an issue. When separate bills have been filed against numerous defendants, the plaintiff is entitled to a separate answer from each defendant. (3 *N. R.* 103.)

(z) *CROSSLEY v. STEWART*. [1863]

In a suit to restrain infringement the defendants were required to set out the names and addresses of all persons from whom they had received sums of money for the use of articles alleged to be manufactured in infringement of the plaintiff's rights, even though such persons might reside abroad. (1 *N. R.* 426.)

(a) *RENARD v. LEVINSTEIN*. [1864]

In a suit to restrain the infringement of a patent for making dyes in a particular manner, the defendant denied that his process was an infringement, and alleged that his process was secret, and that his trade depended on keeping it secret:—*Held*, that he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials; but he was not bound to disclose the proportions in which he used the specified materials, or what the additional materials were. (3 *N. R.* 665; 10 *L. T. Rep.*, *N. S.* 94.)

(b) *DAW v. ELEY*. [1865]

Where the novelty of the invention is denied by the answer, the plaintiff has no right to a discovery of the particulars on which the defendant relies as showing a user of the thing patented prior to the date of the patent. (2 *H. & M.* 725.)

(c) *BOVILL v. SMITH*. [1866]

In a suit to restrain an infringement of a patent which is contested on the ground of anticipation by prior user, the plaintiff is not entitled to discovery from the defendant in answer to a general interrogatory as to the instances of prior user on which he relies. (*L. R.*, 2 *Eq.* 459.)

(d) *THOMAS v. TILLIE*. [1866]

See this case for the form and extent of interrogatories which may be exhibited to a defendant in an action for infringement

of a patent before plea pleaded. (17 *Ir. C. L. R.* 783.) The same interrogatories were allowed in England, not reported. (*Ib.* 785.)

(e) *HOFFMANN v. POSTILL.* [1869]

In answering interrogatories filed by a defendant for the examination of the plaintiff, the general rule applies that he who is bound to answer must answer fully.

Interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case; but a defendant may ask any questions tending to destroy the plaintiff's claim.

A defendant in a suit for infringement of a patent, in order to prove that there was no novelty in the plaintiff's patent, interrogated the plaintiff as to the inventions described in the specifications of previous patents, and asked him to show in what respect they differed from his. The plaintiff declined to answer these interrogatories on the ground that the questions were not questions of fact, and that they related to the plaintiff's case; the defendant excepted to the answer, and the exceptions were allowed. (*L. R.*, 4 *Ch.* 673; 17 *W. R.* 901; 20 *L. T. Rep.*, *N. S.* 893.)

(f) *MURRAY v. CLAYTON.* [1872]

An injunction having been granted to restrain the infringement of a patent, with an inquiry as to damages, an order was made in chambers for an affidavit by the defendants as to the number of the patented machines sold by them, and the names and addresses of the purchasers and of the agents concerned in the transactions. They gave the number of the machines sold, but not the names of the purchasers. On an application by the plaintiff to consider the sufficiency of the affidavit, and another by the defendants to strike out of the order the words they objected to answer, unless the plaintiffs would undertake not to take proceedings against the purchasers:—*Held*, that the plaintiff was entitled to have discovery of the names and addresses of the purchasers, but not of the agents concerned, there being nothing to show that any agents had been employed. (42 *L. J.*, *Ch.* 191; *L. R.*, 15 *Eq.* 115.)

(g) *LEA v. SAXBY.* Exch. D. [1875]

In an action brought upon an indenture licensing the defendants to manufacture certain gates upon a patented principle, in which the defendants covenanted to pay certain royalties upon all gates manufactured by them according to the said principle, and to deliver quarterly statements of the gates, so manufactured by them, to the plaintiff, and to stamp the gates so manufactured by them, and not to sell any gates so manufactured by them below certain specified prices, the Court refused to allow interrogatories to be administered to the defendants, asking the number of gates constructed by the defendants wherein the apparatus for closing or

opening the gates acted simultaneously upon signals. The patent being one for an improved apparatus for closing and opening gates acting simultaneously upon signals, there being other methods besides the patented one of constructing gates so acting, and it being denied by the defendants that they had broken their covenants, interrogatories as to the prices of gates sold were also disallowed, it not appearing that the plaintiff relied upon this as a substantial cause of action. (32 *L. T. Rep.*, *N. S.* 731.)

(h) *CROSSLEY v. TOMEY*. V.-C. M. [1876]

In a suit to restrain the infringement of a patent the defendant was required to state whether he was not making articles in all respects identical with those of the plaintiff, and to set forth in what respects they differed and by what process they were made:—*Held*, that the defendant, who alleged prior user by himself and others, had sufficiently answered by stating that, save so far as the articles manufactured by him before the date of the patent were similar to those of the plaintiff, the articles now made differed from those made by the plaintiff, but he could not show in what they differed without ocular demonstration. *Held*, also, that the defendant was bound, in alleging prior user by other persons, to set forth the names of some of those persons. (2 *Ch. Div.* 533.)

(i) *ROLLS v. ISAACS*. V.-C. B. [1878]

The plaintiff alleged that the defendants<sup>4</sup> infringed his patent, dated 1871, by manufacturing a liquid composition, the principal ingredient of which was the gum of the euphorbia plant.

The defendants denied the infringement and disputed the validity of the plaintiff's patent, and alleged that they manufactured, under a patent dated 1875, a composition for protecting the bottom of ships, in which the resinous part of gum euphorbia was used.

The plaintiff interrogated defendants as to whether they had manufactured for protecting ships' bottoms a composition in which euphorbia gum was an ingredient, and not being a composition prepared exactly in accordance with the specification of their 1875 patent, and, if so, asking the defendant to set forth the ingredients of such composition, and further interrogated as to the ships to which the defendants had, since the date of the plaintiff's patent, applied any composition in which euphorbia gum was an ingredient, although such ships were not mentioned in the particulars of breaches. All above interrogatories disallowed. (*W. N.* 1878, p. 37.)

(j) *BIRCH v. MATHER*. [1883]

In a patent action, where either party makes out a proper case, the Court has jurisdiction to order interrogatories to be answered, notwithstanding the provisions in the Patent Law Amendment Act, 1852, as to particulars, and if the interrogatories are properly worded, they may refer to the very matters which ought to be covered by the particulars. (22 *Ch. D.* 629.)



(k) *In re HADDAN'S PATENT.* [1884]

It is the practice now, if the Court should think fit, to allow a petitioner for revocation of a patent to administer interrogatories to the claimant. Leave granted where the petitioner objected to the patent on six grounds, one of which was fraud. (*W. N.* 1884, p. 192.) The ordinary practice as to discovery is applicable to a petition for revocation of a patent under sect. 26 of the Patents Act of 1883. (54 *L. J.*, *Ch.* 126; 51 *L. T.* 190; 33 *W. R.* 96.)

(l) *LISTER v. NORTON.* [1885]

The rules of the Court as to discovery do not draw any distinction between different subject-matters when in dispute, and the principle which Jessel, M.R., laid down in *Parker v. Wells*, viz., that the defendant need not give discovery of that which will only help the plaintiff in case he gets a decree, and will not help him to get it (18 *Ch. D.* 477), is applicable quite as much to the case of a patent action as it is to the case of a trust action. (*Griff.* 148; 2 *O. R.* 68.)

(m) *MOSELEY v. VICTORIA RUBBER COMPANY.* [1886]

The defendant in an action for infringement interrogated the plaintiff as to documents relating to the preparation of the specifications. The plaintiff's patent agent, Mr. Johnson, was also his solicitor, and privilege was claimed for communications made to him. A further answer was ordered on the ground, that it being clear that the communications to Mr. Johnson *qua* patent agent were not privileged, it was incumbent on the plaintiff, whose oath was conclusive, to distinguish as precisely as possible those which were communications to Mr. Johnson *qua* solicitor. (*Griff.* 163; 3 *O. R.* 351; 55 *L. T.* 482.)

(n) *HASLAM COMPANY v. HALL.* C. Div. [1887]

Documents relating to prior litigation concerning the patent instituted, or intended to be instituted by plaintiffs before they became owners of the patent, must be produced, except such as the plaintiffs state on oath to have come into existence, merely to be communicated to the solicitor for the purpose of litigation, actual or intended, and either as materials for briefs, or for his advice and consideration. (5 *O. R.* 1.)

(o) *BOWN v. SANSOM.* C. A. [1888]

The plaintiff had, in a former action in reference to the same patent filed certain affidavits, stating that the anticipation alleged by the defendants was fraudulent. The former action had been settled, and the affidavits were ordered to be taken off the file. In an affidavit in the present action, the plaintiff referred to these affidavits, but they were not mentioned in his affidavit of documents:—*Held*, that the former affidavits were relevant to the same issue in the present action, and that a further and better affidavit of documents must be made. (5 *O. R.* 510.)

(p) *AMERICAN BRAIDED WIRE COMPANY v. THOMPSON.* [1888]

The defendants were ordered to produce, for the purposes of an inquiry as to damages, all such parts of documents in their possession as disclosed the names of the customers of the firm of Thompson and Co., to whom articles made, in infringement of the plaintiffs' patent, had been sold. (5 *O. R.* 375.)

(q) *THOMSON v. HUGHES.* C. A. [1889]

Order for affidavit by plaintiff, of documents confined to pleadings and orders, shorthand notes of judgments or orders, and particulars of objections in any actions relating to the patent, upheld on appeal; the plaintiff offering also to include shorthand notes of evidence, and affidavits in other actions. (*W. N.* 1889, 212; 7 *O. R.* 187.)

(q\*) *RYLANDS v. ASHLEY'S PATENT BOTTLE COMPANY.* C. A. [1890]

In an action for infringement of a patent for improvements in apparatus for manufacturing glass bottles the defendant pleaded (*inter alia*) want of utility. The plaintiff objected to answer an interrogatory as to whether it was not necessary to introduce modifications into his apparatus to successfully manufacture long-necked bottles, on the grounds that it was not material and that he was introducing improvements which he objected to disclose to a rival trader, and referred to another answer which said that it was not impossible and that such bottles had been manufactured, though not for sale. *Held*, that the interrogatory was relevant and the answer insufficient, as it might be that long-necked bottles could not be made successfully for commercial purposes by the apparatus without modifications, but that the defendants were not entitled to know what the modifications proposed by the plaintiffs were. (7 *O. R.* 175.)

(s) *ASHWORTH v. ROBERTS.* [1890]

On the defendant declining to answer as to user on the ground that his process was secret, the plaintiff asked as to each separate step in the specification whether the defendant had read it:—*Held*, that the defendant must answer. (*W. N.* 1890, p. 154; 25 *N. C.* 111.)

(t) *RAWES v. CHANCE.* C. A. [1890]

North, J. refused to order discovery, before the trial, of the defendant's books containing analyses of the materials used by them, on the ground that if the plaintiffs failed to support their patent, such discovery, being only material to infringement, might become unnecessary. An appeal was dismissed. (7 *O. R.* 275.)

### *Practice.—Inspection.*

PATENTS ACT, 1883, sect. 30. In an action for infringement of a patent the Court or a Judge may on the application of either party make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a Judge may see fit.

(r) *BOVILL v. MOORE.* [1815]

Lord Eldon: "There is no use in this Court directing an action

to be brought if it does not possess the power to have the action properly tried. The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article, and, as the plaintiff alleges, he is making it with a machine constructed upon the principle of the machine protected by the plaintiff's patent. Now the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy at present is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No Court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted, before the trial of the action, to inspect the defendant's machine, and to see it work." (2 *Coop. C. C.* 56 (n.).)

(s) *BROWN v. MOORE.* [1816]

Lord Eldon, referring to this case in *Kynaston v. The East India Company*, said: "I remember a case, where, on a suggestion that a machine used by the defendant was an infringement of a patent, the Court ordered the defendant to allow an entry into his premises for the purpose of ascertaining by inspection whether the machine was an infringement." (3 *Swan.* 264.)

(t) *RUSSELL v. COWLEY.* [1832]

The Court not only ordered that the plaintiff's witnesses should inspect the defendant's machinery at work, but that the defendant's witnesses should inspect the plaintiff's patented machinery at work pending an action for infringement, the object of the Court being to enable the parties to give the best evidence as to whether the defendant had been guilty of infringement or not. (1 *Web. P. C.* 458.)

(u) *MORGAN v. SEAWARD.* [1835]

The defendant was ordered to permit, after reasonable notice, an inspection of machinery made, or to be made, in pursuance of a certain contract. (1 *Web. P. C.* 169.)

(v) *CROFTS v. PEACH.* [1836]

In an action for the infringement of a patent, the plaintiff will not be compelled to produce a specimen of the patent articles, to enable the defendant to prepare his defence to the action. (2 *Hodg.* 110.)

(w) *RUSSELL v. CRICHTON.* [1837]

On motion by plaintiff for an order to inspect defender's works, the defender alleged that his manufacture involved a secret process, the value of which would be lost, if inspection was allowed:—*Held*, that some inspection must be allowed, or else any patent might be infringed with impunity; and order pronounced for giving inspection of the works and manufacture of both parties; the viewers being warned not to use any private information

which they might acquire through that inspection, except for the purpose of giving evidence. (15 *Dec. of Cr. of Sess.* 1270.)

(x) *AMIES v. KELSEY.* [1852]

An application to inspect the defendant's machinery may be made by the plaintiff under 15 & 16 Vict. c. 83, s. 42, whenever an action is pending, even before the delivery of the declaration; but such inspection will not be granted as of course, or without the party applying for it showing that the inspection is material for the purposes of the cause. (22 *L. J.*, *Q. B.* 84; 1 *B. C. C.* 123; 16 *Jur.* 1047.)

(y) *SHAW v. THE BANK OF ENGLAND.* [1852]

In an action for the infringement of a patent, the Court will not grant an order, under the 15 & 16 Vict. c. 83, s. 42, for an inspection of a machine upon an affidavit "that the machine used by the defendants is the same for which the plaintiff has obtained a patent." (22 *L. J.*, *Exch.* 26.)

(y\*) *HARRISON v. SPIRE.* [1853]

A rule nisi for an order to inspect defendant's machinery was granted on motion. (22 *L. T. Rep.* 92.)

(z) *VIDI v. SMITH.* [1854]

The "inspection" mentioned in the 42nd section of stat. 15 & 16 Vict. c. 83, is an inspection of the instrument or machinery manufactured or used by the parties, with a view to evidence of infringement, and does not refer to an inspection of books, which is provided for by another Act of Parliament. (3 *Ell. & B.* 969; 1 *Jur.*, *N. S.*, 14; 23 *L. J.*, *Q. B.* 342.)

(a) *JONES v. LEES.* [1856]

In an action by a patentee against his licensee on a covenant to pay for roving machines made with the plaintiff's invention, and to make none without,—breach, first, in not paying for roving machines made with the invention; and, secondly, in making machines without it; the defendant having, in answer to interrogatories, admitted the making of many hundreds of roving machines, but not with the plaintiff's invention, and having declared that he could not state to whom they were sold, nor give any further information about them, without disclosing his own evidence; and the plaintiff claiming in respect of all the machines the defendant had made, under one or other of the covenants, and asserting that he had seen some of them, which had his invention applied:—*Held*, that the defendant was entitled to such particulars as should describe those portions of the machines to which the plaintiff contended that his invention had been applied, and that the plaintiff might inspect the machines on the premises of the defendant, and also examine him *vivâ voce*. (25 *L. J.*, *Exch.* 241.)

(b) *MEADOWS v. KIRKMAN.* [1860]

In an action for the infringement of a patent for a mode of making veneers or mouldings, the Court refused to order an inspection by

the plaintiff of the defendant's manufactory and machinery; it being doubtful on the plaintiff's affidavit whether his patent was for the kind of veneering, or for the process by which it was done; and the defendant positively swearing that he used no machinery in the process. (29 *L. J.*, *Exch.* 205.)

Pollock, C.B., said: "We ought not to grant such an inspection without, at least, as good a ground for it as would be required in a Court of Equity; or for any inspection of books or documents. Then it must appear that what is asked is really required to prove the plaintiff's case."

(c) *THE PATENT TYPE FOUNDRY COMPANY v. LLOYD; SAME v. WALTER.* [1860]

In an action against a printer for an infringement of a patent for improvements in the manufacture of type, the improvements consisting in the use of lead, tin and antimony in certain proportions, the plaintiff applied to the Court under the 42nd section of the 15 & 16 Vict. c. 83, for leave to inspect, and, if necessary, to take specimens of the type for the purpose of analysis. His affidavit stated that he had obtained from the defendant specimens of the type and caused them to be analysed by a chemist who was dead, and that the type so analysed was an infringement of the patent; but did not set out the report of the chemist or state its substance, or whether or not it was in writing. The Court refused to make an order that the plaintiff should be at liberty to take specimens for analysis. (5 *H. & N.* 192; 29 *L. J.*, *Exch.* 207; 6 *Jur.*, *N. S.*, 103.)

Martin, B.: "I think that we ought to look at the injunction, inspection and account in the same spirit, and grant or refuse them on such terms as would be fair between the parties." (5 *H. & N.* 198.)

Bramwell, B., said: "It is difficult to say that a person authorized to inspect might not consume a small portion of the matter to be inspected. Probably inspection must be construed with reference to the matter to be inspected. If the party inspecting cannot otherwise understand its nature and quality, he may probably consume some small portion of it; but when a sensible meaning with reference to the subject-matter can be given to the word inspection by construing it inspection by the eye, I think it must be confined to that. Type can be inspected by the eye. I think in the present case that more is asked for than the Court has power to grant." (*Ib.* 200.)

Channell, B., said: "I do not say that the application in point of form must be for an injunction, yet I think that the right (to grant inspection) depends on the plaintiff satisfying the Court that they would have granted an injunction if asked for." (*Ib.*)

On an application to the Court of Chancery, Wood, V.-C., *Held*, that laches sufficient to defeat the plaintiffs' right to an interlocutory injunction was no bar to an order on the same motion for inspection, and made an order that the plaintiffs should be at liberty to take specimens of the type for analysis. (*John*, 727.)

*(d) DAVENPORT v. JEPSON.* [1862]

Ordered that the plaintiffs and the defendant, Henry Jepson, by their solicitors and scientific witnesses, be at liberty, from time to time, upon giving three days' notice of their intention so to do, mutually to inspect the machines heretofore used by the plaintiffs and the said defendant in the manufacture of chenille, and that the same machines be put to work upon such inspection, and that the plaintiffs and the said defendant, by their said witnesses and solicitors, be at liberty to take samples of the chenille made or to be made upon the said machines.

And further ordered that the plaintiffs, by their solicitors and witnesses as aforesaid, be at liberty, upon the like notice, to inspect the machines or exhibits marked, &c., produced by the said defendant, and referred to as exhibits in certain affidavits filed, &c., and to put the last-mentioned machines to work and to take samples of the produce thereof. (1 *N. R.* 307.)

*(e) THE SINGER SEWING MACHINE COMPANY v. WILSON.* [1865]

Where the defendant deals in machines which are, as is alleged by the plaintiff, an infringement of his patent, the defendant will not be ordered, in a suit in respect of such infringement, to allow the plaintiff to inspect all the machines in his stock; but he will be directed to verify on affidavit the several kinds of machines that he has sold or exposed for sale, and to produce one machine of each class for inspection. It is a matter of course to grant inspection where a *prima facie* case has been made out. (5 *N. R.* 505; 12 *L. T. Rep.*, *N. S.* 140.)

*(f) PIGGOTT v. THE ANGLO-AMERICAN TELEGRAPH COMPANY.* [1868]

Inspection refused where it would have disclosed important trade secrets, and from the nature of the case, the plaintiff could have no difficulty in proving the nature of the alleged infringement used by the defendants. (19 *L. T. Rep.*, *N. S.* 46.) "The Court ought to be satisfied of two things: that there really is a case to be tried at the hearing of the cause; and that the inspection asked for is of material importance to the plaintiff's case, as made out by his evidence." (*Ib.*)

*(g) NEILSON v. BETTS.* *H. L.* [1871]

Where, as in ordinary cases, the duty of establishing that the thing patented has been pirated lies on the patentee, courts of equity grant limited orders of inspection for the purpose of enabling him to discharge that duty. Such orders cannot be granted where the piracy alleged has taken place abroad. (*L. R.*, 5 *H. L.* 1.)

*(h) SAXBY v. EASTERBROOK.* [1872]

The plaintiffs obtained a verdict in an action for the infringement of a patent; a rule to enter the verdict for the defendants was discharged; and the defendants appealed. An order was afterwards made for an account of profits, which was not appealed against, but on the parties appearing before the master for the purpose of taking the account, the defendants refused to produce

their books. The Court made absolute a rule for production and inspection of the defendants' books, and for interrogatories to the defendants, notwithstanding the pendency of the appeal. (*L. R.*, 7 *Exch.* 207; 41 *L. J.*, *Exch.* 113.)

(i) *FLOWER v. LLOYD*. C. A. [1876]

Where in a patent case the plaintiff and defendant are competitors in trade, and an order to inspect the defendant's works is made, it should be confined to scientific men, and not be made to include the plaintiff himself. (*W. N.* 1876, pp. 169, 230.) The plaintiffs alleging that when the inspection took place, the defendants fraudulently removed some of the stones alleged to be infringements, applied for a rehearing. *Held*, that the stones having been removed only to conceal the names of the customers and not for the purpose of concealing the process, there was no fraud. (10 *Ch. D.* 327.)

(j) *THE PLATING COMPANY v. FARQUHARSON*. [1879]

The plaintiffs, patentees for improvements in electro-plating, applied for inspection of the defendants' process. The defendants objected on the ground that the process was a secret one. The Court appointed an analyst to see the process and take samples of the solutions used and to report to the Court upon the facts and his opinions founded upon them. The report was perused by the judge and the leading counsel and returned to the judge, and the Court refused to allow the analyst to be called or cross-examined. (*Griff.* 187.)

(k) *GERM MILLING COMPANY v. ROBINSON*. [1885]

The assignees of a patent, which claimed the discovery of a new process or product but not any novelty in machinery, brought an action for infringement. They obtained an order for inspection of the defendants' process and took ninety-three samples. The defendants applied for an order to inspect and take samples. *Held*, that both the Court and the defendants might be materially assisted by evidence as to the mode in which the patent was worked and the product produced on behalf of the plaintiffs and that the defendants ought to be allowed inspection of the process as worked by the plaintiffs or their licensees (if willing), with liberty to take samples. (55 *L. J. Ch.* 287; 53 *L. T.* 696; 34 *W. R.* 194; 3 *O. R.* 11.)

(l) *DRAKE v. MUNTZ'S METAL COMPANY*. [1886]

In an action for infringement, the plaintiff took out a summons before delivering his statement of claim for an affidavit verifying the machines and processes used by the defendants, and for inspection. The defendants had already offered inspection. *Held*, that the plaintiff was only entitled to an order for inspection, the Court having no power to require the defendant to make an affidavit, nor to work the machines in the plaintiff's presence. Costs, costs in the cause. (*Griff.* 78; 3 *O. R.* 43.)

(m) CHEETHAM v. OLDHAM. [1888]

Inspection must be limited to those of the defendant's processes as to which a *prima facie* case of infringement has been made out. (5 O. R. 617.)

(n) GARRARD v. EDGE. [1889]

In an action for infringement of a patent for improvements in presses for pressing roof tiles, the defendants set up anticipation by dies made and sold prior to the patent. The plaintiffs asked for an order for production of all dies and parts of dies and models and drawings of dies intended to be produced by the defendants as being or representing dies used prior to the patent. The case of Nordenfelt v. Gardner was cited as a precedent for such an order, but it appeared that the order in that case was made by consent, and the Court of Appeal, affirming Kay, J., held that there was no jurisdiction to make it, except by consent. (6 O. R. 372.)

(n\*) RYLANDS v. ASHLEY'S PATENT BOTTLE COMPANY. C. A. [1890]

In an action for infringement of a patent for improvements in apparatus for manufacturing glass bottles, the defendants applied for inspection of machines which they alleged were in the power of the plaintiff. The plaintiff objected on the grounds that the machines belonged to a limited company of which the plaintiff was a director, and that he was engaged in making improvements on the machines, and it would be injurious to give inspection to a rival. *Held*, that although the plaintiff ought not to be obliged to give inspection of any modifications, yet that it would aid the Court to have inspection of the machines by which long-necked bottles had been made, and that the plaintiff must make a further affidavit as to whether any of those machines were in existence without modifications. That there was a *prima facie* case for saying he could procure inspection, and if there were such machines in existence, he must make a *bona fide* application to the company to give inspection, and make an affidavit as to the result. The company subsequently offered inspection of the machines, but not at work. The judge ordered inspection, and intimated that if it could be done without disclosing trade secrets the machine should be shown at work. (7 O. R. 175.)

*Practice—Injunction.*

1. Injunction generally.
2. Validity of patent.
3. Infringement must be shown.
4. Expired patents.
5. Procedure.
6. Order.

*Injunction generally.*

PATENTS ACT, 1883, Sect. 30. In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order



for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a Judge may see fit.

(o) *GITTINS v. SYMES.* [1854]

The rule for a writ of injunction was formerly a rule to show cause only in the first instance. (15 *C. B.* 362; 24 *L. J.*, *C. P.* 48.)

(p) *CLAYTON v. PERCY.* [1854]

The plaintiff having recovered a verdict, an order for an injunction was obtained and made a rule of court. Upon the defendant continuing the infringement after personal service of the order on him, a rule was made absolute for attachment. (48 *Leg. O.* 150.)

(q) *LISTER v. EASTWOOD.* [1855]

Where, after verdict in an action for the infringement of a patent, an order for an injunction and for an account to be taken of profits made by the defendant was applied for under section 42 of the Patent Law Amendment Act, 1852, the Court would not make an order for an injunction until it was shown that the defendant, after the verdict, had continued to infringe the patent. (3 *C. L. Rep.* 1249.)

(r) *COPELAND v. WEBB.* [1862]

Where two parties had obtained patents for the same invention, the Court of Chancery refused to interfere by injunction, and left them to try the legal right, and meanwhile ordered that the defendant should keep an account, and that the matter should stand over till the hearing. (11 *W. R.* 134; 1 *N. R.* 119.)

(s) *PLIMPTON v. SPILLER.* C. A. [1876]

An interim injunction will be granted to restrain the alleged infringement of a patent, the plaintiff undertaking to abide by any order of the Court as to damages, when the defendant's trade is a new one and in the event of the injunction not being granted, the plaintiff would have to bring a multitude of actions for infringement against the purchasers of the patented article sold by the defendant. (4 *Ch. D.* 286.)

(t) *HEUGH v. MAGILL.* M. R. [1877]

Where a patent for improvements upon a machine, the subject of a prior patent, had been put in practice by the patentee for a term of ten years, but had only been enjoyed by him without the licence of the prior patentee for about one year, it was *held* that, as the undisturbed possession of the patentee did not commence until after the expiration of the prior patent, there had not been a sufficiently long enjoyment to entitle him to an interim injunction. (*W. N.* 1877, p. 62.)

(u) *FLOWER v. LLOYD.* V.-C. B. [1877]

In an action to restrain the infringement of a patent for improvements in the method of making ornamental tin plates, the

plaintiffs obtained an injunction. The defendants, being about to appeal, moved to suspend the injunction pending the appeal, offering to give any undertaking as to damages that the Court might think fit to impose, and to prosecute the appeal with diligence, and alleged that if they were prevented from carrying out the numerous contracts they had in hand, the result would be to destroy their connection and to cause them irreparable damage :—*Held*, no ground for suspending the operation of the injunction, for that the defendants could buy the articles in the market, and so fulfil their contracts. (36 *L. T. Rep.*, *N. S.* 444.)

(v) *VAVASSEUR v. KRUPP.* C. A. [1878]

A foreign sovereign bought in Germany shells made there, but said to be infringements of an English patent. They were brought to this country in order to be put on board a ship of war belonging to the foreign sovereign, and the patentee obtained an injunction against the agents of the foreign sovereign and the persons in whose custody the shells were, restraining them from removing the shells. The foreign sovereign then applied to be and was made a defendant to the suit. An order was then made by the Master of the Rolls, and affirmed on appeal, that, notwithstanding the injunction, he should be at liberty to remove the shells. (9 *Ch. D.* 351.)

(w) *FREARSON v. LOE.* M. R. [1878]

A patentee can sustain an action for an injunction to restrain a threatened infringement of his patent, even if no actual infringement has taken place. (9 *Ch. D.* 48.)

Jessel, M.R., in delivering judgment, said : “ I am not aware of any suit or action in the Court of Chancery which has been successful on the part of a patentee without infringement having been proved ; but in my opinion, on principle, there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. . . . It seems to me, when you consider the nature of a patent right, that where there is a deliberate intention expressed and about to be carried into execution to infringe certain letters patent under the claim of a right to use the invention patented, the plaintiff is entitled to come to this Court to restrain that threatened injury. Of course, it must be plain that what is threatened to be done is an infringement.” (*Ib.* 65.)

(x) *ADAIR v. YOUNG.* C. A. [1879]

An action was brought against the master of a ship to restrain him from using pumps which were an infringement of the plaintiff's letters patent. He denied having used any pumps which were an infringement of the patent, and did not suggest that the owners ought to be parties. It was shown that the ship was fitted up exclusively with pumps which were an infringement of the letters patent, but had been so fitted up before the defendant, who was not a part owner, had taken command of her. He had nothing to do with putting them on board, and they had never been worked

in British waters. *Held*, by Brett and Cotton, L.JJ. (dissentiente James, L.J.), affirming the judgment of Bacon, V.-C., that the plaintiff was entitled to an injunction restraining the defendant from using the patented invention, on the ground that he, being in command of a ship exclusively fitted up with pumps which were an infringement of the letters patent, was intending to use the patented invention. (12 *Ch. D.* 13.)

James, L.J., in dissenting to the judgment in this case, said : " I think that an injunction ought not to be granted against a man unless he has done something which he ought not to have done, or permitted something which he ought to have prevented. Now, a master who comes on board ought not to be answerable on the ground that, when he takes the command, there is on board a pump which infringes a patent. He does not, owing to his qualified possession, become at once an infringer. . . . An injunction therefore can only be granted on the principle of *quia timet*, and in applying that principle I think it would be a right exercise of the discretion of the Court not to grant an injunction against a master, who has done nothing wrong, when there is no difficulty in finding and suing the owner of the ship. . . . Whatever appliances there may happen to be on board, however they came there, pumps, anchors, fire-extinguishers, stolen or not stolen, pirated or not pirated, it is his bounden duty to use them according to the exigencies of navigation for the safety of the ship, cargo, and life." (*Ib.* 20.)

(y) UNITED TELEPHONE COMPANY *v.* DALE. [1884]

In order to justify the committal of a defendant for breach of an injunction, it is not necessary that the order granting the injunction should have been served upon him, if it is proved that he had notice of the order *aliunde* and knew that the plaintiff intended to enforce it. This rule is not limited to cases in which a breach is committed before there has been time to get the order drawn up and entered. *Semble* : that an injunction to restrain the sale of a complete machine is violated by the sale of the component parts in such a way that they can be easily put together by any one. (25 *Ch. D.* 778.)

(z) HARVIE *v.* ROSS. [1887]

It may be a breach of interdict, but is not a contempt of Court, for a defendant against whom an injunction has been awarded to attempt to escape from its effect by manufacturing articles which he *bonâ fide* believes not to be a breach of the injunction. (4 *O. R.* 234.)

(z\*) SPENCER *v.* ANCOATS VALE RUBBER COMPANY. C. A. [1888]

The owners of a patent dated 1877 for vulcanized india-rubber springs, having brought an action to restrain infringement, the defendant company agreed to a judgment that they should be restrained from infringing the patent of 1877, but without prejudice to their right to manufacture vulcanized india-rubber springs according to an earlier and expired patent of 1866, of

which also the plaintiffs had been owners. . The plaintiffs moved subsequently to sequester the goods of the company and to commit certain of the directors for breach of the injunction, and the defendants alleged that what they were doing was covered by the proviso. *Held*, that the proviso was not intended to give the defendants a licence to use the 1877 patent so far as it was necessary for effectually working the 1866 patent, that, having regard to what was known at the time, the 1877 patent must be construed to claim as an improvement on the 1866 patent, the moulding of metal and india-rubber together before it was hardened, that the defendant company had made use of this improvement and that there had been a breach of the injunction. (6 O. R. 46.)

*Injunction—Validity of Patent—Uninterrupted Enjoyment.*

(a) *HICKS v. RAINCOCK*. [1783]

Demurrer to a bill, for an injunction to stay the infringement of a patent right, that the plaintiff had not established his right at law, overruled. (2 *Dick.* 647.)

(b) *BOULTON v. BULL*. [1796]

Injunction granted, where patentee had been in possession for twenty-seven years, that the question as to the validity of the patent might be tried. There was a verdict for the plaintiff, subject to the opinion of the Court upon a case stated. The Court was equally divided in opinion as to the validity of the patent:—*Held*, that the injunction should be continued until another action was brought. (3 *Ves.* 140.)

(b\*) *THOMSON v. MOORE* H. L. [1890]

Where a defendant has submitted to an injunction, he cannot be permitted when proceeded against for renewed infringements to question the validity of the patent. (7 O. R. 325.)

(c) *OXFORD AND CAMBRIDGE UNIVERSITIES v. RICHARDSON*. [1802]

Injunction granted or continued to the hearing, though the patentee's legal title be doubtful.

Lord Eldon said: "It is then said, in cases of this sort the universal rule is, that, if the title is not clear at law, the Court will not grant or sustain an injunction, until it is made clear at law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory, in which this Court has granted or continued an injunction to the hearing under such circumstances. In the case of patent rights, if the party gets his patent, and puts his invention in execution, and has proceeded to a sale, that may be called possession under it; however doubtful it may be, whether the patent can be sustained, this Court has lately said, possession under a colour of title is ground enough to enjoin, and to continue the injunction, till it shall be proved at law, that it is only colour and not real title." (6 *Ves.* 706.)

(d) *HARMER v. PLAYNE.* [1807]

Injunction granted, where the patentee had been in possession under the patent for thirteen years, until the right was tried at law; although considerable doubt existed as to the validity of the patent. (14 *Ves.* 130.)

Lord Eldon: "The ground upon which, where doubt is excited in the mind of the Court, an injunction is granted, until the legal question can be tried, a ground that was acted upon in the case of *Boulton and Watt*, in some cases preceding that and some that have occurred since, is this: where the Crown on behalf of the public grants letters patent, the grantee, entering into a contract with the Crown, the benefit of which contract the public are to have, and the public have permitted a reasonably long and undisputed possession under colour of the patent, the Court has thought, upon the fact of that possession, proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard, that the grant of the Crown may in the result prove to have been valid. The question is not really between the parties upon the record; for, unless the injunction is granted, any person might violate the patent; and the consequence would be, that the patentee must be ruined by litigation. In the case of *Boulton and Watt*, therefore, though a case of great doubt, upon which some of the ablest judges in Westminster Hall disagreed, yet upon the ground of the possession by the patentee against all mankind, the injunction was granted, until the question could be tried." (*Ib.* 131.) "I do not say a case might not exist where possession might be distinctly proved, and yet there might be such strong doubt whether the specification was not bad in law, that the Court would *brevi manu* interfere, and put an end to the injunction." (*Ib.* 133.)

(e) *GEORGE v. BEAUMONT.* [1815]

An injunction obtained on the grounds that the party, under pretence of treating with the patentees for a licence, had watched the process, and then practised it without a licence, will be dissolved if the validity of the patent be doubted, and an account will be ordered to be kept of the extent to which the invention has been practised, until the validity of the patent can be tried at law. (27 *Rep. Arts, 2nd Series*, 252.)

(f) *HILL v. THOMPSON.* [1817]

Where there has been a length of exclusive enjoyment under a patent, the Court will grant an injunction in the first instance, without previously putting the party to establish his right at law; otherwise where the patent is recent and its validity is disputed. Sometimes the Court will direct the party, against whom the application is made, to keep an account pending the discontinuance of the injunction. (3 *Mer.* 622.)

The injunction having been dissolved, with liberty to the

plaintiff to bring an action to establish his patent right, and the defendants to keep an account in the meanwhile; a verdict having been obtained for the plaintiff on the trial of the action, on application being made to revive the injunction, it was objected that the defendants intended to move for a new trial; and the matter was ordered to stand over till the result of that application should be known, the parties continuing to keep the account in the interim. (*Ib.* 631.)

(g) *RUSSELL v. BARNESLEY.* [1834]

The fact of the pendency of an action against another party, is not a sufficient ground for continuing an *ex parte* injunction, without putting the plaintiff to bring an action against the new defendant. (1 *Web. P. C.* 472.)

(h) *RUSSELL v. COWLEY.* [1834]

Lord Lyndhurst: "This Court having directed a trial at law, and the jury having found for the patentee, and a motion that the verdict should be set aside and a nonsuit entered having failed, it is quite of course that an injunction should be issued until the hearing of the cause." (2 *Coop. C. C.* 59 (n).)

(i) *MORGAN v. SEAWARD.* [1835]

Where the plaintiff is assignee of the patent the Court may, on directing a trial instead of granting an injunction, accept the defendant's undertaking to admit the plaintiff's title to the patent. (1 *Web. P. C.* 169.)

(j) *KAY v. MARSHALL.* [1836]

Lord Cottenham, L.C., said: "The equitable relief flows from the legal title, and the question is whether, upon the statements in the bill, the Court can take upon itself to decide that the plaintiff has no legal title. If the plaintiff, asking for equitable relief upon the ground of a legal title, states upon his bill a title which cannot be supported at law, the defendant may take advantage of it by demurrer." (2 *Web. P. C.* 42.)

(k) *BEESTON v. FORD.*

Per Lord Lyndhurst: "There may be considerable doubt as to the validity of a patent; still, if there has been a long exclusive enjoyment, the doctrine of the Court is that an injunction shall go to protect the patent, until the question of its validity is duly determined at law." (2 *Coop. Ch. Ca.* 58.)

(l) *LUKIE v. ROBSON.* [1837]

An *ex parte* injunction having been obtained, and suffered to go undisturbed for two years, and the specification appearing free from obscurity and the evidence of novelty sufficient:—*Held*, that the Court could not be doing wrong in upholding the injunction. (9 *Rep. Arts, N. S.* 55.)

(m) *BICKFORD v. SKEWES.* [1838]

Shadwell, V.-C.: "Whatever may be the objection to the specification, this Court is bound to look to the fact that there has been an enjoyment under the patent, as a sort of practical answer to the theoretical objection." Interlocutory injunction granted after enjoyment for six years. His Lordship, however, said: "I admit that if you were to say six years are sufficient, you may, by cutting off successive portions, reduce the six years to nothing. But I have nothing to do with any other case than the case before me." (1 *Web. P. C.* 213.)

(n) *COLLARD v. ALLISON.* [1839]

Although a patent is of long standing, yet if, from the nature of the alleged invention, or the conflicting evidence as to its novelty, its validity appears to be doubtful, or if the evidence of exclusive possession is not satisfactory, the Court will not grant an injunction until the title has been established at law.

After the patentee had obtained a verdict in an action brought to try the validity of the patent, the Court refused to grant an injunction to restrain the infringement of the patent, on the ground that a rule *nisi* for a new trial had been obtained and was pending in the court of law, and that the legal title of the patentee was therefore still undecided. (4 *M. & C.* 487.)

(o) *CURTIS v. CUTTS.* [1839]

Lord Cottenham: "The rule upon which the Court acts in granting an injunction, where the validity of the patent alone is disputed, requires, not merely that there shall have been possession and enjoyment under the patent, but such possession and enjoyment must have been undisturbed and exclusive." (2 *Coop. C. C.* 60 (n).)

(p) *BICKFORD v. SKEWES.* [1839]

When the Court has interfered, in aid of a legal right, by granting an injunction upon the terms of the plaintiff's bringing an action, it will deprive the plaintiff of the injunction if he does not commence and proceed with his action with due promptness; but it will not do this if the defendant has been supine in the cause. (4 *My. & Cr.* 498; 8 *L. J., Ch.* 188.)

(q) *NEILSON v. HARFORD.* [1841]

Where the plaintiff was directed to proceed at law, in order to try the validity of his patent, and obtained judgment, an injunction was allowed almost as a matter of course. (1 *Web. P. C.* 373.)

(r) *NEILSON v. FORMAN.* [1841]

The legal right of a plaintiff ought to be established beyond all possibility of doubt before the Court will be justified in granting an injunction, which, by stopping extensive works, will do a

mischief to the defendant that, if the plaintiff do not succeed, can never be repaired. (2 *Coop.* 61 (n).)

(s) *MUNTZ v. GRENFELL.* [1842]

Per Knight Bruce, V.-C.: "The patent having been worked by the plaintiff and defendant as partners, under circumstances affording a presumption that the defendant did not, during the existence of the partnership, dispute that the patent was valid, the Court of Chancery will, upon an interlocutory application for an injunction, assume that the patent is valid." (2 *Coop.* 61 (n).)

(t) *MUNTZ v. FOSTER.* [1843]

Upon an appeal, from an order of Bruce, V.-C., for an injunction to restrain the infringement of a patent, Lyndhurst, L.C., said: "The patentee has been in possession of his exclusive privilege for several (eleven) years, and the Court will not, on any suggested defect of the specification, allow the enjoyment of that privilege to be disturbed until the title has been decided in a court of law." (2 *Web. P. C.* 95.)

(u) *BRIDSON v. M'ALPINE.* [1845]

Motion for an injunction to restrain an infringement ordered to stand over for the plaintiff to bring an action to establish his right. The plaintiff obtained a verdict, but the defendant tendered a bill of exceptions, which could not be determined without some considerable delay. Upon the motion being renewed, the Court, under the circumstances, ordered it to stand over till the bill of exceptions had been disposed of. (8 *Beav.* 229.) Where it is not clear either that the patent is legally valid or that it has been infringed, it depends on the degree of doubt which exists on these questions whether the Court will grant the interim injunction. In such cases the Court will cautiously consider the degree of convenience and inconvenience to the parties, and according to the doubt and the degree of inconvenience may either refuse to grant the injunction simply or refuse it on terms of the party undertaking to keep an account, or may direct the motion to stand over on terms of plaintiff proceeding to a trial at law. (*Ib.* 230.)

(v.) *DIRCKS v. MELLOR.* [1845]

If the defendant admit the validity of the patent, the title of the plaintiff and its infringement by him, the Court will at once issue its injunction with costs. (26 *Lond. Jour.* 268.)

(w) *HEATH v. UNWIN.* [1847]

The plaintiff, having obtained a patent for an improved method of making steel by the application of carburet of manganese, brought an action against the defendant for infringing his patent by using two ingredients, which, when fused, would produce carburet of manganese. The Court of Exchequer held that the patent had not been infringed, either directly or indirectly, because



the defendant was ignorant of the fact that he was using the same substance as that employed by the plaintiff. A motion for an injunction upon a bill filed prior to the action was now opposed, on the ground that the decision of the court of law was final, and the bill ought to be dismissed. The Court considered that although the act was committed unconsciously, the defendant was liable for the injury he had done, and consequently retained the bill, and gave liberty to the plaintiff to bring another action. (16 *L. J.*, Ch. 283.)

(x) *THE ELECTRIC TELEGRAPH COMPANY v. NOTT.* [1847]

As a general rule, the Court ought not to give its aid to the legal right by injunction unless satisfied, the legal right being disputed, that in the result such legal right will be established; or, the legal right not being disputed, that the acts complained of are a violation of it. There is an exception where the sole question is the validity of a patent, and there has been a user of the patent, and an exclusive enjoyment under it for a reasonable time. The Court will in such a case interpose by injunction, until the validity of the patent has been ascertained by a trial at law. But where, though the validity of the patent is not disputed, yet there is conflicting evidence upon the question of infringement, the general rule applies, the Court will not grant an injunction until it has been ascertained by a trial at law that there has been an infringement. (2 *Coop.* 41.)

(y) *STEVENS v. KEATING.* [1847]

Application to restrain defendant from infringing plaintiff's patent. Shadwell, V.-C., said: I think, "with reference to the very language used in *Kay v. Marshall*, that where a patent has been taken out for several years, and there has been a dealing upon it, a user of it, that it is not, at the end we will say of twelve years, to be set aside merely because speculations may be made of more or less force upon its validity as regards the language of the specification. I cannot but myself think, therefore, that in this case there has been such a *prima facie* established legality of the plaintiff's patent, that it is the duty of the Court to grant the injunction; but the plaintiff, of course, must be put to bring such action as will try the validity of the patent, and then the defendant will have the opportunity of trying the question fairly." (2 *Web. P. C.* 176.) Affirmed on appeal, Cottenham, L.C., said: The rule, that "in doubtful cases great care ought to be taken by this Court not to grant an injunction which is at all likely to prove unfounded . . . is confined to cases where there is a serious doubt in the mind of the judge as to whether the title to the injunction is made out or not, for if the Court sees that there is a clear case for an injunction, it would be absurd to say, go to law and prove that which you have already proved here, before I grant an injunction. In patent cases, however, a rule steps in which is quite consistent with the general rule to which I have just referred, and, indeed, is only an instance

of the exception which a correct statement of that rule must always include, viz., that long and uninterrupted possession shall be considered such *prima facie* evidence of title as to justify the Court in protecting the patent right by an injunction until its invalidity, if it be invalid, shall have been established by an action at law." (2 Ph. 335; 2 Web. P. C. 177.)

(z) CROSSKILL v. EVORY. [1848]

Though a patentee had enjoyed his patent for a considerable time, and had succeeded in several actions for an infringement thereof in upholding his patent, yet there being a new infringement by a different party, an injunction to restrain him was refused until after a trial at law. (10 L. T. Rep. 459.)

(a) BRIDSON v. BENECKE. [1849]

The plaintiff having been put to establish his legal right, succeeded on the trial, but the defendants tendered a bill of exceptions. An injunction was granted, under the circumstances, before the bill of exceptions had been disposed of. (12 Beav. 1.)

(b) CALDWELL v. VANVLISSENGEN. [1851]

Injunction granted against subjects of the kingdom of Holland, to restrain them from using on board their ships within the dominions of England, without the licence of the plaintiffs, an invention, to the benefit of which the plaintiffs were exclusively entitled under the Queen's patent, the title of which had been maintained at law against several attempts to impeach it. Where a legal right exists, the Court cannot refuse to interfere for its protection, upon grounds which depend exclusively on considerations of national policy. (9 Hare, 415; 21 L. J. Ch. 97; 16 Jur. 115.)

Turner, V.-C.: "Where there has been long enjoyment under the patent (the enjoyment of course including use), the public have had the opportunity of contesting the patent; and the fact of their not having done so successfully affords, at least *prima facie*, evidence that the title of the patentee is good; and the Court therefore interferes before the right is established at law." (9 Hare, 424.)

(c) BAXTER v. COMBE. Ir. Ch. [1851]

On a motion for an injunction to restrain the infringement of a patent, an order was made that the motion should stand until the plaintiff brought an action at law. There was a verdict for the plaintiff, and the defendant tendered a bill of exceptions, pending which the motion was renewed; the Court granted an injunction, the plaintiff undertaking to abide any order which the Court might make, by directing an issue, or otherwise, to ascertain the damage, if any, which the defendant should sustain by obeying the order, in case the defendant should obtain judgment in the action at law. (3 Ir. Ch. R. 245.)

## (d) BROWN v. KIDSTONE. [1852]

The patent was not obtained for Scotland till some months after it had been obtained for England. In the interval a description of the invention had appeared in a magazine circulated in Scotland:—*Held*, that this publication created such a *prima facie* objection to the patentee's title, that he could not interdict parties in Scotland alleged to be using the invention without a licence. (1 S. M. & P. 769.)

## (e) NEWALL v. WILSON. [1852]

Where a patent had been in force for twelve years, and had been the subject of four suits against different persons, all of which terminated favourably to the patentee, and in two of which verdicts had been given in favour of the validity of the patent:—*Held*, that in a fifth case, the patentee was entitled to an injunction pending the trial of the legal right, although a fresh fact was brought forward, tending to impeach the novelty of the invention. (2 De G., M. & G. 282.)

## (f) HANCOCK v. MOULTON. [1852]

Length of time and uninterrupted enjoyment of a patent give a colour of right even where there has not been a trial at law. The Court ought not to grant an injunction to restrain an infringement of a patent before a trial at law, unless the evidence of infringement be such that the Court would on the same evidence commit the defendant for a breach of the injunction. (M. Dig. 506.)

## (g) LISTER v. EASTWOOD. [1855]

Where a patentee had brought an action for damages, and at the trial an arbitration had been agreed to, upon which the arbitrator by his award had established the validity of the patent, and the patent had been again invaded; the Court, upon a bill filed for an injunction to restrain the infringement, *held*, that the award of the arbitrator must be considered as equivalent to a verdict establishing the validity of the patent, against which there had been no motion for a new trial. (26 L. T. Rep. 4.)

## (h) GARDNER v. BROADBENT. [1856]

Sir J. Stuart, V.-C., said: "If the plaintiff is in a position to support by proper evidence his title to the patent, and to prove the fact of its having been infringed, he is in every other respect, in spite of the recency of its date (1855), entitled to move in this court *ex parte* for an injunction. . . . There is no law of this court which prevented a patentee by the recency of his patent from applying for an injunction *ex parte*; and I wish it to be understood that the law of the court is that laid down by Lord Eldon in the case of *The Universities of Oxford and Cambridge v Richardson*," (2 Jur., N. S. 1041.)

(i) *BETTS v. MENZIES*. [1857]

Where there is doubt as to the validity of the plaintiff's patent, but he has had eight years of undisturbed enjoyment under it, and the defendant had neglected to dispute the validity of the patent on a former occasion, when he had the opportunity of doing so, an injunction was granted, and plaintiff ordered to proceed to trial at law. (3 *Jur. N. S.* 357.)

Wood, V.-C.: "The law of this court is, that where the patentee has had long enjoyment, there he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful." (*Ib.* 358.)

(j) *CLARK v. FERGUSON*. [1859]

Bill for an injunction to restrain the defendants from working the plaintiff's patent, dated April, 1859, for an improved kind of block for lowering boats. The defendants were employed to manufacture blocks for the plaintiff, but having, as they claimed, discovered an improvement on the plaintiff's invention, they requested the plaintiff to introduce such alleged improvements into his specification, and allow the defendants a share of the profits. The plaintiff having refused this the defendants applied for a patent, and claimed a right to work their invention independently of the plaintiff. Injunction granted, under the circumstances, in spite of the recent date of the plaintiff's patent. (1 *Giff.* 184.) Sir J. Stuart, V.-C.: "It is not a mere matter of course, because a patent is recent, to call on the patentee to establish his rights at law before he can obtain relief in this court. It is in the discretion of the Court to require a plaintiff to assert his rights at law or otherwise, according to the nature of the case." (*Ib.* 187.)

(k) *HILLS v. EVANS*. [1862]

Lord Westbury: "It is the habit and the rule of a Court of Equity not to grant that injunction (to restrain infringement), at all events at the hearing, and not to make it perpetual unless the legal validity of the patent has been conclusively established." (4 *De G., F. & J.* 289.)

(l) *DAVENPORT v. JEPSON*. [1862]

The Court will, since the 25 & 26 Vict. c. 42, enter into the question of the validity of a patent on a motion for an interim injunction. The powers of the Court are not limited by the above Act. (1 *N. R.* 173.)

(m) *RENARD v. LEVINSTEIN*. [1864]

Lord Justice Knight Bruce: "It is necessary, to support a motion to dissolve an injunction, that there should be at least a fair *prima facie* case in the opinion of the judge or judges who may have to decide the matter as to the validity of the specification; if not in every patent case, at least in one which arises upon a patent of no great age. . . . With a patent no older than the present patent is (three years), though its age is no objection to an inter-

locutory injunction of itself, in the present stage of the cause there ought to be no injunction, and upon that ground alone I am of opinion that this injunction should for the present be dissolved." Defendant to keep an account. (10 *L. T. Rep., N. S.* 177.)

(n) *DAVENPORT v. GOLDBERG.* [1865]

Where the plaintiffs have had thirteen years' user of their patent, their right to which had been established, once at law and once in a Court of Chancery, the validity of the patent is *primâ facie* sufficiently established as against an infringer. (2 *H. & M.* 282.)

(o) *BOVILL v. GOODIER.* [1866]

A defendant is not to be concluded by a trial at law, establishing the validity of the patent, to which he is no party, and is not to be driven to contest the validity of the patent by a *scire facias*. (35 *Beav.* 427.)

(p) *PENN v. BIBBY.* [1866]

After a trial before the Vice-Chancellor, without a jury, in which issues were found for the plaintiff, a motion for a new trial having been refused by the Vice-Chancellor, and on appeal refused by the Lord Chancellor, was being taken by appeal to the House of Lords. The Court declined to suspend the final order for an injunction, pending the appeal to the House of Lords. (*L. R.*, 3 *Eq.* 308; 36 *L. J.*, *Ch.* 277.)

(q) *THE WILLCOX AND GIBBS SEWING MACHINE COMPANY v. WOOD.* [1869]

The Court refused to restrain the defendants from selling as the plaintiffs' sewing machines, "with the latest improvements," old sewing machines manufactured and patented by the plaintiffs without such improvements. (20 *L. T. Rep., N. S.* 10.)

(r) *DUDGEON v. THOMSON.* [1874]

Sir G. Jessel: "The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent."

The fact of an interdict having been granted against the defendant by the Court of Sessions in January, 1873, held to be sufficient *primâ facie* evidence of the validity of a patent for the United Kingdom granted in 1866, to warrant the Court granting an interlocutory injunction. (30 *L. T. Rep., N. S.* 244.)

(s) *PLIMPTON v. MALCOLMSON.* [1875]

An injunction to restrain an alleged infringement will not be granted on an interlocutory application, unless it can be shown that there has been active user of the invention, even where the

patent has been in force for eight years. (*L. R.* 20 *Eq.* 37; 44 *L. J.*, *Ch.* 257.)

(*t*) *JACKSON v. NEEDLE.* [1884]

Formerly the Court was not in the habit of granting injunctions to restrain infringements until the title had been established by an action at law. That rule no longer applies, but at the same time the Court has not shown the same disposition to grant injunctions where the patent said to be infringed is of recent date. So far, at any rate, as cases arising before the Act of 1883 are concerned, the Court abstains from interfering by injunction in the case of a recently dated patent, when there is really a substantial question to be tried. Under the Act of 1883 the question which has still to be determined is, whether the investigation and protection which is given to the public under sects. 10 and 11, may alter this rule when the owner of a patent of recent date comes for an interim injunction. (*Griff.* 132; 1 *O. R.* 174; 2 *O. R.* 191.)

(*u*) *LISTER v. NORTON.* [1884]

Chitty, J.: "As to what is exactly a recent patent, and what is a patent of sufficient age to support an injunction, that is a matter no doubt more or less of discretion. But the discretion is limited by the practice; and according to my recollection of the practice a patent three years old would not be sufficient where it is disputed." (*Griff.* 148; 1 *O. R.* 114, at p. 115.)

(*v*) *BRIGGS v. LARDEUR.* [1884]

In an action for infringement if the patent is, on the face of it, so hopelessly and irretrievably bad that it is absolutely impossible that it could be supported, the Court will consider before granting an interim injunction, but where a patent has not been challenged for ten years, the Court ought to assume for the purposes of a motion for an interim injunction that the patent is a good patent; leaving it open till the case comes on for trial to determine that the patent is as bad a patent as was ever taken out. (*Griff.* 55; 1 *O. R.* 126.) There was an appeal, but owing to a settlement it was not heard. (1 *O. R.* 192.)

(*w*) *ROTHWELL v. KING.* [1886]

Bristowe, V.-C. (citing *Davenport v. Jepson*): "Where there has been long enjoyment (in that case it was nine years), the Court will not refuse an interlocutory injunction merely on the ground that the defendant if ultimately successful will have been more injured by its being granted than the plaintiffs by its not having been granted." User for six years held sufficient where there had been no action fought, but the plaintiffs had on four different occasions induced people to discontinue infringing. (3 *O. R.* 379, at p. 380.)

(*x*) *BRITISH TANNING COMPANY v. GROTH.* [1889]

The plaintiffs owned a patent two years old for improved apparatus for tanning by aid of electricity, and moved for an interim

injunction against the defendant who was working a subsequent patent for the same purpose. The defendant denied the validity of the plaintiffs' patent, and alleged that the patentees had entered into an agreement with him not to oppose any company formed to purchase his invention. *Held*, that as the patent was of recent date, and it was not clear that the processes were identical, and having regard to the agreement, although the defendant refused to undertake to keep an account, no order should be made, except that the motion stand to the trial. (7 O. R. 1.)

*Injunction—Threats of or actual Infringement must be shown.*

(y) *HILL v. THOMPSON*. [1817]

Lord Eldon, L.C.: "The affidavits in support of the injunction represent, that the defendants have made iron in the way mentioned in the specification. But, whether it is to be considered as a patent for extracting iron from slags or cinders, by working and smelting, and by the admixture of certain materials, to reduce the percentage to 40 per cent., or for mixing cinders, limestone, and mine rubbish in certain proportions; it should, before any injunction was granted, have been pointed out that the patent was actually infringed by so mixing the ingredients, or so reducing the percentage." (3 *Mer.* 625.)

(z) *WOOD v. COCKERELL*. [1819]

Per Lord Eldon: "Where there is one question whether a patent is valid, and another question whether it has been infringed, the Court of Chancery would be going a great way if it took upon itself to grant an injunction." (2 *Coop.* 58 (n).)

(a) *ABBOTT v. WILLIAMS*. [1837]

A party will be restrained from selling an article in such a state that it may be applied by others so as to infringe a patent, though they may not be restrained from applying it themselves to a different purpose. (9 *Rep. Arts.* 103.)

(b) *LOSH v. HAGUE*. [1837]

An injunction being applied for, it is not sufficient for the defendant to admit the infringement and promise not to repeat it, the plaintiff is still entitled to an injunction. (1 *Web. P. C.* 200.)

(c) *DAVENPORT v. RICHARDS*. [1860]

Where there is a *prima facie* case of infringement of a patent, the length of time which the patent has been enjoyed by the patentee will influence the Court in granting an injunction against the parties who are alleged so to have infringed upon the patentee's rights. (3 *L. T. Rep., N. S.* 503.)

(d) *NEILSON v. BETTS*. H. L. [1871]

Where an alleged piracy has taken place abroad it becomes the duty of the defendant to give evidence of a negative character to prove (in answer to the *prima facie* case made by the patentee)

that the process used was of a different character from that which had been patented. Where that negative evidence was not given by the defendant, but positive evidence on the part of the patentee was given by one workman that he had been employed at the foreign manufactory, and there saw the capsules manufactured by a process not distinguishable from that of the patentee:—*Held*, that these circumstances justified the conclusion of identity of material and process, and were sufficient warrant for the grant of injunction. (*L. R.*, 5 *H. L.* 1.)

(e) *BETTS v. WILLMOTT*. [1871]

In a suit to restrain the sale of a patented article, it is incumbent on the plaintiff not only to prove the sale, but to prove that the article was not made by himself or his agents. (*L. R.*, 6 *Ch.* 239; 19 *W. R.* 369.)

(f) *SHILLITO v. LARMUTH*. [1884]

Where the patent was ten years old, and was therefore for the purposes of the motion assumed to be good:—*Held*, by Bristowe, V.-C., that the plaintiff need only satisfy the Court for the purposes of the interlocutory application that there is a *prima facie* case as regards the infringement which it is alleged will be proved at the trial. (2 *O. R.* 1.)

(g) *PROCTOR v. BAILEY AND SON*. C. A. [1889]

Machines which had been held in the case of *Proctor v. Bennis* to be an infringement of the plaintiff's patent, which had been held valid, were put up by Bennis on the defendants' premises in 1882, on the terms that they were to be paid for only if successful. Their use was discontinued after a few months as they were not successful, and Bennis was asked to take them away but did not do so until 1885. Bristowe, V.-C., held that there had been infringement, and that although there was no threat to continue it, the plaintiff was entitled to an injunction in aid of his legal rights. *Held*, by the Court of Appeal, that although the defendants had denied in their defence that what they had done was within the scope of the plaintiff's patent, yet that as it was impossible in the face of the other facts in the case to infer from this that the defendants had any intention to continue infringing, an injunction could not be granted, and that as the Palatine Court had only power to grant damages in a case where it was proper to grant an injunction, there was no jurisdiction, and the action must be dismissed. (6 *O. R.* 106, 538.) [But now see 53 & 54 *Vict. c.* 23 s. 3.]

*Practice—Injunction—Delay and Acquiescence.*

(h) *LOSH v. HAGUE*. [1837]

Sir L. Shadwell, V.-C.: "On the 23rd of March, the plaintiff received some information that there was an evasion of his patent, and some portion of time it appears was spent in making inquiries; there was notice given distinctly on the 8th of May. Then some



further correspondence takes place, and letters between the parties ; and then a bill is filed, on the 7th of July, and the application is virtually made. I cannot but think, therefore, that the plaintiff has come in sufficient time." (1 *Web. P. C.* 201.)

(i) *BACON v. JONES.* [1839]

The plaintiff knew of the alleged infringement in August, 1835, but did not apply for an injunction till 1839. The Court refused to grant an injunction or to retain the bill. (4 *My. & Cr.* 438.)

Lord Cottenham, L. C., said: "It is no trifling grievance to a defendant to have a chancery suit hanging over him for four years, in which, if the Court shall so determine at the hearing, he will have to account for all the profits he has been making during the intermediate period. Is a defendant to be subject to this annoyance without any absolute necessity, or even any proportionate advantage to his adversary, and without that adversary being able to show any reason why he did not apply at an earlier time?" (*Ib.* 439.)

(j) *BRIDSON v. BENECKE.* [1849]

A special injunction, on notice, to prevent the infringement of a patent refused, on the ground of delay, notwithstanding the plaintiff's long enjoyment under the patent, and the establishing of its validity in an action against another party. The plaintiff discovered the infringement in January, but did not file his bill till the following December. (12 *Beav.* 1.)

Lord Langdale, M.R., said: "I think that a party coming for the assistance of this Court to protect a legal right, not absolutely established, against the party who is alleged to have infringed it, ought to come at an early period. I do not say, at the earliest possible period, because that would be putting an application for an injunction on notice, where all parties have an opportunity of being heard, in the same condition as an injunction *ex parte*, which it would not be expedient to do. The rule of this Court is very strict, that you must apply in proper time." (*Ib.* 3.)

(k) *BAXTER v. COMBE.* Ir. Ch. [1850]

Delay in filing the bill is a ground for refusing the injunction.

Where the patent was obtained in 1846, the alleged infringement of it took place in 1847, and the bill was not filed for more than two years afterwards, the injunction was refused. (1 *Ir. Ch. R.* 284.)

(l) *HANCOCK v. MOULTON.* [1852]

A patentee is not bound to bring actions in respect of every infringement, but in order to support an injunction against an infringer, who has been permitted to go on for some time, and against whom no action has been brought, distinct notice ought to be given to him that the patentees would seek to enforce their right. (*M. Dig.* 506.)

## (m) NEWALL v. WILSON. [1852]

A patentee does not acquiesce in the infringement of his patent by omitting to proceed by *scire facias* to set aside a subsequent patent extending to part of his invention, unless such subsequent patent is put in practice. (2 De G., M. & G. 282.)

## (n) SMITH v. THE LONDON AND SOUTH WESTERN RAILWAY COMPANY. [1854]

The owners of a patent for a peculiar mode of manufacturing iron wheels for railway carriages, having discovered that several railway companies were violating their patent, brought an action for damages against one of such companies only, but did not in any way give notice to the other companies to discontinue their infringements of the plaintiffs' right. In the action, the validity of the patent was disputed, and it was not decided until three years after the patent had expired, when a verdict was given for the plaintiffs, with large damages. Thereupon the plaintiffs filed a bill for an account of profits, and an injunction against another of the companies who had infringed their patent, complaining of acts done nine years before:—*Held*, that the delay was not excused by the pendency of the action, but was fatal to the plaintiffs' case. (*Kay*, 408.)

## (o) BOVILL v. CRATE. [1865]

Where an interlocutory injunction to restrain infringement of a patent was moved for in a suit in which the bill was filed in July, and it appeared that the plaintiff wrote complaining of the infringement in the preceding November, and knew of the defendant's proceedings in the previous August, the injunction was refused on the ground of delay. (*L. R.*, 1 *Eq.* 388).

## (p) OSMOND v. HIRST. [1885]

On a motion for an interlocutory injunction to restrain infringement in 1885, it appeared that the defendants manufactured under a patent dated 1882:—*Held*, that as the defendants might have cross-examined the plaintiff or proved *aliunde* that he stood by and suffered the defendants' patent to be worked, there had been no laches shown on the part of the plaintiff. (*Griff.* 179; 2 *O. R.* 265.)

## (q) READ v. ANDREW. [1885]

On an application for an interlocutory injunction it appeared from the plaintiffs' affidavits that the defendants had taken over the business of John Andrew and Company, who were supplied by the plaintiffs with the patented preparations in 1873, and had used these preparations since that date:—*Held*, no ground for refusing an interlocutory injunction. (*Griff.* 201; 2 *O. R.* 119.)

## (r) GREER v. BRISTOL TANNING COMPANY. [1885]

The plaintiffs commenced an action for infringement, and on December 2nd moved for leave to serve notice of motion, and for

an interim injunction:—*Held*, that as they had had evidence of infringement on November 13th, and had not applied at once the interim injunction *ex parte* must be refused. (2 O. R. 268.)

(s) THOMSON v. BATTY. [1888]

The plaintiff discovered in 1885 that the defendant, a nautical instrument maker, was making and advertising a compass card alleged to be an infringement of the plaintiff's patent. Correspondence ensued, but proceedings were not actually taken until 1888, the plaintiff saying that he was not previously aware of actual sales by the defendant. An interim injunction was refused on the ground of delay, the costs being reserved. (4 T. L. Rep. 36.) At the hearing it turned out that the plaintiff had known of this infringement for over two years:—*Held*, by Kekewich, J., that, nevertheless, as the plaintiff was successful in the action the costs of the application should be costs in the cause. (6 O. R. 84.)

(t) UNITED TELEPHONE COMPANY v. EQUITABLE TELEPHONE COMPANY [1888]

The Equitable Telephone Company had written to the plaintiffs in February 1887, saying that they intended to manufacture and sell the S. telephone, and inviting the plaintiffs to contest their right to do so. The plaintiffs took no notice until March 1888, when they commenced an action, and explained the delay by saying that their solicitors advised them not to bring an action until the defendants had a substantial capital and were selling the telephone:—*Held*, that the delay did not disentitle them to an interlocutory injunction. (5 O. R. 233.)

#### *Practice—Injunction—Expired Patents.*

(u) CROSSLEY v. BEVERLEY. [1829]

Injunction granted generally to restrain the sale, both before and after the term limited by the patent, of machines piratically manufactured while the patent was in force. (1 R. & M. 166; 1 Web. P. C. 119.)

(v) CROSSLEY v. THE DERBY GAS LIGHT COMPANY. [1834]

Although a patent has expired, the Court will grant an injunction to restrain the sale of articles manufactured in fraud of that patent previous to its expiration. (4 L. J., Ch. 25.)

(w) PRICE'S PATENT CANDLE COMPANY v. BAUWEN'S PATENT CANDLE COMPANY. [1858]

On the 28th of November, 1856, the plaintiffs filed a bill for an injunction to restrain the defendants from infringing their patent. On the 10th of December the motion was heard, and ordered to stand over until the hearing, the plaintiffs to bring an action. At the hearing it appeared that the plaintiffs had obtained a verdict, and the defendants admitted that, down to the 8th of December, they had used the plaintiffs' patent process, but denied that they now had in their possession any candles or substances

of which the bill sought to have an account:—*Held*, that, under these circumstances, the Court could not grant an injunction, and consequently could not decree an account. (4 *K. & J.* 727.)

(x) *DAW v. ELEY.* [1867]

A. obtained, in a suit against B. for infringement, a decree by which the validity of the patent was declared, and an injunction was granted to restrain infringement. Upon motion to commit B. for breach of the injunction:—*Held*, that it was open to B., in answer to the motion to commit, to show that, the patent having been determined, there was no longer any order of the Court in existence which he could be said to have infringed. (*L. R.*, 3 *Eq.* 496; 36 *L. J.*, *Ch.* 482.)

*Procedure on Application for Injunction.*

(y) *BACON v. JONES.* [1839]

A patentee having filed a bill to restrain an alleged infringement, made no interlocutory application for an injunction, but went into evidence in support of his case, and brought the cause to a hearing. The Master of the Rolls, being of opinion that the plaintiff, upon the evidence, had not made out a case which would have supported an injunction if applied for in the interlocutory stage, refused to give him an opportunity of establishing his title at law, and dismissed the bill with costs; and the Lord Chancellor, on appeal, affirmed this decision. (4 *My. & Cr.* 433.)

(z) *BACON v. SPOTTISWOODE.* [1839]

Where a bill is filed by a patentee for an injunction to restrain an alleged infringement of his patent, the plaintiff is not precluded from asking for an injunction at the hearing by the fact of his not having applied for it on an interlocutory motion; but the not moving for the injunction imposes on the plaintiff, in such a case, the obligation of making out a clear and unexceptional title at the hearing; and if he fails in that, and has not previously obtained an injunction, he will not be allowed to use the facts proved in the cause as evidence of a *prima facie* case, giving him a right to further time, for the purpose of enabling him to establish more satisfactorily his legal title. (1 *Beav.* 382.)

(a) *BRIDSON v. M'ALPINE.* [1845]

Lord Langdale, M.R.: “Where an injunction is asked to restrain the infringement of a patent, the Court has occasion to consider—first, the validity of the patent; and, secondly, the fact of the infringement. Where those two facts are established, it is within the power, as it is the duty of the Court, to grant the injunction.”

“According to the doubt which may exist in the mind of the Court upon the facts, and, according to the degree of inconvenience to the parties, the Court, not thinking fit to grant the injunction at the time, may take one of several courses: it may either refuse to grant the injunction simply, or it may refuse it on

the terms of the party undertaking to keep an account, or it may direct the motion to stand over, on the terms of the plaintiff proceeding to a trial at law. When it has been determined that the plaintiff must first establish his right at law, the Court does not generally interfere with the mode of trying the legal question, though in some instances it may require the parties to make the necessary admissions of facts to facilitate the trial. It is to be remembered that the proceeding is not like the trial of an issue, but an action in the ordinary form, with which, generally speaking, the Court will not interfere until the legal right has been determined at law. I must, however, qualify this by saying that, in cases of overwhelming mischief, this Court has authority to interfere at any time." (8 *Beav.* 230.)

(b) *STEVENS v. KEATING.* [1847]

When the Court grants an injunction, the order ought not merely to direct that an action shall forthwith be brought, with liberty to the parties to apply in case of delay, but to give such directions of its own, in the first instance, as will insure the speedy trial of the action. An injunction granted pending an action to be brought by the plaintiff, for the speedy trial of which special directions were given, was dissolved on the ground of the plaintiff not having duly complied with those directions. The plaintiff to keep an account. (2 *Ph.* 333.)

(c) *THE PATENT TYPE FOUNDRY COMPANY v. WALTER.* [1860]

Sir W. Page Wood, V.-C.: "With respect to obtaining a perpetual injunction, the rule is established by *Bacon v. Jones*, that in patent cases, unless the plaintiff takes steps to bring the matter before the Court by motion before the hearing, he will not, in general, be entitled to a perpetual injunction at the hearing. He is therefore not at liberty to wait for the hearing, but the Court requires him to place the matter in course of investigation at the earliest possible period." (*John*, 730.)

(d) *MAYER v. FIRTH.* [1860]

In a suit for an injunction to restrain the defendants from infringing the plaintiff's patent, and for an account, &c., the plaintiff may move to proceed with an action at law to try the right, on a proper affidavit, without previously moving for an injunction. (2 *L. T. Rep.*, N. S. 536.)

Practice—Injunction—Order.

(e) *BETTS v. DE VITRE.* [1865]

See this case as modified on appeal for form of order for a perpetual injunction to restrain defendants from further infringement of a patent; as to costs personally against directors of a limited liability company, and as to accounts and inquiries to ascertain damages sustained by a patentee in consequence of the infringement of a patent. (12 *L. T. Rep.*, N. S. 51.)

(f) *MURRAY v. CLAYTON.* [1872]

The plaintiff was patentee of a brick-making machine. The defendants patented another machine, which was held by the Lords Justices, overruling the decision of the Vice-Chancellor, to be an infringement of the plaintiff's patent on the ground that the plaintiff's machine was entitled to protection as a new and useful combination of well known parts. By the terms of the order the defendants were restrained from selling any machines similar to those of the plaintiff and generally from imitating the plaintiff's invention, "or any part thereof or making any addition thereto or subtraction therefrom." The defendants shortly afterwards patented a new invention, in which many of the parts of the plaintiff's machine were used, but which did not present all the distinctive features of it nor exactly the same combination:—*Held* (on a motion by the plaintiff to commit the defendants for breach of the injunction), that the order for an injunction must be taken with reference to the pleadings, and the allegations in the bill, and that the defendants' last patent was not within the meaning of the order, but that, as there had not been strict compliance with the order in the other instances brought forward against the defendants, no costs should be given him. Affirmed on appeal. (21 *W. R.* 498.)

(g) *UNITED TELEPHONE COMPANY v. TASKER.* C. A. [1888]

The defendants opposed an injunction on the ground that the plaintiffs had broken a contract to supply the defendants with telephones. Kay, J., granted an injunction on the plaintiffs undertaking to supply the defendants with telephones in place of those which they were prevented from using. The defendants had admitted using fifty-two. Subsequently the defendants said that they found they had forty-four more telephones in use, and asked to be supplied with others in place of those:—*Held*, that the undertaking must be limited to the fifty-two, which number was in the minds of the parties at the time. (5 *O. R.* 628.)

(h) *SPENCER v. ANCOATS VALE RUBBER COMPANY.* C. A. [1888]

Where an injunction is granted by consent, the order should state that it was by consent. (6 *O. R.* 55.)

(h\*) *THOMSON v. HUGHES.* [1890]

The defendants admitted that they sold compass cards called the Hughes compass cards, but denied that they sold the Moore compass cards, but as the latter had been decided to be an infringement of the plaintiff's patent, on a motion for an interim injunction, they undertook not to sell the Moore compass cards, and to keep an account of the Hughes cards sold by them. The plaintiff having discovered that defendant was selling a third card called the Paget card, which appeared to be practically the same as the Moore card, again moved for an interim injunction:—*Held*, that the effect of the undertaking was the same as of an injunction, and that the defendant ought not to have sold the

Paget cards, but that on the balance of convenience, as the plaintiff could be completely recompensed by damages, whereas the defendant could not be, in case it turned out that the Paget cards were not an infringement, an interim injunction should not be granted, but that defendants must undertake to keep an account. (7 O. R. 71.)

*Practice—Venue.*

(i) CAMERON v. GRAY. [1795]

A plaintiff cannot make an affidavit that the cause of action, in a case for the infringement of a patent, arose wholly in any particular county and not elsewhere, since the substratum of the action, namely, the patent, is at Westminster. (6 T. R. 363.)

(j) BRUNTON v. WHITE. [1825]

On a motion to change the venue, in a case for infringement, the Court said there was no precedent for the application, and that unless some instance was cited in which it had been done they could not grant the motion. Rule refused. (7 D. & R. 103.)

(k) SPECKHART v. CAMPBELL ACHNACH AND COMPANY. [1884]

Action for an injunction against a defendant, resident in Scotland, to restrain infringements by posting articles made according to the patent from Scotland for sale in England. Leave given to serve the writ out of the jurisdiction. (W. N. 1884, p. 24.)

(l) FAIRBURN v. HOUSEHOLD. [1885]

An action for infringement having been commenced in the Chancery Division, place of trial Manchester, Manisty, J., made an order at Manchester that it should be tried before Kay, J., in London, but it was discharged on appeal. (Griff. 96; 2 O. R. 195.)

(m) EDMUNDS' PATENT. [1889]

On a petition for revocation it appeared that the petitioners and their principal witnesses and the machinery were at Birmingham, and North, J., ordered the petition to be tried at Birmingham Assizes. (The order was drawn up wrongly that the issue of fact only was to be so tried.) (6 O. R. 355.)

*Practice—Postponement of Trial.*

(m<sup>1</sup>) SMITH v. UPTON. [1843]

The trial of an action for infringement was postponed pending the trial of a *sci. fac.* to repeal the patent. (6 M. & G. 251.)

(n) MUNTZ v. FOSTER. [1844]

Action brought on the 21st July, and cause set down for trial. A writ of *scire facias* to repeal the patent issued on the 3rd of May, at the instance of one of the defendants. In the ordinary course, the cause would have first come on for trial. The Court refused to order that the trial of the cause should be postponed until after the *scire facias* had been determined. (2 Web. P. C. 93, (n.).)

(o) *PATTESON v. HOLLAND.* [1845]

Where one action for infringement had been tried, and a rule *nisi* for a new trial had been obtained and argued, and another action was pending for another infringement of the same patent, and a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*. (*Hind. on Pat.* 293.)

*Practice—Trial of Questions of Law and Fact.*(p) *SPENCER v. JACK.* [1862]

In a suit instituted to restrain an infringement, an issue was directed, as to the novelty of the plaintiff's "*invention*." On the defendant's motion, for this issue was substituted one, as to the novelty of the plaintiff's "*invention or manufacture*." On appeal it was directed, that the question of novelty should be tried on two separate and distinct issues; one, as to whether the plaintiff's improvements constituted a *new invention*; the other, whether it constituted a *new manufacture*. (3 *De G., J. & S.* 346.)

(q) *DAVENPORT v. JEPSON.* [1862]

A defendant is entitled to have the question of the validity of the patent raised, even on an interlocutory motion. (1 *N. R.* 173.)

(r) *NEEDHAM v. OXLEY.* [1863]

On the trial of issues in a patent case, the Court will allow an issue to go to the jury, for the purpose of raising, as a question of fact, the point whether there is a substantial variance as between the complete and the provisional specification. (8 *L. T. Rep., N. S.* 532.)

(s) *YOUNG v. FERNIE.* [1863]

In order to bring a case within the proviso contained in the 25 & 26 Vict. c. 42, s. 2, authorizing the Court of Chancery, notwithstanding the Act, whenever it shall appear that a question of fact may be more conveniently tried by a jury at the assizes, or at any sitting in London or Middlesex for the trial of issues in the Superior Courts of Common Law, to direct such trial, the Court of Chancery must be satisfied that the administration of justice in the particular case may be more conveniently exercised and promoted by directing such issues, than by completing the hearing and the inquiry before itself. (1 *De G., J. & S.* 353; 9 *L. T. Rep., N. S.* 590.)

(t) *CURTIS v. PLATT.* [1864]

The practice introduced into Chancery of having separate issues is not peremptory, and must be regarded as nothing more than a convenient mode of arranging the questions to be decided by the Court. (11 *L. T. Rep., N. S.* 250.)



(u) *PENN v. JACK.* [1866]

Upon the trial of issues in a patent case the plaintiff is entitled to call evidence in reply, for the purpose of rebutting a case of prior user set up by the defendant. But after the evidence for the defence has been summed up, the defendant will not be allowed to adduce further evidence in answer to that given by the plaintiff in reply. (*L. R.*, 2 *Eq.* 314; 14 *L. T. Rep.*, *N. S.* 495.)

(v) *MORGAN v. FULLER.* [1866]

A defendant was not allowed to add a totally new issue of fact not in any way suggested by his answer to the issues which had been already directed for trial. (*L. R.*, 2 *Eq.* 296.)

(w) *BOVILL v. GOODIER.* [1866]

After a patentee had established his patent as against one person at law, he instituted proceedings for an infringement against another in equity. The Court granted the defendant an issue as to the novelty of the invention, but refused it as to the utility of the invention and the sufficiency of the specification, holding that the utility was not contested, or had been proved in the suit, and that the sufficiency of the specification had been already decided in the action at law, a decision in which this Court, so far as it was matter of law not depending on the novelty of the invention, concurred. (*L. R.*, 2 *Eq.* 195; 35 *Beav.* 427.)

(x) *FERNIE v. YOUNG.* H. L. [1866]

Lord Westbury: "In the procedure of Chancery, according to the old practice, these rules were established. If, in the evidence given before the Court, or in the proceedings before the Court, there arose a considerable controversy upon a question of fact, it was usual for the Court of Chancery to direct an issue to be tried before a jury at common law for the purpose of informing itself in what manner that question of fact ought to be answered; but when the proceedings before the Court of Chancery involved a mixed question of law and fact, then it did not direct an issue, but it directed an action, or it retained the bill in order that an action might be brought, for the purpose of having the assistance of a Court of law both upon the question of fact by means of a jury and upon the question of law by means of the Court. A third description of cases was this, namely, where relief was sought in equity founded entirely upon a legal title, and then, where the legal title had not been established by the decision of a Court of law, it was the habit of the Court of Chancery to direct the bill to be retained, with liberty to the plaintiff to bring an action to establish his title; and such in the case of a bill brought by a patentee for relief in a Court of Chancery was the settled rule of procedure, with the exception perhaps only of cases where the patent was of such age and had been so generally recognized and submitted to by the world that the Court of Chancery did not require that its legal validity should first be established."

Now it appeared "desirable to make the Court of Chancery self-sufficient, and enable itself to try, by the aid of a jury, and by the oral examination of witnesses, all questions arising before it both of law and fact. Accordingly, by the Chancery Amendment Act, 1858, in the 3rd sect., power was given to the Court to direct any question of fact to be tried by a jury before itself; and then, in another section, the Court was empowered to dispense with the jury and itself to try the question of fact. This power given to the Court was converted into an obligation by the Act of 1862, and extended to questions of law as well as to questions of fact. It is quite clear, therefore, that the procedure to be adopted under these statutes would, in the case of a patent, be analogous to, and altogether usurp the place of, the old mode of procedure which would have been adopted under the former practice." (*L. R.*, 1 *H. L.* 78.)

(y) *HOFFMANN v. POSTILL*. [1868]

V.-C. Giffard intimated that in future he should treat the hearing of issues in patent cases as the hearing of the cause, and would not advance them before the cases in the paper, except upon a special case made. (19 *L. T. Rep.*, *N. S.* 276.)

(z) *HENDERSON v. RUNCORN SOAP AND ALKALI COMPANY*. [1868]

A trial of issues will not be granted at the request of the defendant when opposed by the plaintiff. (19 *L. T. Rep.*, *N. S.* 277.)

(a) *ARNOLD v. BRADBURY*. [1871]

The usual issues may be granted in a patent suit before the hearing of the cause, although the defendant denies the validity of the patent on the ground of the generality of the claim in the specification. (*L. R.*, 6 *Ch.* 706, reversing 24 *L. T. Rep.*, *N. S.* 613.)

(b) *HUTCHISON v. PATTULLO*. [1888]

In an action for infringement, the validity of the patent being challenged on the ground that the complete went beyond the provisional specification and on other grounds, the Lord Ordinary decided to have the objections on the construction argued as a point of law without hearing evidence as to the rest of the case and held the patent bad (4 *O. R.* 329):—*Held*, by the Inner House, that the Lord Ordinary was wrong, and the case was remitted to him to proceed in the ordinary way. (5 *O. R.* 351.)

### *Practice—Right to a Jury.*

[By Patents Act, 1883, sect. 28, an action or proceeding for infringement or revocation of a patent shall be tried without a jury unless the Court shall otherwise direct. See p. 65.]

(c) *NEEDHAM v. OXLEY*. [1863]

When questions of fact are determined by a special jury before the Court of Chancery itself, it is not necessary to certify, under 21 & 22 Vict. c. 27, for the special jury. (2 *N. R.* 388; 8 *L. T. Rep.*, *N. S.* 604.)

(d) DAVENPORT v. GOLDBERG. [1865]

The defendant in a suit to restrain the infringement of a patent has no right to have the issues of fact referred to a jury *ex debito justitiæ*; and where the issues raised have been already determined, such reference will in general be refused. But if it appear that there is a really doubtful question at issue, the Court will not decide it for itself, if either party desire a jury. (2 *Hem. & M.* 282.)

(e) TANGYE v. STOTT. [1865]

Where the plaintiff's counsel in his opening made charges which were not raised by the pleadings, and the defendant's counsel thereupon asked for a jury, the application was acceded to, and the cause ordered to stand over. (14 *W. R.* 128.)

(f) BOVILL v. HITCHCOCK. [1868]

The defendant to a bill for an injunction to protect a legal right cannot *ex debito justitiæ* require to have such right tried by a jury; for the Court, before the statutes 21 & 22 Vict. c. 27, and 25 & 26 Vict. c. 42, sent such cases to be tried at law, not in order that they might be tried by a jury, but because the Court, having no jurisdiction to try a legal right, required to have the judgment of a Court of common law upon it. (*L. R.*, 3 *Ch.* 417.)

(g) PATENT MARINE INVENTIONS COMPANY v. CHADBURN. [1873]

In the absence of special circumstances the ordinary issues in a patent suit will be tried before the Court itself without a jury. (*L. R.*, 16 *Eq.* 447; 21 *W. R.* 745; 28 *L. T. Rep.*, *N. S.* 614.)

(h) SUGG v. SILBER. [1876]

Where the plaintiff gives notice of trial before a judge sitting with assessors, the defendant had a right under Ord. XXXVI., r. 3, by giving notice within the time specified, to insist on a trial before a judge and jury. (1 *Q. B. D.* 362.)

[Now by Rules of Supreme Court, Order 36, Rule 5, the Court or a Judge may direct the trial without a jury of any cause, matter, or issue requiring any scientific investigation which cannot in their or his opinion conveniently be made with a jury; and by Patents Act, 1883, sect. 28, an action or proceeding for infringement or revocation of a patent shall be tried without a jury unless the Court shall otherwise direct (p. 65).]

(i) AMERICAN BRAIDED WIRE COMPANY v. THOMSON. [1888]

In an action for infringement, an inquiry as to damages having been directed, the plaintiffs applied that it might be referred to a judge and jury:—*Held*, that the Court had no power to order it. On an appeal the parties agreed to a reference, and the Court of Appeal declined to express an opinion on the point. (5 *O. K.* 538, 696.)

*Practice—Affidavits.*

PATENT RULES, 1890, rule 17. The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows :—

- (a.) In the United Kingdom, before any Justice of the Peace, or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;
- (b.) In any other part of Her Majesty's dominions, before any Court, Judge, Justice of the Peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and
- (c.) If made out of Her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a consul, vice-consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

17A. Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall so far as possible be confined to one subject.

(j) *HILL v. THOMPSON.* [1817]

The affidavit in support of an injunction to restrain an infringement should state particularly in what the alleged infringement consists; and when the proportions mentioned in the specification are of the essence of the invention, it should state the defendant to have worked by them. (3 *Mer.* 624.)

When an injunction is applied for *ex parte*, it is incumbent on the party making the application to swear, at the time of making it, as to his belief, that he is the original inventor; for, although, when he obtained his patent, he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect. (*Ib.*)

(k) *HILL v. WILKINSON.* [1817]

In the case of an alleged infringement of a patent, the injunction must be granted, or refused, according to the opinion the Court may form after an examination of the affidavits. (2 *Coop.* 57 (n).)

(l) *STURTZ v. DE LA RUE.* [1828]

Lord Lyndhurst, L.C.: "There can be no doubt that, when a party comes for an injunction against the infringement of a patent, he ought to state that he believes, at the time when he makes the application, that the invention was new, or had never been practised in this kingdom at the date of the patent. It is not enough that it was believed to be new at the time when the patent was taken out." (5 *Russ.* 329.)

## (m) LEWIS v. MARLING. [1829]

New facts stated upon affidavit, which would be ground for repealing a patent by *scire facias*, will not be received on a motion for a new trial. (1 *Web. P. C.* 495.)

## (n) BICKFORD v. SKEWES. [1837]

Injunction granted although, on account of the patentee being dead, there was no affidavit to the effect that he, at the time of application, believed himself to be true and first inventor, and that the invention was new. (1 *Web. P. C.* 211.)

## (o) STOCKING v. LLEWELLYN. [1842]

If there is any material variation between the allegations in the Bill, or the aid sought by it, and the affidavits in support of the plaintiff's case, the injunction will be dissolved, with costs. (3 *L. T. Rep.* 33.)

(p) *In re* STEAD'S PATENT. [1846]

Two petitions were presented, the second being supplementary to, and stating what had taken place subsequent to the presentation of, the first. The affidavits made by the petitioner in support of the first petition, gave a general history of his invention, of the communication from abroad on which it was founded, and of his attempts to introduce it into this country; and those in support of the second petition stated the proceedings at law which had taken place since presentation of the first petition, the publications adduced at the trial as impeaching the novelty of the invention, and the title of the petitioner. The counsel for the opponents objected to the affidavits being received as proof of the matters contained in them, the intention being that such affidavits should be received in addition to other evidence, because the applicant having made a good case might be the only person who knew the real case:—*Held*, that the affidavits were required to show that the petitioner believed certain facts to be true; and that the opponents could prove their own case by other evidence. (2 *Web. P. C.* 143.)

## (q) ELECTRIC TELEGRAPH COMPANY v. NOTT. [1847]

The Court will, at any time previous to the hearing, postpone the hearing, in order to allow time for filing affidavits; but no affidavits filed after the hearing has begun may be read. (11 *Jur.* 273.)

## (r) SHAW v. THE BANK OF ENGLAND. [1852]

In an action for the infringement of a patent, the Court refused to grant an order for inspection of a machine upon an affidavit "that the machine used by the defendants is the same for which the plaintiff has obtained a patent." (22 *L. J. Exch.* 26.)

Pollock, C.B.: "The affidavit is too vague and defective for the Court to grant this application. It ought, at least, to state

that there is such a machine, and that the plaintiff has reason to believe that it is an infringement." (*Ib.*)

(s) *GARDNER v. BROADBENT.* [1856]

A. B. in May, 1856, became the purchaser of a patent, which the defendant, as alleged, infringed subsequent to the date of the purchase. A. B. obtained an injunction *ex parte* to restrain the defendant, on an affidavit in support, which stated that the patent had been recorded, and that it became and was good and valid. The Court held this affidavit insufficient, and on that ground dissolved the injunction, with costs. (2 *Jur.*, N. S. 1041.)

Sir J. Stuart, V.-C., said: "When the plaintiff applied for an *ex parte* injunction, his affidavit ought to have stated clearly and distinctly that he believed the patentee, from whom he purchased the patent, was the original and true inventor, and that he believed that the invention had not been practised at the time when the patent was granted." (*Ib.*)

(t) *In re M'KEAN'S PATENT.* [1859]

Where a petition to have the great seal affixed to a patent had been filed, and the respondents served with notice two months before the first day of Michaelmas Term, for which day the petition was answered, and the respondents only filed affidavits on the morning of that day:—*Held*, that they could not be read; and the patent was ordered to be sealed. (1 *De G., F. & J.* 2; 8 *W. R.* 1; 1 *L. T. Rep.*, N. S. 19.)

(u) *MEADOWS v. KIRKMAN.* [1860]

Order for inspection of defendant's machinery refused where plaintiff's affidavit did not sufficiently ascertain the nature of the invention infringed. (29 *L. J. Exch.* 205.)

(v) *WHITTON v. JENNINGS.* [1860]

When a defendant to a bill filed for an injunction to restrain an infringement, or for leave to bring an action at law, stated by his answer that the invention was not novel, and that the plaintiff's patent was invalid, the Court, on a motion by the plaintiff, without his having made an affidavit as to the novelty of the invention or validity of the patent, refused to grant him an injunction or to give leave to bring an action, unless he produced a clear and distinct affidavit that the invention was novel and the patent valid, but allowed the motion to stand over for that purpose. (1 *Dr. & S.* 110.)

(w) *MAYER v. SPENCE.* [1860]

In an injunction suit to restrain an infringement, a motion for leave to take proceedings at law ordered to stand over for the plaintiff to make an affidavit of his belief of his title to the patent, and of the alleged infringement. (1 *J. & H.* 87.)

(x) *BETTS v. WILMOT.* [1871]

The onus being on the plaintiff to show not merely that the

thing made is his own patented article, but that it has been unlawfully sold, he must be prepared to swear distinctly that it is not manufactured by him or his agent. The onus is then thrown upon the defendant. (*L. R. 6 Ch. 239*; *25 L. T., N. S. 188.*)

(y) *MURRAY v. CLAYTON.* [1873]

The defendant against whom an inquiry as to damages has been granted, must make an affidavit as to the number of the patented machines sold by him and the names and addresses of the purchasers. (*L. R. 15 Eq. 115.*)

*Practice—Evidence of the Subject-matter of a Patent.*

(z) *LEWIS v. DAVIS.* N. P. [1829]

In an action for the infringement of a patent, professing to be an improvement on a former patent, the specification of the former patent must be put in evidence, in order to show what the improvement really is. (*1 Web. P. C. 489*; *3 C. & P. 502.*)

(a) *BATEMAN v. GRAY.* [1853]

In an action for infringing a patent, defendant pleaded only—(1) not guilty; (2) a traverse that plaintiff was the inventor; and (3) a traverse that the invention was new. At the trial, the plaintiff put in the specification, which claimed three old things; but he proved, by his own evidence, that the invention which he really claimed, and which he thought he had described in his specification, was the combination of the three things:—Held, that the specification was evidence for the jury, but not conclusive; and that they were warranted in finding that the invention was the combination. (*1 C. L. Rep. 512.*)

Pollock, C. B., said: "We think that what was the invention is a question for the jury, and that the specification does not conclude the plaintiff. It was evidence to be considered by the jury and no more." (*Ib. 515.*)

(b) *BOYD v. HORROCKS.* C. A. [1889]

An example of a class of machines may, in order to explain counsel's argument, be handed up and looked at although it is not in evidence. (*6 O. R. 152.*)

*Practice—Evidence of Novelty of Invention.*

(c) *MANTON v. MANTON.* N. P. [1815]

Action for the infringement of a patent for a hammer for the locks of fowling-pieces.

Gibbs, C.J., said to the jury: "The first witness, a man of considerable experience, had never seen any locks with the lips so perforated; *primâ facie*, that is good evidence; but when the question is, whether this had existence previous to the patent, fifty witnesses proving that they never saw it before would be of no

avail if one was called who had seen it and practised it." (*Dav. P. C.* 350.)

(d) *R. v. HADDEN.* [1826]

On *scire facias* to repeal a patent for a machine, on the ground that it is not new, you may, to prove that, put into the hand of a witness, who had constructed a machine for the same purposes, a drawing not made by himself, and ask him whether he has such a recollection of the machine he made, as to be able to say that that is a correct drawing of it. (2 *C. & P.* 184.)

(e) *In re CUTLER'S PATENT.* Ch. [1839]

The identity of purpose, and not of name, is the criterion in judging of the similarity or dissimilarity of inventions. (1 *Web. P. C.* 427.)

(f) *GALLOWAY v. BLEADEN.* N. P. [1839]

It is only necessary for the plaintiff to make out a *prima facie* case as to the novelty of his invention, to call upon the other side to show affirmatively that it is not new. This the plaintiff may do by calling persons who are conversant with the subject of the patent, and who pass their time in understanding the nature of patents, and in following up and discovering what are the inventions that are going on from week to week, to say that they had not before heard that there had been such a discovery previous to the grant of the patent. (1 *Web. P. C.* 526.)

(g) *WALTON v. POTTER.* N. P. [1841]

Tindal, C.J., said to the jury: "It will be not immaterial to call your attention, upon this first head of inquiry, to the specification of the plaintiff's, and next that of the defendants' patent in order that we may compare them together, and see whether there really is that variation in substance so as to give the denomination of a new discovery to what the defendants have done, or whether they are not following out the invention of the plaintiff, with some variation in the description, which may not allow it the name of a new discovery." (1 *Web. P. C.* 587.)

(h) *HYDE v. PALMER.* [1863]

In an action for the infringement of a patent taken out in 1849, the defendant, in support of a plea that the invention was not new, gave evidence that O., who was dead, had in 1846 used a process identical with that in the patent. On the cross-examination of the witnesses it appeared that, if O. used the invention and sold the product before the date of the patent, it was only in very small quantities, and that it was not brought into general use; and one of the witnesses was asked in cross-examination whether O. had not sold some of the product to S., and said he had. The plaintiff in reply called S., who gave evidence that in 1850 or 1851, O sold him a small quantity of the product, and at the time of the sale said that it was a new article, that he did not wish it to be publicly



known, and he would sell him all he could manufacture:—*Held*, that evidence of what O. said at the time of that sale was not admissible in reply, as it would not have been admissible in chief on an issue whether O., before 1849, used the invention. (3 *B. & S.* 657; 11 *W. R.* 433; 7 *L. T. Rep.*, *N. S.* 823; 32 *L. J.*, *Q. B.* 126.)

(i) *BETTS v. NEILSON.* *H. L.* [1871]

Where a patent had been taken out by D. in 1804, and another patent had been taken out by B. in 1849, and B. took proceedings against N. for infringement, to which N. set up as an answer want of novelty, and proved D.'s patent, evidence of all that was done in the trade to which the patent related between the date of D.'s patent and of B.'s patent, was admissible on this question of novelty. (*L. R.*, 5 *H. L.* 2.)

(j) *BOYD v. HORROCKS.* [1888]

In an action for infringement of a patent for improvements in winding machines, the plaintiff applied after the evidence had been closed, speeches delivered, and judgment reserved, to call further evidence with regard to the date of certain changes in a machine which had been alleged to be an anticipation of the plaintiff's:—*Held*, that the evidence was relevant to a main issue and should be admitted. (5 *O. R.* 557.)

*Practice—Evidence of the Grant of Letters Patent.*

(k) *MINTER v. WELLS.* *N. P.* [1834]

Alderson, B.: "The patent is *primâ facie* evidence on the part of the person who claims the right that he is so entitled, and it is for the person who seeks to infringe that patent to show some circumstance whereby that right, which otherwise would be presumed to exist, is defeated, to show that the Crown's grant has been improperly obtained by the present plaintiff." (1 *Web. P. C.* 129.)

(l) *RUSSELL v. CRICHTON.* [1837]

Letters patent afford *primâ facie* evidence of the originality of the alleged invention. (1 *Web. P. C.* 677 (n).)

(m) *NICKELS v. ROSS.* [1849]

At the trial the plaintiff put in the letters patent and specification, and gave evidence to show that a machine like his had never been in use before the date of the letters patent:—*Held*, that this entitled the plaintiff to a verdict upon the issue joined on the plea of *non concessit*.

*Held*, also, that the plaintiff was entitled to a verdict on the issue joined on a plea, stating that the plaintiff had obtained the patent on a false representation that he was in possession of the invention in consequence of a communication from a foreigner resident abroad, without any proof that the invention was communicated to him by a foreigner residing abroad, as alleged in the petition recited in the specification,—a party availing himself of

information from abroad, being an *inventor* within the meaning of the 21 Jac. 1, c. 3, s. 6. (8 *C. B.* 679.)

*Evidence of Sufficiency of the Specification.*

(n) *TURNER v. WINTER.* [1787]

Buller, J.: "I do not agree with the counsel who have argued against the rule, in saying, that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admit that it has been tried and succeeds. But wherever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this on his part is sufficient, and it is then incumbent on the defendant to falsify the specification." (1 *T. R.* 606.)

(o) *R. v. FUSSELL.* [1826]

The evidence of a scientific man, that to carry out an invention from the specification would require a great deal of contrivance, is, in the absence of evidence to the contrary, sufficient proof of the insufficiency of the specification. (1 *Carp. P. C.* 449.)

(p) *BROOKS v. RIPLEY.* [1831]

If the specification be not sufficiently clear to be understood by an ordinary workman (a witness for the plaintiff), witnesses will not be allowed to be called to explain the intention of the patentees, and plaintiffs will be nonsuited. (2 *Lond. Jour., C. S.* 35.)

(q) *MINTER v. WELLS.* N. P. [1834]

Alderson, B.: "The plaintiff, in order to establish his right, must show that the invention is new, and that it is useful, and that the specification is such that an ordinary workman could make the machine which would answer the purpose which the patent was intended to accomplish." (1 *Web. P. C.* 129.)

(r) *CORNISH v. KEENE.* N. P. [1835]

Upon an action for infringement, the specification is proved to be sufficient, if witnesses are called by the plaintiff, who have actually made the manufacture without any instruction except the specification; and none are called by the defendant, who could not understand the specification, had been misled by it, or incurred expense in endeavouring to copy or to imitate it. (1 *Web. P. C.* 502.)

(s) *R. v. NICKELS.* [About 1846]

Where, in a patent for machinery, the improvements are not sufficiently ascertained or described either by words or figures, parol evidence is not admissible to explain the specification and show what is new. (*Hind. Law of Pat.* 186.)

(t) YOUNG v. FERNIE. Ch. [1864]

Experiments conducted for the express purpose of manufacturing evidence, with a view to litigation, are to be looked at with distrust. (4 *Giff.* 609.)

(t<sup>1</sup>) EDISON v. WOODHOUSE. C. A. [1887]

If a workman says that a specification is a sufficient guide to him, and the Court believes him, the Court must hold the specification sufficient. (3 *O. R.* 183; 4 *O. R.* 99.)

### *Evidence of Infringement.*

(u) HUDDART v. GRIMSHAW. N. P. [1803]

Action for the infringement of a patent for a new mode of making cables and other cordage. Evidence was given on behalf of the plaintiff by an engineer, who was familiar with the subject of rope-making, that some rope, proved to be of the defendant's manufacture, agreed in its structure and in all its qualities with the rope made by the plaintiff's patented method. The witness knew of no other method of manufacturing such rope, which he believed to have been made in accordance with the plaintiff's patent:—*Held*, that this was *primâ facie* evidence, till the contrary was shown, of an infringement of the plaintiff's patent. (*Dav. P. C.* 288; 1 *Web. P. C.* 91.)

(v) HALL v. BOOT. N. P. [1822]

The sale of an article which might, during its manufacture, have been improved according to a patent process, coupled with the fact of the defendant having the machine necessary for practising such process in his possession, is sufficient evidence of infringement. (1 *Web. P. C.* 100.)

(w) MUNTZ v. FOSTER. N. P. [1844]

Tindal, C.J.: "For the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection arises either to the nature of the grant or the specification which has been enrolled by the plaintiff." (2 *Web. P. C.* 99.)

(x) PALMER v. WAGSTAFFE. [1854]

The plaintiff's patent, obtained for "*the mode of manufacture of candles by the application of two or more plaited wicks, so disposed that the ends always turn outwards,*" is not proved to be infringed by the mere production of a candle, made by the defendant, in which the wicks were so plaited and turned outwards. It must be further shown that the defendant made it by the method described in the plaintiff's specification, or in some way that the jury might consider colourable. (9 *Ex.* 494; 23 *L. J., Ex.* 217; 2 *C. L. R.* 1052.)

(y) UNWIN v. HEATH. H. L. [1855]

Crompton, J.: "Proof of a user of an invention before the patent was granted, such as would be evidence that there was

no novelty, if taking place after the patent, is evidence of an infringement." (25 *L. J.*, *C. P.* 13.)

(z) *DAVENPORT v. RICHARDS.* Ch. [1860]

The fact that the articles made by the plaintiff's and defendant's machines are identical, is a fair argument to show that an infringement of the plaintiff's patent has been committed. (3 *L. T. Rep.*, *N. S.* 504.)

(a) *SEED v. HIGGINS.* H. L. [1860]

The opinion of scientific witnesses as to whether there has or not been an infringement ought not to be received. Per Lord Wensleydale. (8 *H. L. Cas.* 550; 30 *L. J.*, *Q. B.* 314; 6 *Jur.*, *N. S.* 1264.)

(b) *NEILSON v. BETTS.* H. L. [1871]

*Seemle*, that, where the piracy alleged has taken place abroad, it becomes the duty of the defendant to give evidence of a negative character to prove (in answer to the *prima facie* case made by the patentee) that the process used was of a different character from that which had been patented.

Where that negative evidence was not given by the defendant, but positive evidence on the part of the patentee was given by one workman that he had been employed at the foreign manufactory, and there saw the capsules manufactured by a process not distinguishable from that of the patentee:—*Held*, that these circumstances justified the conclusion of identity of material and process. (*L. R.*, 5 *H. L.* 1.)

(b\*) *BATLEY v. KYNOCK.* [1875]

Bacon, V.-C.: "What is the office of a scientific witness in giving evidence in this Court? His office is to point out and explain the mechanism by which power is applied, and the means whereby mechanical effects are produced. To that task he brings special knowledge." (*L. R.* 20 *Eq.* 637.)

(c) *BADISCHE ANILIN UND SODA FABRIK v. LEVINSTEIN.* [1883]

On the question of infringement, the defendant alleged that he used a secret process entirely different from that of the plaintiff's, and was allowed to refuse to answer any question which would disclose it. Subsequently the Court being of opinion that the patent was valid, gave the defendant leave to state his process *in camera*, and the shorthand writers' notes, which would have disclosed the process, were impounded. (24 *Ch. D.* 156.)

(c\*) *AUTOMATIC WEIGHING MACHINE COMPANY v. KNIGHT.* [1888]

In an action for infringement, it was held that there had been no infringement. The Court expressed its approval of the conduct of the plaintiffs, who had called only one scientific witness. (*W. N.*, 1888, 250.)

*(d) CARTSBURN COMPANY v. SHARPE. [1884]*

Where it appeared that the articles sold by the respondents might have been produced by machinery, which involved no infringement of the complainers' patent:—*Held*, that it did not lie on the respondents to prove that the articles were not manufactured according to the specified process, and that the complainers had failed to prove their case. (1 *O. R.* 181.)

*Practice—Account.*

Patents Act, 1883, sect. 30. In an action for infringement of a patent, the Court or a judge may on the application of either party make such order for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.

*(e) JONES v. PEARCE. [1831]*

Shadwell, V.-C.: "Where an undertaking by the defendant to keep an account will afford to the Court ample means of doing justice to the plaintiff, should his legal right be established, the Court rarely grants the interim injunction." (2 *Coop.* 58.)

*(f) CROSSLEY v. THE DERBY GAS LIGHT COMPANY. [1834]*

Where the words of the decree ordering an account to be taken are clear, it is not the practice of the Court to express an opinion for the guidance of the master as to particular difficulties which may arise, even although these difficulties may be foreseen. Such difficulties must be dealt with when they actually occur in pursuing the investigation. (3 *M. & Cr.* 428.)

*(g) BACON v. SPOTTISWOODE. [1839]*

A plaintiff is not entitled to any account, even though he may have a right to an injunction, when the bill alleges that the defendant has sold and used, it being the fact that he has sold for no profit, and it not appearing that he has used otherwise than by furnishing the patent article to his customers, although the defendant may have derived a collateral profit from the use of such articles by his customers, where that case is neither alleged in the bill nor proved. (1 *Beav.* 387.)

*(h) HADDEN v. SMITH. [1847]*

The plaintiff granted a licence to the defendant to use two patents, upon payment of certain royalties. The plaintiff afterwards put in a disclaimer as to part of his patent; the defendant refused to continue paying the royalties, on the ground that the licence was void. The bill prayed an account of royalties under the licence; and in case the defendant should dispute the plaintiff's right to payment by reason of the invalidity of the patent or otherwise, then that the defendant might be restrained from continuing to manufacture articles the subject of the patent:—*Held*, upon demurrer, that if the licence were void, and the defendant was not bound to account, he ought to be restrained from

acting without the authority of the plaintiff. Demurrer overruled. (17 *L. J.*, Ch. 43.)

(i) *MITCHELL v. BARKER*. [1851]

Where, upon the face of the affidavits, the evidence as to the validity of the patent and its infringement was distinctly contradictory, an injunction was refused, but the plaintiff was directed to bring his action at law, the defendant undertaking to keep an account in the meantime. (39 *Lond. Jour.* 531.)

(j) *SMITH v. THE LONDON AND SOUTH WESTERN RAILWAY COMPANY*. [1854]

The right to a decree in equity for an account of the profits made by the manufacture and use of articles in infringement of a patent was incident to the right to an injunction to restrain future infringements; and where no case was made for the injunction, the account was not decreed. (*Kay*, 408.)

Wood, V.-C., in delivering judgment, said: "The true ground of the relief in these cases is laid down in *Bailey v. Taylor* (1 *R. & M.* 75), where Sir J. Leach, M.R., says, 'The Court has no jurisdiction to give to a plaintiff a remedy for an alleged piracy, unless he can make out that he is entitled to the equitable interposition of this Court by injunction; and in such case the Court will also give him an account, that his remedy here may be complete.'"

(k) *HOLLAND v. FOX*. [1854]

In an action for the infringement of a patent, plaintiff obtained a verdict for 40s. damages. Afterwards he obtained a rule, absolute in the first instance, ordering defendant to render an account of all the articles which he had before and since the commencement of the action made or sold in breach of plaintiff's patent and pay to plaintiff the moneys received for such articles. A rule *nisi* was obtained, on the part of the defendant, to discharge this rule. It appeared that defendant had made profits by the sale of the pirated articles since the commencement of the action; but that he had discontinued the manufacture since the verdict and before the plaintiff's rule was obtained. And it appeared that, shortly after the action commenced, plaintiff's attorney had told the other side that plaintiff would take only nominal damages, and would, if necessary, file a bill in equity to obtain an account of the profits: —*Held*, that the action was still pending, so as to give this Court jurisdiction under the Patent Law Amendment Act, 1852, sect 42: —*Held*, also, that there having been a verdict with damages, and there being no continuing piracy such as would give ground for an injunction, no account of profits before action could be ordered; but, held, that the defendant might be considered as trustee for the plaintiff of those profits which he had made, pending the action, after notice that plaintiff would require them; and that an account of those profits might be ordered. The practice of the equity

courts followed. (3 *Ell. & B.* 977; 2 *C. L. R.* 1576; 1 *Jur., N. S.* 13; 23 *L. J., Q. B.* 357.)

(l) *VIDI v. SMITH.* [1854]

Pending an action for infringement of a patent for an invention, plaintiff obtained, under the Patent Law Amendment Act, 1852, a rule *nisi* that defendant should render on oath an account of the sale of the articles (alleged to be pirated) sold before the action, and of the profit made therefrom; and keep an account of the articles to be sold and of the profit therefrom. The rule was drawn up on an affidavit that plaintiff had the patent, and that defendant had infringed it after notice. Cause being shown:—*Held*, that no retrospective account of profits made by sales before the action ought to be ordered before final judgment, and so much of the rule was discharged:—*Held*, also, that the Court had jurisdiction to order an account to be kept in future, though no injunction was asked for, it appearing that there was a *prima facie* case of infringement: and the Court ordered that the rule should be absolute for such an account, on condition that the plaintiff elected not to claim damages at the trial, and undertook, if he failed in the action, to pay defendant the expense of keeping the account so ordered. (3 *Ell. & B.* 969; 2 *C. L. R.* 1573 1 *Jur., N. S.* 14; 23 *L. J., Q. B.* 342.)

(m) *PRICE'S PATENT CANDLE COMPANY v. BAUWEN'S PATENT CANDLE COMPANY.* [1858]

The rule in patent cases, that this Court could not decree an account unless it could grant an injunction, applied, notwithstanding it might appear at the hearing that, since an interim injunction was moved for, the defendants had sold articles which, had the facts and law been then sufficiently ascertained, the Court would have restrained them from selling. (4 *K. & J.* 727.)

(m\*) *KERNOT v. POTTER.* [1862]

K. and P. entered into an agreement that K. should take out a patent and assign it to P., and that P. should work it as long as it could be worked at a profit, and pay royalties. P. ceased working the patent, alleging that it could not be worked at a profit, and refused to pay royalties. K. obtained judgment in an action at law for royalties, and then applied for an injunction and an account of subsequent royalties, or if the agreement were determined for relief against the defendant as an infringer:—*Held*, that in a case of this nature it was in the discretion of the Court whether it would direct an account or leave the parties to their remedy at law, and that the account being only a part of an agreement which the Court could not wholly enforce, the plaintiff ought to be left to his remedy at law. (3 *De G., F. & J.* 447.)

(n) *HILLS v. EVANS.* [1862]

Where an injunction was granted to restrain an infringement,

liberty was given to the plaintiff, instead of an account, to bring an action at law for damages, in lieu of an account. (8 *Jur.*, *N. S.* 531.)

(o) *EDWARDS v. NORMANDY.* [1864]

E. being owner of one-third of an American patent, assigned his interest therein to N., the legal owner of the other two-thirds, in consideration of receiving one-fifth of the profits to arise from sales of the invention in America, for which N. agreed to account to him, and he deprived himself of all right to interfere in arrangements made for licensing such sales. N. was, in this transaction, the agent of a company who were beneficial owners of the two-thirds of the American patent, and of an English patent for the same invention, and was the exclusive manufacturer of the invention in England, but bound to supply his manufacture to the company only. The company granted to G. an exclusive licence for the sale of the invention in America, supplying him with machines at certain prices, higher than those at which they bought from N., and receiving from G. one-third of the net profits arising from the American sales:—*Held*, 1st, that G. was not liable to account to E. for his profits; 2nd, that the company were bound to account to E. for profits arising from the sale to G. at higher prices than were paid to N.; 3rd, that N. was not bound to account to E. for the profits arising from the manufacture of the invention. (3 *N. R.* 562; 12 *W. R.* 548.)

(p) *TROTMAN v. WOOD.* [1864]

The jury, in an action against the defendants for non-payment of royalties and for an account, found that the defendants had used a part of the plaintiff's invention:—*Held*, that the plaintiff was entitled to an account. (16 *C. B.*, *N. S.* 479.)

(q) *MATHERS v. GREEN.* [1865]

Where a patent for an invention is granted to two or more persons in the usual form, each one may use the invention without the consent of the others, and without accounting for the profits so made. (*L. R.*, 1 *Ch.* 29.)

(r) *ELLWOOD v. CHRISTY.* [1865]

The Court will only direct an account to be taken, under the 42nd section of 15 & 16 Vict. c. 83, of the profits which have been actually made by the defendant, and not of the *loss which the plaintiff has sustained by the infringement*; and, in the case of an assignee of the patent, the account will only be taken from the date of the registration of the assignment under sect. 35. (18 *C. B.*, *N. S.* 494; 34 *L. J.*, *C. P.* 130; 13 *W. R.* 498.)

(s) *NUNN v. D'ALBUQUERQUE.* [1865]

The defendant having in ignorance infringed the plaintiff's patent, submitted, and he offered before suit to pay the amount of profits made, which were very trifling. At the hearing, although



a perpetual injunction was granted, no costs were given, and an account was granted only upon the plaintiff's request and at his peril. (34 *Beav.* 595.)

(t) *RENARD v. LEVINSTEIN.* [1865]

It is no sufficient answer to a motion for an interlocutory injunction that the defendant has volunteered to keep an account. (2 *Hem. & M.* 628.)

(u) *FOX v. DELLESTABLE.* [1866]

F. obtained a patent for umbrella ribs, and enjoyed it uninterruptedly to its conclusion, with the exception of an action for damages by H., another patentee, who recovered £300, and a manufacture and sale of the ribs by D. & D. six months before it expired. F. filed a bill and restrained D. & D., and the cause came to a hearing nine months after the expiration of the patent. Malins, V.-C.: "Although the patent has expired, if the bill was previously filed, the plaintiff is entitled to an account, if the Court sees a proper case for it. . . . But regard must be had to the particular circumstances of the case, and the question is whether, under the circumstances of the case, I ought to give relief. To justify me in doing so, I must be satisfied of the validity of the patent." (15 *W. R.* 194.)

(v) *MOXON v. BRIGHT.* [1869]

A patentee agreed with a machine maker that the machine maker should make machines according to the patent and sell them, taking a certain sum upon each machine for himself, and paying to the patentee as a royalty the amount charged for the machines above that sum:—*Held*, that the patentee could not maintain a suit in equity for an account against the machine maker as agent, although in one case he received a sum of money for the patentee. (*L. R.*, 4 *Ch.* 292.)

(w) *SAXBY v. EASTERBROOK.* [1872]

An account will be granted as soon as the verdict is given, and the defendant cannot refuse to allow his books to be inspected, for the purpose of taking an account, on the ground that he is about to appeal. (*L. R.*, 7 *Exch.* 207; 41 *L. J.*, *Exch.* 113.)

(x) *DE VITRE v. BETTS.* [1873]

The rule that, upon a decree against a party for the infringement of a patent, the patentee is not entitled under 21 & 22 Vict. c. 27, ss. 2, 5, to have both an account of profits and an inquiry into damages, is now established, and applies to every case of infringement. The patentee must therefore elect which of the two forms of relief he will adopt. (*L. R.*, 6 *H. L.* 319; 21 *W. R.* 705.)

(y) *ADAIR v. YOUNG.* C. A. [1879]

In an action by a patentee to restrain alleged infringements of

letters patent for the manufacture of pumps, a judgment was made giving a perpetual injunction against the defendants, who were pump manufacturers, and directing an account of the profits made by them by the sale of pumps made in infringement of the letters patent. The defendants forthwith gave notice of appeal, and set the appeal down for hearing, and then applied to stay proceedings under the account till the appeal was heard. This application was refused by Bacon, V.-C.:—*Held*, on appeal, that as the discovery given by the account would enable the plaintiff to take proceedings against the customers of the defendants, and the defendants, supposing them to be ultimately successful, would thus sustain irreparable injury in their business, the appeal ought to be advanced, and proceedings under the account stayed till the hearing. Costs of the application made costs of the appeal. (11 *Ch. D.* 136.)

(z) *BERGMANN v. MACMILLAN.* [1881]

An account of profits will not be directed if it is clear that no profits have been made.

An assignee of a share of profits is entitled to an account from the licensee, but the account must be taken once for all in the presence of all the parties interested. (17 *Ch. D.* 423.)

(a) *WERDERMAN v. SOCIÉTÉ GÉNÉRALE D'ÉLECTRICITÉ.* C. A. [1881]

By an assignment of a patent it was agreed that the patentee was to have £1000 and 5 per cent. on the profits, or on a sale out and out was to have in lieu of the arrangement as to profits 5 per cent. of the net purchase-money. The assignees covenanted for themselves and their assigns to work the invention to the best advantage, and that an account of profits should be rendered yearly by them or their assigns. The assignees formed a company to work the patent, and the patent was made over to them with notice of the arrangement. *Held*, that the assignment amounted to a contract that the owners for the time being of the patent should account for and pay to the patentee a share of the profits, unless a sale within the meaning of the deed was effected, and that no one taking with notice of this contract could refuse to give effect to it. (19 *Ch. D.* 246.)

(b) *WATSON v. HOLLIDAY.* [1882]

The amount of profits made by infringing a patent is recoverable by the patentee, not as damages, but as money had and received to his use; and the patentee is therefore not prevented by the 31st section of the Bankruptcy Act of 1869, from proving in the bankruptcy of the infringer for these profits. (20 *Ch. D.* 780.)

(c) *SIDDELL v. VICKERS SONS AND COMPANY.* [1889]

In an action for infringement of a patent for an improved appliance for use in large forgings, the Court of Appeal had ordered "an account of all iron or steel forgings, manufactured by the defendants by the use of the plaintiff's said invention, as de-

scribed in figure 2 of the specification, and also of the profits made by the defendants by reason of such use." The defendants refused to disclose any accounts of the profits made by them prior to their commencing to use the plaintiff's invention, on the ground that the alterations in their profits were not due to using the plaintiff's invention, but to other causes. Kekewich, J., being of opinion that for the purpose of ascertaining the profits made by reason of the use of the plaintiff's invention, it was necessary to inquire what was the cost of forging iron and steel forgings manufactured by the defendants, both prior to the use of such invention and during its use, ordered the defendants to give such information within a fortnight. (6 O. R. 464.)

*Practice—Damages.*

Patents Act, 1883, sect. 17, sub-s. 4 (b.) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

[Sect. 17 is set out in full at p. 599.]

Sect. 20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

(d) *ARKWRIGHT v. NIGHTINGALE.* [1785]

Where a patentee, who has failed to establish his right under the patent upon a former occasion, sues for damages for an alleged infringement, the defendant is allowed to give evidence to show to what extent persons have acted upon the faith of the former verdict. (*Dav. P. C.* 55, 1 *Webs. P. C.* 61.)

(e) *NEWALL v. WILSON.* [1852]

An allegation as to the defendant's inability to be answerable in damages, held not irrelevant upon a motion for an injunction against the infringement of a patent. (2 *De G., M. & G.* 282.)

(f) *SMITH v. LONDON AND NORTH WESTERN RAILWAY COMPANY.* [1853]

Where the defendants have gone on using the infringing articles without any concealment, believing that they had a right to do so, and the owner of the patent has stood by, damages ought not to be assessed as if the defendants had purchased every article at the patentee's price. (*Mac. P. C.* 188.)

(g) *NEEDHAM v. OXLEY.* [1863]

Where a bill prays in the alternative an inquiry as to damages, or an account of the defendant's profits, but no issue as to damages was submitted to the jury, the Court will not refer an inquiry to

assess damages to chambers, but will grant the alternative. (8 *L. T. Rep.*, *N. S.* 604; 2 *N. R.* 388.)

(h) *BETTS v. DE VITRE.* [1864]

The jurisdiction given by the Chancery Amendment Act, 1858, to award damages when relief is sought by injunction against wrongful acts, extended to the case where the Court had previously the power of giving some other form of remedy, as, for example, an account of profits.

Since the Chancery Acts, 1858 and 1862, the question of damages will still be left to be decided by a jury where there is extreme difficulty in their assessment by the Court itself.

Therefore, in a suit for an injunction by a patentee who had granted no licences, the Court put him to his election whether he would have an account of profits or an action for damages against the defendants; following the form in *Hills v. Evans.* (11 *Jur.*, *N. S.* 9; 11 *L. T. Rep.*, *N. S.* 533.)

(i) *DAVENPORT v. RYLANDS.* [1865]

The plaintiff's bill prayed for an injunction against the infringement of his patent by the defendant, for an account of profits and for damages. After the filing of the bill, but before the hearing of the cause, the patent expired. The infringement being proved, the Court held that, for the purpose of awarding damages under the Act 21 & 22 Vict. c. 27, its jurisdiction related back to the time of the filing of the bill. For, otherwise, the object of the statute, which was to enable a Court of Equity to give full and complete relief to a suitor without recourse to a court of law, would be defeated. (*L. R.*, 1 *Eq.* 302; 35 *L. J.*, *Ch.* 204; 14 *L. T. Rep.*, *N. S.* 53.)

Wood, V.-C., said: "The inquiry will be in the form, 'what damage the plaintiff has sustained,' and not 'what damage, if any,' he has sustained, as it would be in the case of a trade-mark. There is this difference between the case of a trade-mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say, 'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee." (*L. R.*, 1 *Eq.* 308.)

(j) *PENN v. BIBBY.* [1866]

Where bills to restrain the infringement of a patent have been filed against both the person who manufactures and the person who uses the article, and issues of fact have been found for the plaintiff, it is the right of the plaintiff to have not only an account against the manufacturer, but also damages against the person

using the article, wherever it be found. (*L. R.* 3 *Eq.* 308; 36 *L. J.*, *Ch.* 277.)

(k) *PENN v. JACK.* [1867]

A suit was instituted to restrain the defendants from infringing the plaintiff's patent for an invention applicable to steam vessels. By the decree the defendants were ordered to pay to the plaintiff the damages which he had sustained by reason of the defendants' user or vending of the invention. The plaintiff had been in the habit of granting licences to use the invention at the rate of 2s. 6d. per horse-power per ship:—*Held*, that the compensation to which the plaintiff was entitled was a sum calculated on this basis upon the ships to which the defendants had applied the invention, and that he was not entitled to any additional sum in respect of contracts which he had missed by reason of the defendants' piracy.

The plaintiff having, in another suit, obtained a decree against certain wrongful users (not being manufacturers) of unlicensed machines fitted by the defendants with the plaintiff's invention, had, in some instances, been paid his ordinary royalty by such users:—*Held*, that, in every such instance, no further royalty was payable by the manufacturer. (*L. R.*, 5 *Eq.* 81; 37 *L. J.* *Ch.* 136.)

(l) *BETTS v. NEILSON.* [1868]

Damages may be awarded, although not specifically prayed by the bill. (18 *L. T. Rep.*, *N. S.*, 159.)

(m) *BETTS v. GALLAIS.* [1870]

The Court would not entertain a bill for the mere purpose of giving relief in damages for the infringement of a patent, when the bill had been filed so immediately before the expiration of the patent as to render it impossible to have obtained an interlocutory injunction. (*L. R.*, 10 *Eq.* 392; 22 *L. T. Rep.*, *N. S.*, 841.)

(n) *NEILSON v. BETTS.* *H. L.* [1871]

A patent having been sustained, the decree granted an injunction against further infringement, directed an inquiry as to damages and an account as to profits. The decree was varied by striking out, in accordance with the respondent's election, the order for the account of profits. Per Lord Westbury: "The two things are hardly reconcilable, for if you take an account of profits you condone the infringement." (*L. R.*, 5 *H. L.* 1.)

(o) *DE VITRE v. BETTS.* *H. L.* [1873]

The validity of the patent and the fact of infringement by the defendants having been decided in the plaintiff's favour, the Court below directed an account of profits made by the defendants by the use and exercise of the plaintiff's invention, and an inquiry what sum ought to be paid by the defendants in respect of damage sus-

tained by the plaintiff by the defendants' use and exercise of the plaintiff's invention.

The Lord Chancellor, on appeal to the House of Lords, said: "The case of *Neilson v. Betts* most undoubtedly decided the general principle that, upon a decree against a party for the infringement of a patent, the patentee is not entitled both to an account of profits and an inquiry into damages. That principle applies generally and without any distinction at all. It applies to every case of infringement; and, therefore, it must be taken to have settled conclusively that point, that the patentee must, in all these cases where he has a decree, elect whether he will have an account of profits or an inquiry into damages. He cannot have both." (*L. R.* 6 *H. L.* 321.)

(p) UNITED TELEPHONE COMPANY *v.* WALKER. [1886]

The plaintiffs, whose usual practice was not to sell but to let out their patented article at a royalty, obtained judgment for infringement, and an inquiry as to damages:—*Held*, that the measure of damages was the profit rental during the entire period, from the time when the article came into the possession of the infringer until the assessment of damages or delivery up of the article; that it was immaterial whether the article had been in actual use or not; and that the defendants could not set off the value of any infringing article delivered up under the judgment of the Court, nor any portion of an agreed sum for damages already recovered by the plaintiffs against the manufacturer, from whom the defendants bought the articles; although, at the time of such action being commenced, the goods were already in the possession of the defendants; but, that if the damages recovered from the manufacturer had been a sum representing the full rental or royalty, the defendants would have been entitled to set it off. (56 *L. T.* 508; 4 *O. R.* 63.)

(q) AMERICAN BRAIDED WIRE COMPANY *v.* THOMSON. [1888]

The Court of Appeal having granted an injunction and an inquiry as to damages, the plaintiff applied to the judge of first instance, that the inquiry might be referred to a judge and special jury for trial. Kekewich, J., was of opinion that he had no jurisdiction to make such an order: on appeal from this decision, the parties consented to a reference to an official referee, and the Court of Appeal reserved its opinion on the point, but decided that such an order should be asked for when the inquiry is granted. (5 *O. R.* 696.)

(r) UNITED HORSESHOE AND NAIL COMPANY *v.* STEWART AND CO. *H. L.* [1888]

Action by assignees of a patent, who did not grant licences, but themselves manufactured and sold the nails produced by their patented machinery. It was admitted that the defenders had sold a number of boxes of nails manufactured so as to infringe the

patent:—*Held*, that to the extent by which their trade was injured by the sales, the pursuers were entitled to substantial damages; that the measure of damage was not the profit made by the defenders, but the profit which the pursuers would have made out of such sales, deducting a fair percentage in respect of sales due to the particular exertions of the defenders; and that the possibility that the defenders might have manufactured similar nails, without infringing the patent, was no ground for reducing the damages to a nominal sum:—*Held*, further, that the fact that the pursuers had, in consequence of the unlawful competition of the defenders, reduced the price of nails sold by themselves, did not entitle them to recover additional damages in respect of the reduction in the profits on such sales.

The inherent illegality of a sale of goods manufactured without licence by patent machinery is not affected by the circumstance that the infringement consisted in using a small, and it may be the least useful, part of the invention. (13 *App. C.* 401.)

(s) *PROCTOR v. BAILEY*. [1889]

In an action for infringement, the Palatine Court has only power to grant damages, under Lord Cairns' Act, where it is proper to grant an injunction; and, therefore, if the infringement is of old date, and there is no evidence of intention to continue it, the Palatine Court has no jurisdiction. (6 *O. R.* 538.) But see p. 346 (g).

(t) *AMERICAN BRAIDED WIRE COMPANY v. THOMSON*. [1890]

In an action for infringement, an inquiry as to damages was ordered, and the official referee found substantially (1) that the reductions in prices made by the patentees were so made in consequence of the sales of the defendants; and that, subject to the following allowances, the plaintiffs would have made the sales made by the plaintiffs, and also those made by the defendants at the plaintiffs' original prices; (2) the additional profit which the plaintiffs would have made on their own sales, at the original price, would have been £7257, from which 20 per cent. was deducted as an allowance for the increase of sales due to the reduction in price; (3) the profit which the plaintiffs would have made on the articles made and sold by the defendants, if the plaintiffs had made and sold them at the original prices, would have been £4028, from which deductions were made (a) of 10 per cent. on account of sales due to the connection and exertions of the defendants, and (b) of 20 per cent. as an allowance for the increase of sales due to the reduction in price; or in the alternative, (4) the profits which the plaintiffs would have made on the articles made and sold by the defendants, if the plaintiffs had made and sold them at the prices which they were getting was £1838, from which a deduction of 10 per cent. was made on account of the connection and exertions of the defendants:—*Held*, by Kekewich, J., following the *United Horseshoe and Nail Company v. Stewart*, that if the patentee thinks fit to reduce the price, he is not entitled to recover the difference in price because it is not the natural and

direct consequence of the infringer's acts ; and that, therefore, the alternative measure (4) must be adopted instead of (3), and that the amount found in paragraph (2) must be omitted altogether. (7 O. R. 47.) But *held*, by the Court of Appeal, that the referee was justified in finding as a fact that but for the wrongful act of the defendants the plaintiffs would have sold, at the original prices, those bustles which in fact they sold at the lower price, and those which the defendants themselves sold at a lower price : that all the damages found were the direct and natural consequence of the wrongful acts done by the defendants, and that the plaintiffs were entitled to the full amount. (44 Ch. D. 274 ; 7 O. R. 152.)

*Practice.—New Trial.*

(u) WALTON v. POTTER. [1841]

Where the judge has left to the jury the specific issues raised on the record, and refused to put to them certain questions of fact, suggested by the defendant's counsel :—*Held*, no mis-direction, or ground for a new trial.

*Semble*, such questions can only be asked with the consent of all parties, and the jury are not bound to answer them. (11 L. J., C. P. 138.)

(v) PATTESON v. HOLLAND. [1845]

Where one action for infringement had been tried, and a rule *nisi* for a new trial had been obtained and argued, and another action was pending for another infringement of the same patent, and a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*. (*Hind. on Pat.* 293.)

(w) FERNIE v. YOUNG. H. L. [1866]

Where a Court of Chancery has directed an issue to try a question of fact, before a jury, or before a judge without a jury, and a verdict has been found by the jury or the judge, it will not enter into the question of fact and set aside the verdict without a motion for a new trial or for judgment *non obstante veredicto*. (L. R., 1 H. L. 80.)

(x) PENN v. BIBBY ; PENN v. JACK. [1866]

In dealing with the finding of the Court below, upon questions of fact, under the jurisdiction given by the Chancery Amendment Act, 1858, the Court of Appeal is placed precisely in the situation of the judges of the courts of common law when a rule is obtained to set aside the verdict of a jury ; consequently, the Court will not consider whether the finding was proper, but merely whether there was sufficient evidence to warrant the verdict. Where the motion for a new trial is grounded on the improper rejection of evidence, the evidence ought to have been formally tendered to the judge of the court below, and rejected by him. (L. R., 2 Ch. 127 ; 36 L. J., Ch. 455.)



(y) *DAW v. ELEY*. [1867]

A. obtained, in a suit against B. for infringement, a decree by which the validity of the patent was declared, and an injunction was granted to restrain infringement. If, upon motion to commit B. for breach of the injunction, it is shown that the patent had ceased to be of any validity at the date of decree:—*Held*, that the only mode of getting rid of the decree is by bill of review, showing that it was erroneous in delaring the patent to be valid and subsisting. (*L. R.*, 3 *Eq.* 509; 36 *L. J.*, *Ch.* 485.)

(z) *HINDE v. OSBORNE*. C. A. [1885]

In an action for infringement the defendants pleaded want of novelty, but withdrew the plea being unable to give particulars. On appeal they alleged that since the trial they had searched the records in the British Museum and were prepared to show that the invention was not novel. Brett, M. R.: “What is the principle of law applicable to such cases? It is that you cannot have a new trial under such circumstances unless you show that you have discovered fresh evidence, which by due diligence and care you could not have discovered before the trial. Here this is not made out; because one of the ordinary modes of objecting to the novelty of a patent, that is, of seeking for evidence to show that it is novel, is to go to those very places which the defendants’ advisers now say they have been to.” (*Griff.* 125; 2 *O. R.* 64, at p. 67.)

(a) *GERM MILLING COMPANY v. ROBINSON*. C. A. [1886]

The patentee being called by the plaintiffs, stated that he had publicly sold flour made according to his process before the date of the patent. The plaintiffs applied for a new trial on the ground that this was a slip, but their application was refused. (3 *O. R.* 399.)

*Practice—Appeals.*

*Appeals to the Law Officers.*

(By the Patents Act, 1883, sects. 7, 9 and 18, amended by 48 & 49 Vict. c. 63, and 51 and 52 Vict. c. 50, where the comptroller requires an amendment under sect. 7 or 9 of the Patents Act of 1883, or refuses leave to amend under sect. 18, and the applicant appeals, the law officer shall, if required, hear the applicant and the comptroller, and by sect. 11, amended by 51 and 52 Vict. c. 50, where notice of opposition is given under sect. 11, and the comptroller decides on the case and there is an appeal, the law officer shall, if required, hear the applicant and any person so giving notice and being in the opinion of the law officer entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made, and by sub-s. (4) the law officer may, if he thinks fit, obtain the assistance of an expert who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.)

[These sections 7, 9, 11 and 18, will be found set out in full on pp. 34, 35, 38, and 10, respectively.]

Patents Act, 1883, sect. 38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them

under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE  
LAW OFFICERS, 1883.

1. When any person intends to appeal to the law officer from a decision of the comptroller in any case in which such appeal is given by the Act, he shall within 14 days from the date of the decision appealed against file in the Patent Office a notice of such his intention.

2. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

3. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk, at room 549, Royal Courts of Justice, London; and when there has been an opposition before the comptroller, to the opponent or opponents; and when the comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

4. Upon notice of appeal being filed, the comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

5. No appeal shall be entertained of which notice is not given within 14 days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave upon application to the law officer.

6. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given.

7. Such notice shall in all cases be given to the comptroller and the appellant; and, when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

8. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

9. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer, there is good ground for not making such order.

10. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

11. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

12. If any costs so ordered to be paid be not paid within 14 days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act.

13. All documentary evidence required, or allowed by the law officer to be

filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

14. Any notice or other document required to be given to the law officers' clerk, under these rules, may be sent by a prepaid letter through the post.

*Appeals to the Court of Appeal.*

(a) *WASHBURN COMPANY v. PATTERSON.* [1884-5]

Where the defendant had been ordered to deliver up to the plaintiff the infringing machines, the Court refused to suspend the order pending an appeal unless the defendants undertook not to remove the machines out of the country or to use them meanwhile.

Where security for the costs of an appeal is ordered, and three months, or what the Court considers a reasonable time, has elapsed without such security being given, the appeal will be dismissed unless extenuating circumstances are shown. (*Griff.* 239; 1 *O. R.* 191; 2 *O. R.* 27.)

(b) *HINDE v. OSBORNE.* C. A. [1885]

On an application to the Court to hear fresh evidence on appeal, there must be some ground shown to satisfy the Court that there is some evidence now forthcoming which could not with due diligence have been got before, and such ground must be not merely swearing by affidavits or anything of that kind, but something in the nature of the production of a lost document which will not expose the parties to a mere flood of affidavits, made up to meet the defects disclosed at the trial. (*Griff.* 125; 2 *O. R.* 45.)

(c) *OTTO v. STEEL.* C. A. [1886]

Pearson, J., having refused a stay pending an appeal, the defendant appealed from such refusal. The defendant admitted infringement, but disputed the validity of the patent. *Held*, that as the patent had been established in this and in previous actions, it would not be right to stay the account or the operation of the injunction. (3 *O. R.* 121.)

(d) *WALKER v. HYDRO-CARBON SYNDICATE.* C. A. [1886]

Applications for leave to adduce further evidence on appeal, and to postpone the appeal from a decision dismissing a petition for revocation on the ground that the petitioner who desired to be present was abroad were both refused. (Afterwards the appeal was withdrawn by arrangement.) (3 *O. R.* 253.)

(e) *WATLING v. STEVENS.* C. A. [1886]

An appellant applied for leave to produce further evidence, but was refused as his affidavit did not show that the further evidence first came to his knowledge after the trial. On the second day he produced such an affidavit, but was told it was too late. (*Griff.* 242; 3 *O. R.* 150.)

(f) *BRITAIN v. HIRSCH.* C. A. [1888]

The Court of Appeal not being satisfied that the plaintiffs had not been deterred from asking one of their witnesses certain

questions by the expressed opinion of the judge, gave the appellants an opportunity of calling such witness and heard witnesses on behalf of the respondents upon the point. (5 O. R. 226.)

(g) ELLINGTON v. CLARK. C. A. [1888]

A copy of the judge's notes should be procured in all cases depending on the evidence of the appellant, or the case will be ordered to stand over at his expense. (5 O. R. 322.)

(g\*) SPENCER v. ANCOATS VALE RUBBER COMPANY. C. A. [1888]

The defendant company having agreed to an order restraining them from infringement, the plaintiffs subsequently moved to sequester the company's property, and to commit certain of the directors for breach of the injunction contained in the order, and on an appeal applied to introduce further evidence:—*Held*, that the application was an interlocutory one, and that the further evidence should be admitted. (6 O. R. 46.)

*Judgment on the Pleadings.*

(h) THE GROVER AND BAKER SEWING MACHINE COMPANY v. MILLARD. [1862]

In a case where the defendant, who was out of the jurisdiction of the Court, had not put in an answer, although the time for answering had long expired, and had never appeared to the bill, the Court, on the plaintiff applying for leave to enter an appearance in order to take the bill *pro confesso*, ordered that notice should be given to the defendant, that unless he put in an answer within fourteen days from the service of such notice, an appearance would be entered for him, and proceedings taken to take the bill *pro confesso*. (8 Jur., N. S. 713.)

(i) UNITED TELEPHONE COMPANY v. DONOHUE. C. A. [1886]

In an action for infringement of a patent the defendant in his defence admitted ten instances of infringement, but denied that he had committed any others. *Held*, that the plaintiff was entitled to a perpetual injunction, and an inquiry as to damages on the basis that there were ten instances of infringement and no more. (31 Ch. D. 399.)

(j) UNITED TELEPHONE COMPANY v. SMITH. [1889]

UNITED TELEPHONE COMPANY v. MITCHELL.

The plaintiffs in each action delivered particulars of breaches, and in their statements of claim stated "particulars of breaches are delivered herewith." No statement of defence was delivered in either action. On motion for judgment *Held*, that for the purpose of the judgment the particulars of breaches might be regarded as forming part of the statements of claim. (38 W. R. 70.)

*Practice—Costs.*

Patents Act, 1883, sect. 31. In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in

question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs charges and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.

(k) *GILLETT v. WILBY.* N. P. [1839]

In an action for the infringement of a patent three pleas were pleaded: 1st, the general issue; 2nd, that the alleged improvements were not new; and 3rd, that the plaintiffs were not the true and first inventors of the improvements:—*Held*, that the validity of the patent might be considered as having come in question under the second plea, so as to entitle the plaintiff to a certificate to that effect, under the 3rd section of the statute 5 & 6 Will. 4, c. 83. (1 *Web. P. C.* 270; 9 *C. & P.* 334.)

(l) *LOSH v. HAGUE.* [1839]

Where a defendant, in an action for the infringement of a patent, succeeds on a plea which goes to the whole action, he will be entitled to the general costs of the cause, deducting the costs of the objections on which the plaintiff has succeeded, and of the issues found for him. The certificate given by the judge under the 5 & 6 Will. 4, c. 83, s. 5, should be as to the determination of each objection of which notice has been given, and not as to the issues. (5 *M. & W.* 387; 7 *D. P. C.* 495; 3 *Jur.* 409.)

(m) *GILLETT v. GREEN.* [1841]

An action on the case for the infringement of a patent is within the operation of the 3 & 4 Vict. c. 24, s. 2; and notwithstanding the provisions of the stat. 5 & 6 Will. 4, c. 83, s. 3, the plaintiff, recovering only nominal damages, cannot have his full costs, or triple costs, without a certificate under the former Act. After the taxation the judge has no power to grant a certificate. (7 *M. & W.* 347; 9 *D. P. C.* 219; 1 *Web. P. C.* 271.)

(n) *STOCKER v. RODGERS.* N. P. [1843]

If, in an action for the infringement of a patent, the defendant plead not guilty, that the invention is not new, and that the specification is not sufficient; and the defendant at the trial consent to a verdict for the plaintiff, without any evidence being given, the judge will not certify under the stat. 5 & 6 Will. 4, c. 83, s. 3, "that the validity of the patent came in question before him." (1 *C. & K.* 99.)

Erskine, J., said: "My certificate would affect third parties; and it would be possible, in a case like the present, for two parties, by collusion, to consent to a verdict in favour of a patent, and, if they could obtain a certificate under the 3rd section of the statute, to use it afterwards to the injury of another party who was really contesting the validity of the patent." (*Ib.* 100.)

(n) *GEARY v. NORTON.* [1846]

The plaintiff is entitled to the costs of an injunction, although the defendant promises to commit no further act of infringement. (1 *De G. & S.* 9.)

(o) *STEVENS v. KEATING.* [1850]

On a bill filed for an injunction, the plaintiff obtained the injunction on motion, the defendant appearing and opposing the motion; the bill was subsequently dismissed with costs:—*Held*, that the defendant was entitled to the costs of the motion which he had unsuccessfully opposed. (1 *Mac. & G.* 659.)

(p) *NEWALL v. WILKINS.* N. P. [1851]

After the plaintiff in an action for infringement has obtained a verdict, the record of a former trial, in which the patent was affirmed, is admissible to show that the plaintiff is entitled to treble costs. The defendant's case ought not to be prejudiced by the admission of the evidence upon the trial; but it ought to be proved subsequently. (17 *L. T. Rep.* 20.)

(q) *LISTER v. LEATHER.* [1858]

Where the Court considers the plaintiff entitled to full costs as between solicitor and client, the decree or order should contain an express direction that the costs be so taxed, notwithstanding the 43rd section of the Patent Law Amendment Act, 1852, provides that he shall have such full costs, unless the judge shall certify that he ought not to have them. (4 *K. & J.* 425.)

(r) *CLARK v. FERGUSON.* [1859]

Where the bill, praying for an injunction to restrain the infringement of a patent, described the plaintiff as a lieutenant in Her Majesty's ship *Gladiator*, now on service, the Court refused to compel him to give security for costs. (1 *Giff.* 184.)

(s) *GREAVES v. THE EASTERN COUNTIES RAILWAY COMPANY.* [1859]

In an action for the infringement of a patent, defendants delivered, with their pleas, particulars of objections, pursuant to stat. 15 & 16 Vict. c. 83, s. 41. The plaintiff having abandoned his action before trial:—*Held*, that the defendants were entitled to the costs of the particulars and of the evidence in support of them, for sect. 43 does not apply, so as to limit the ordinary right to costs, except when the cause comes on for trial. (1 *Ell. & Ell.* 961; 28 *L. J., Q. B.* 290; 5 *Jur., N. S.* 733.) *Held*, also, that the cause not having been tried, the defendant, under 6 Geo. 4, c. 50, s. 34, was not entitled to the costs of a special jury applied for by him. (*Ib.*)

(t) *BETTS v. CLIFFORD.* [1860]

On a bill to restrain the infringement of a patent, a motion for injunction was ordered to stand over until after the trial of an action, nothing being said about costs. In the action, the plaintiff

succeeded on the issue as to the infringement, but failed in establishing the validity of his patent. The bill was afterwards dismissed with costs:—*Held*, that the defendant's costs of the motion were costs in the cause.

There must be some special circumstances, beyond the mere weight of the cause, to justify the allowance of the costs of a third counsel. Examples of such special circumstances are cases of illness, and cases where a junior counsel is called within the bar, and it becomes necessary, according to the rules of the bar, to retain another junior: and cases where the third counsel (of the common law bar) has been engaged in a case, the evidence and judge's notes in which form a substantive part of the plaintiff's case. (1 *J. & H.* 74.)

(u) *RENARD v. LEVINSTEIN.* [1864]

Where the defendant was ordered to pay costs incurred by him through amending his particulars of objections, the Court refused, on the application of the plaintiff, to put him upon the terms of giving security for their payment on proof that he had a place of business in England. (11 *L. T. Rep.*, *N. S.* 505; 13 *W. R.* 229.)

(v) *BOVILL v. HADLEY.* [1864]

The 43rd sect. of the 15 & 16 Vict. c. 83, enacts, that it shall be lawful for the judge before whom an action for infringing letters patent shall be tried, to certify on the record that the validity of the patent came in question; and that "the record, with such certificate, being given in evidence in any suit or action for infringing the said letters patent," shall entitle the plaintiff, on obtaining final judgment, to "his full costs, charges and expenses, taxed as between attorney and client," unless the judge shall certify that he ought not to have such full costs.

An action having been brought by a patentee (substantially) for the recovery of royalties under a due licence, a compromise was entered into before the plaintiff's case was closed, and an order of *nisi prius* was drawn up, under which the defendant was to pay an agreed sum, and a verdict was to be entered for the plaintiff in the action, for 40s. damages, and costs, with all "usual certificates." After the cause was thus disposed of, the presiding judge, upon an *ex parte* application, indorsed on the record a certificate that the record in a certain action wherein *Bovill* was plaintiff and *Keyworth* was defendant, and the certificate thereon indorsed, was given in evidence at the trial of this action:—*Held*, that this certificate was improperly granted, the record and certificate in the former action not having been given in evidence, and it not being under the circumstances a "usual certificate" within the contemplation of the parties. (17 *C. B.*, *N. S.* 435; 10 *L. T. Rep.*, *N. S.* 650.)

(w) *CURTIS v. PLATT.* [1864]

The defendant obtained further time to plead, on the terms that the cause should be put down for trial before issue joined, and that

short notice of trial should be taken. The pleas were delivered, and the plaintiff had a special jury nominated, but not struck. The action was then discontinued before issue joined or notice of trial given:—*Held*, that the circumstances of the case did not authorize a departure from the general rule, that costs incurred before notice of trial shall not be allowed. (33 *L. J., C. P.* 255; 10 *Jur., N. S.* 823; 10 *L. T. Rep., N. S.* 383.) Willes, J., said: “With respect to the second ground, it is contended, that as notice of objection is delivered with the pleas, the expenses incurred in preparing these objections ought to be allowed as accessory to these objections. But I am not satisfied that these expenses were connected with the objections; one instance given has been the looking into specifications of patents of a similar character; but the validity of such a claim would depend on whether the defendant knew, when he delivered the objections, the particulars of the invention, or whether he was merely making speculative inquiries. I have strong doubts whether such expenses should be allowed at all.” (10 *Jur., N. S.* 823.)

(x) *BETTS v. DE VITRE.* [1864]

The directors of a limited company, and acting as its agents, infringed a patent, and were made defendants, together with the company, to a suit, the bill in which prayed for an injunction and costs:—*Held*, that the decree must be made against the directors as well as the company, and that the directors were personally liable to pay the costs. (11 *Jur., N. S.* 9; 11 *L. T. Rep., N. S.* 533.) Sir W. Page Wood, V.-C.: “Where there is a wilful act against the rights of a patentee after he has obtained a verdict, and the certificate of a judge that his title came in question, all the world must be taken to know that that was fairly and completely tried and disposed of, and, if they infringe the patent, they infringe it, with a liability for costs, in consequence of the full right being disposed of.” (11 *Jur., N. S.* 11.)

(y) *ELLWOOD v. CHRISTY.* [1865]

In an action for the infringement of a patent, the plaintiffs claimed in their declaration a writ of injunction, and an account to be taken of all profits. The plaintiffs having obtained a verdict on all the issues, a rule *nisi* was obtained for the master to take an account of all profits made by the defendants. The defendants, on showing cause, made an affidavit stating what profits they had made. The Court made the rule absolute on the terms that, if the plaintiffs should not succeed in surcharging the account stated in the affidavit by one-sixth, they were to pay costs of the rule and inquiry. (13 *W. R.* 498.)

(z) *DAVENPORT v. RYLANDS.* [1865]

A patentee is entitled to costs as between solicitor and client at the discretion of the judge, under the 15 & 16 Vict. c. 83, s. 43, in any suit to protect his rights under a patent, the validity of which has been previously established, notwith-



standing the fact that the validity of the patent is not questioned in the subsequent suit. (*L. R.*, 1 *Eq.* 302; 35 *L. J.*, *Ch.* 204.)

(a) *NUNN v. D'ALBUQUERQUE.* [1865]

The defendant, having in ignorance infringed the plaintiff's patent, submitted, and he offered before suit to pay the amount of profits made, but did not offer to pay the plaintiff's costs. At the hearing, the Court refused to give the plaintiff his costs, although a perpetual injunction was granted. (34 *Beav.* 595.)

(b) *PENN v. BIBBY.* [1866]

Where, in a suit to restrain the infringement of a patent, issues are directed, and the judge certifies that the validity of the letters patent came in question, the plaintiff cannot, at the hearing of that suit, have more than party and party costs, the provisions of the 43rd section of the Patent Law Amendment Act, 1852, applying only to subsequent actions and suits. (*L. R.* 3 *Eq.* 308; 36 *L. J.*, *Ch.* 277.)

(c) *PENN v. BIBBY.* [1866]

Upon leave being granted to a defendant to re-amend objections by inserting certain further specified instances which had come to his knowledge, he was ordered to pay the costs of the application, and the costs arising out of and consequent upon the re-amendment were reserved. (*L. R.*, 1 *Eq.* 548.)

(d) *BETTS v. CLEAVER.* [1872]

Where a leader has been employed in a suit but not retained, the costs of employing him as third counsel at the hearing will not be allowed as between party and party, although the junior counsel who drew the pleadings has, before the hearing, been called within the bar.

A similar affidavit was filed by the plaintiff in each of several suits. The solicitor for the defendants took an office copy of the affidavit in one suit only, and examined at the Record Office the affidavits in the other suits:—*Held*, that he was not entitled to charge for perusing the affidavits in the other suits. (*L. R.*, 7 *Ch.* 513.)

(e) *DE VITRE v. BETTS.* *H. L.* [1873]

The appellants gave notice to the respondent that a decision favourable to their contention on one point of the pending appeal having been given in another case by a court of final appeal, they were prepared to withdraw from the remaining points of their appeal and pay the respondent's costs up to the date of their doing so, on condition that the respondent would consent to a variation in the order appealed from, in conformity with the decision favourable to the appellants' one contention which had been so given during the pendency of the appeal. The appellants added, that in the event of the respondent rendering it necessary to proceed

with the appeal in spite of such decision they should, if successful, ask for the costs of the appeal. The respondent declined to consent to such variation:—*Held*, that he must pay the costs of the appeal from the date of his refusal to accede to the appellants' proposal. (21 W. R. 705.)

(f) SMITH *v.* BULLER. V.-C. M. [1875]

On taxation of costs as between party and party, the only costs chargeable against the unsuccessful party are such as are necessary for the conduct of the litigation. Any charges merely for conducting litigation more conveniently may be called luxuries, and must be paid by the party incurring them. *E.g.*, the costs of drawings of exhibits affixed to the margin of counsel's briefs were disallowed.

Charges for the attendance of a solicitor's clerk in addition to the solicitor on cross-examination will not in any case be allowed.

The charge to be allowed for counsel's fees for cross-examination will not ordinarily exceed £5 5s. a day after the first, for which a larger fee may be allowed in heavy cases; and where the case is long and complicated, as much as £7 7s. a day may be allowed for the subsequent days.

A moderate fee, such as £7 7s. a day, may be allowed for a scientific witness to read up a case for the purpose of giving evidence.

The burden of proving the necessity for employing three counsel rests with the person who employs them, regard being had to the nature of the case, the length of the evidence, the subject-matter of the suit, and the amount of property involved.

The rule of the Common Law Courts as to refreshers applies to the hearing of heavy suits in Chancery, whether on written or *vivâ voce* evidence, the brief fee being taken to cover two days. (*L. R.*, 19 *Eq.* 473.)

(g) BATLEY *v.* KYNOCK. V.-C. B. [1875]

In a suit to restrain infringement, the plaintiff, before the hearing, obtained the common order to dismiss the bill with costs. On taxation, objection was taken to the allowance of drawing particulars of breaches and settling same by counsel, on the ground that, by 15 & 16 Vict. c. 83, s. 43, costs "shall not be allowed in respect of any particular, unless certified by the judge before whom the trial was heard to have been proved by such plaintiff or defendant respectively." (*L. R.* 20 *Eq.* 632.)

Bacon, V.-C.: "I cannot say that the Master, in refusing to disallow the defendants' costs of preparing their defence, was wrong. . . . The state of circumstances contemplated by the statute never did, and never could, arise. The case referred to at common law, *Honiball v. Bloomer* (10 *Exch.* 538), has no application to the present case."

A second objection referred to the payments made to scientific witnesses. Bacon, V.-C., adopted the rule of the Court as stated by

the officer of the Court, who reported that "It is the practice in equity to allow a proper remuneration to scientific witnesses." But added, "But great care is necessary in dealing with such charges in party and party costs." (*Ib.* 637.)

A third objection was as to a model prepared for the hearing. Bacon, V.-C.: "In cases of patents where scientific evidence is brought in, the use of a model is, in many instances, indispensable. Very often neither the plaintiffs nor the defendants can put their case before the Court at all without the assistance of a model. Even when not indispensable, it is often eminently useful, without laying either party open to the charge of indulging in the luxuries of which V.-C. Malins (*Smith v. Buller*) spoke." (*Ib.* 638.)

(g\*) *BALL v. LELM.* [1881]

The defendant strenuously resisted the plaintiff's action for infringement until he came into Court, when he submitted to judgment. Kay, J., refused to give a certificate that the validity came in question. (*Times*, 14th April, 1881.)

(h) *EDISON TELEPHONE COMPANY v. INDIA RUBBER COMPANY.* [1881]

Where after issue joined, and a day has been fixed for the hearing, the defendant obtains leave to amend his particulars of objection, all costs incurred by the plaintiff subsequently to the delivery of the original particulars of objection must be paid by the defendant, in case the plaintiff elects within a time fixed by the order to discontinue the action. (17 *Ch. D.* 137.)

(i) *UNITED TELEPHONE COMPANY v. HARRISON, COX, WALKER AND COMPANY.* [1882]

Where at the trial of an action for infringement the Court is of opinion that there has been infringement, but holds on a legal ground that the patent is void, it would not give the plaintiff a certificate under sect. 43 of the Patents Act, 1852, that breaches by the defendant had been proved. (21 *Ch. D.* 720.)

(j) *WATSON v. HOLLIDAY.* [1882]

When a bankrupt, sued for infringement of a patent, does not appear at the hearing, and his trustees appear and defend, they are liable to the costs of the action. (20 *Ch. D.* 780.)

(k) *LISTER v. NORTON.* [1884]

Motions for interlocutory injunctions stand on a different footing in patent cases. Where there is an independent case against a motion, so that the defendant may say, "If you succeed at the trial yet you must have failed on the motion by reason of the delay, and therefore you have exposed me in any view to unnecessary expense," it is better then to order the motion to stand to the trial, if the defendant asks for it, instead of merely making the costs in the motion costs in the action. (*Griff.* 149; 1 *O. R.* 114.)

## (l) MOORE v. BENNETT. H. L. [1884]

On appeal the general rule is that where there is a successful party, *i.e.* a party who has brought an appeal and succeeded, *prima facie*, he gets the costs of the appeal. Where there is an appeal upon two grounds, and the appellant succeeds upon one and the respondent upon the other, the party who has succeeded upon one was justified in bringing the appeal, but he has not succeeded altogether, and he does not get the costs. (*Griff.* 158; 1 O. R. 129.)

## (m) PERONI v. HUDSON. [1884]

In an action for infringement the defendant delivered a defence and particulars of objections, but did not appear at the trial. Kay, J., refused an application that costs might be on the higher scale. He gave a certificate that the plaintiff had proved his particulars, but refused to certify that the patent had come in question, holding that sect. 31 only applied where the patent was established in a case contested in court. (*Griff.* 184; 1 O. R. 261.) But see *Haydock v. Bradbury*, p. 391 (u).

## (n) UNITED TELEPHONE COMPANY v. TOWNSHEND. [1885]

When the defendant was willing to agree to submit to a perpetual injunction, and to pay party and party costs, but the plaintiffs having a certificate that the validity of the patent had already come in question, claimed solicitor and client costs:—*Held*, that if the defendants consented to treat the hearing of the motion as the trial of the action the order must be for solicitor and client's costs. (3 O. R. 10.)

## (o) CROPPER v. SMITH AND HANCOCK. [1885]

The defendant Smith delivered three objections, the first only of which was relied on by Hancock in his particulars. The House of Lords held that the first two objections failed, but that the third objection was sufficient to invalidate the patent, and that Hancock was not shut out from the benefit of that decision. Pearson, J., being applied to by both defendants as judge of first instance for a certificate, certified that the defendant Smith had established his third objection. (*W. N.* 1885, p. 111.)

## (p) BADISCHE ANILIN UND SODA FABRIK v. LEVINSTEIN. [1885]

Where it was held that a patentee had failed in establishing the validity of his patent, but succeeded on the issue of infringement: ordered that the plaintiff should pay the general costs of the action, but that the defendant should pay the costs occasioned by the issue of infringement, the one set of costs to be set off against the other. (29 Ch. D. 366.) There was a cross appeal to the House of Lords on this order, but as the main appeal was successful, it became unnecessary for the cross appeal to be considered. (10 App. C. 710.)

## (q) POOLEY v. POINTON. [1885]

Pearson J.: "The Court of Appeal have lately decided (and I am glad they have been able to come to that decision), that although the patent of the plaintiff may be absolutely bad and may be no patent at all, nevertheless if the defendant chooses to deny the infringement of the patent, assuming the patent to be good, and puts the plaintiff to the expense of meeting that issue, infringement or no infringement, even if the plaintiff fails in the main subject of the suit, by reason of his patent not being a good patent, he is nevertheless entitled, as against the defendant, to the costs of the issue in respect of the infringement." (*Griff.* 199; 2 *O. R.* 167, at p. 169.)

## (r) PARNELL v. MORT LIDDELL &amp; Co. C. A. [1885]

The Court of the County Palatine is not affected by the Patent Law Amendment Act, 1852. At the trial of an action for infringement the judge held that the patent was bad on its face and dismissed the action with costs, saying that the defendants ought to have the costs of the witnesses brought to support their particulars of objections, although not called. *Held*, that there was no obligation on a Court of Equity not bound by the Act to follow the rule as to costs of particulars of objections in the Patents Act of 1852, and that therefore the judge had power to give these costs. (29 *Ch. D.* 325.)

## (s) HOCKING v. FRASER. [1885]

Where the plaintiffs claimed for infringement of two patents and succeeded on the first, but offered no evidence as to the second: —*Held*, that the defendants were entitled to be paid the costs so far as they were increased by the second claim. (*Griff.* 129; 3 *O. R.* 3.)

## (t) UNITED TELEPHONE COMPANY v. FLEMING. (No. 2.) [1886]

A statement of claim and particulars of breaches having been delivered and no defence having been put in, Chitty, J., ordered an injunction and delivery up of instruments and costs as between solicitor and client up to and including judgment, but not the costs of the inquiry until after it had been held. The learned judge said: "I never part with the control of the costs; it is my fixed rule." (3 *O. R.* 282.)

## (u) HAYDOCK v. BRADBURY. [1886]

In an action for infringement the defendant denied infringement and put in issue the validity of the patent, but did not appear at the trial. *Held*, that the plaintiff on proving his case was entitled to a certificate that the validity of the patent came in question. (4 *O. R.* 74.)

## (v) GUILBERT MARTIN v. KERR. [1886]

Costs of the issue of infringement were refused to the unsuccessful

ful plaintiffs on the ground that the issue was not sufficiently distinct from the rest of the case. (4 O. R. 23.)

(w) *EASTERBROOK v. GREAT WESTERN RAILWAY COMPANY.* [1886]

A patentee who cannot do what he professes to do, ought not to block the way for other inventors and harass them with actions when they have succeeded where he has failed. In such an action when the questions of utility and infringement could not be separated, the Court would not take away from the defendants the costs of the issue of infringement when they had succeeded as to utility. (2 O. R. 210; *Griff.* 85.)

(x) *ROWCLIFFE v. MORRIS.* [1886]

In an action for infringement Bristow, V.-C., held the patent invalid and dismissed the action with costs. The defendant did not apply at the trial for a certificate that he had proved his particulars of objections, but moved for one six months afterwards. The plaintiff opposed the motion. The Vice-Chancellor granted the certificate but gave no costs of the motion. (3 O. R. 145.) But see next case.

(y) *PROCTOR v. SUTTON LODGE CHEMICAL CO.* [1887]

The Vice-Chancellor of the County Palatine is not a "Court" or a "Judge" within sect. 31, and consequently a certificate granted by him that the validity of a patent came in question is useless, and will not entitle the plaintiff in a subsequent action to solicitor and client's costs. (5 O. R. 184.) [But now see 53 & 54 Vict. c. 23, s. 3.] This action being vexatious, the judge *ex abundante cautela* gave a certificate depriving the plaintiff of such costs.

(z) *KAYE v. CHUBB.* C. A. [1887]

The costs of the issue of infringement on which the plaintiff succeeded being trifling, and the patent being held to have been anticipated, the Court of Appeal, exercising the same discretion as the judge at the trial would have done, gave the defendants the whole costs of the action. (4 O. R. 289.)

(a) *AMERICAN BRAIDED WIRE COMPANY v. THOMSON.* [1887]

Costs of issues raised by some of the defendants' particulars of objection as to which no evidence had been offered, ordered to be paid by the defendants although on the whole successful. (4 O. R. 322.) (The decision in the defendants' favour was afterwards reversed, see p. 261 (b).)

(b) *ROTHWELL v. KING.* [1887]

The plaintiff had obtained an interim injunction on giving the usual undertaking as to damages. The injunction was subsequently dissolved by consent without prejudice to the undertaking. *Held*, in the Palatine Court, that the defendant was entitled to an inquiry as to damages and an order for the payment thereof and for payment of the costs of the motion, and of the

inquiry, and that the costs of the inquiry ought not to be reserved. (4 O. R. 76.) :—*Held*, subsequently, that the Court could not give the defendants a certificate as to their particulars of objection. (4 O. R. 397.)

(c) *FLETCHER v. ARDEN*.

A certificate of particulars of objection was given with a direction that it should not operate to duplicate costs. (5 O. R. 59.)

(d) *BADHAM v. BIRD*. [1888]

The certificate as to particulars of objections was limited to those which were put to the plaintiff in cross-examination. (5 O. R. 238.)

(e) *Longbottom v. Shaw*. } [1888]  
and *Oddy v. Smith*. }

Certificates of particulars of objections, which the successful defendants had had no opportunity of proving, were refused. (5 O. R. 502, 509.)

(f) *CRAMPTON v. THE PATENTS INVESTMENT COMPANY*. [1888]

A certificate of validity was granted in an action to restrain threats without prejudice to the effect of such certificate. (5 O. R. 404.)

(g) *HASLAM FOUNDRY AND ENGINEERING COMPANY v. HALL*. C. A. [1888]

A certificate made under sect. 31 of the Patents Act of 1883, that the validity of the patent came in question, is not a judgment or order against which an appeal lies under sect. 19 of the Judicature Acts, 1873. (20 Q. B. D. 491.)

A certificate had been granted that the validity of the patent came in question, although the patent was held invalid. (5 O. R. 144.)

(h) *ELLINGTON v. CLARK BURNETT AND Co*. C. A. [1888]

When the plaintiffs brought scientific witnesses and thereby rendered it necessary for the defendants also to bring scientific witnesses, and it was held that there was no infringement :—*Held*, that costs ought to be allowed on the higher scale. (5 O. R. 319.)

(i) *COLE v. SAQUI AND LAWRENCE*. C. A. [1888]

The Court of Appeal, in reversing a decision in favour of a patent, has jurisdiction to grant a certificate that the particulars of objection were reasonable and proper so as to entitle the defendant to costs in respect thereof. (40 Ch. D. 132.)

(j) *BLAKEY v. LATHAM*. [1888]

Where a patent was held to be invalid, but the Court said that "If the patent was valid there had been an infringement," the Court refused to insert a declaration in the judgment that there

had been an infringement, or to allow the plaintiffs any cost in respect of such issue. (*W. N.* 1888, p. 126.)

(*k*) *BLANK v. FOOTMAN.* [1888]

Where there is a distinct issue upon which the generally successful party fails, and that issue can be separated from the others so that you may show that it has really no immediate connection with those upon which the party has succeeded, he ought not to have the costs of that issue on which he has failed, and which presumably ought never to have been raised. (5 *O. R.* 661.) The costs of such a separate issue were in this case given to the unsuccessful plaintiff.

(*l*) *GOULARD AND GIBBS' PATENT.* [1888]

On a petition for revocation the judge was of opinion that there was no power to give a certificate as to particulars of objections. (5 *O. R.* 537.)

(*m*) *TICKELPENNY v. ARMY AND NAVY CO-OPERATIVE SOCIETY.* [1888]

Costs of particulars not proved by plaintiffs not given to defendants. (5 *O. R.* 411.)

(*n*) *KAYE v. CHUBB.* H. L. [1888]

Costs paid without an undertaking to refund can be ordered to be repaid on appeal. (5 *O. R.* 653.)

(*o*) *WARD v. LIVESEY.* [1888]

The plaintiff charged his licensee with fraud in relation to the accounts rendered, but failed to support such charge. *Held*, that although entitled on the whole to the relief asked for, the plaintiff was not entitled to get his costs up to and including the trial, but that each party must pay their own. (5 *O. R.* 110.)

(*p*) *EDISON AND SWAN ELECTRIC LIGHT COMPANY v. HOLLAND,* [1889]

Where a certificate of validity has been granted in a former action, another one will not be granted, lest doubt should be thrown on the sufficiency of the first. (6 *O. R.* 243.) The third parties being the real defendants were made liable for the costs. (41 *Ch. D.* 28.)

(*r*) *AUTOMATIC WEIGHING MACHINE COMPANY v. INTERNATIONAL HYGIENIC SOCIETY.* [1889]

*Held*, by Charles, J., that where a certificate had been granted that the validity of the patent came in question, but this action had been commenced before such certificate was granted, sect. 31 had no application, and that was not altered by the defendants having amended their defence after the certificate was granted:—*Held*, further, that even if sect. 31 did apply, as the only question was infringement of an admittedly valid patent, a certificate ought to be granted that the plaintiff ought not to have his costs as between solicitor and client. (6 *O. R.* 475.)



(s) UNITED TELEPHONE COMPANY *v.* PATTERSON. [1889]

In an action for infringement, the defendant did not dispute the validity of the patents, but denied infringement, and in the alternative paid £75 into court. The plaintiffs proved certificates of the validity of the patents having been previously tried, and the defendant, at the hearing, submitted to an injunction and an inquiry, but objected to paying solicitor and client costs, as the validity had not been disputed:—*Held*, by Chitty, J., that the mere fact that the validity of the patent was not called in question, was no ground by itself for the judge exercising his discretion, and certifying that the plaintiff ought not to have solicitor and client costs:—*Held*, further, that the costs of the inquiry, and as to the issue concerning damages must be reserved until after the inquiry, but with that exception, the plaintiff must have solicitor and client costs up to judgment. (6 *O. R.* 140; 60 *L. T.* 315.)

(t) SHAW *v.* JONES. [1889]

In an action for infringement, Smith, J., gave judgment for the plaintiffs, with an injunction and costs, and referred it to the referee to take an account, and gave him jurisdiction over the costs of the reference, in order that if the plaintiffs insisted on taking an account, which turned out to be a trumpety thing, they might not have the costs of doing it. (6 *O. R.* 328.)

## (u) EDMUNDS' PATENT. [1889]

Where in a petition for revocation, the question of fact had been sent to be tried by a judge at assizes, and the judge found that the patent should be revoked, but declined to deal with anything beyond the facts:—*Held*, that the Chancery Division had power to deal with the costs, and that the petitioner ought to have them. (6 *O. R.* 355.)

(v) GARRARD *v.* EDGE. C. A. [1890]

The defendants having succeeded on the ground of non-infringement, the taxing-master disallowed the costs of their particulars of objections, as no certificate had been obtained. The plaintiff then carried in for taxation a bill of costs occasioned by his having had to meet the defendants' objections:—*Held*, that as the costs of defendants' particulars were only disallowed in consequence of the absence of a certificate, and not because their objections were unreasonable, the taxing-master could not allow any of the plaintiff's costs of meeting those objections. If the plaintiff considers that in consequence of unreasonable objections he has incurred extra costs, he ought to ask the Court to direct the taxing-master to consider that question, and to direct that defendants shall pay the costs so incurred. (42 *L. T.* 510; 38 *W. R.* 455.)

**Presumption** that patentee is inventor, p. 363 (*l*), (*m*).

**Principle** as subject-matter of patent. See under Subject-matter, pp. 540 to 544.

**Privy Council.** Jurisdiction of, to grant extension, pp. 105, 106.  
Rules as to petition to, pp. 98, 99.

**Procedure.** See Practice.

**Process,** as subject-matter of patent. See under Subject-matter, pp. 511 to 518.

**Profits.** Account of. See Practice, Account, pp. 367 to 373.

**Prohibition to Attorney-General** will not lie, pp. 15 (*h*), 396 (*a*).

(*a*) VAN GELDER'S PATENT. C. A. [1888]

The Attorney-General is not a Court, and no prohibition will lie to prevent him from granting leave to amend by disclaimer. (6 *O. R.* 22.)

**Prolongation of Patent.** See Extension.

**Proof.** See Practice, Evidence, pp. 358 to 366.

**Protection by Specification.** See Specification.

*Provisional Protection.*

PATENTS ACT, 1883, s. 14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

*Protection by Complete Specification.*

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

**Provisional Specification.** See Specification, pp. 411 to 414.

**Publication** in a book or specification. See under Novelty, pp. 244 to 261  
by experiments. See under Novelty, pp. 261 to 265  
by sale. See under Novelty, pp. 265 to 267.

**Public Use.** See under Novelty, pp. 232 to 242.

**Rectification of Register.** See under Register.

**Refusal of grant** by comptroller.

PATENTS ACT, 1883, sect. 86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

**Register.**

to be kept at Patent Office. Patents Act, 1883, s. 23, p. 397  
to be *primâ facie* evidence, sect. 23 (2), p. 397  
trust not to be entered on, sect. 85, p. 397

proprietor to be entered on. Patents Acts, 1883, sect. 87, and 1888, s. 21, p. 397

to be open to public. Patents Acts, 1883, s. 88, and 1888, s. 22, p. 397.

certified extracts from, to be evidence, sect. 89, p. 75

rectification of. Patents Acts, 1883, ss. 90 and 91, and 1888, s. 23, p. 397

making false entry in, sect. 93, p. 398.

#### *Registration—*

must be proved on action for infringement by assignee, p. 399 (*w*)

absence of, need not be specified in notices of objection, p. 399 (*w*)

where objection to, cannot be maintained, p. 400 (*z*)

may be expunged by Court, sect. 90, p. 397

or corrected, sect. 90, p. 397

relates back to day of assignment, p. 400 (*z*).

#### *Register.*

PATENTS ACT, 1883, sect. 23. (1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

(2.) The Register of Patents shall be *prima facie* evidence of any matters by this Act directed or authorised to be inserted therein.

(3.) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

Sect. 85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive.

Sect. 87 (amended by 51 & 52 Vict. c. 50, sect. 21). Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, in the Register of Patents. The person for the time being entered in the Register of Patents, as proprietor of a patent, shall, subject to *the provisions of this Act and to* any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing. Provided that any equities in respect of such patent may be enforced in like manner as in respect of any other personal property.

Sect. 88 (amended by 51 & 52 Vict. c. 50, sect. 22). Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to *the provisions of this Act and to* such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Sect. 90 (amended by 51 & 52 Vict. c. 50, sect. 23). (1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person *or of any other particulars* from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any

question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

Sect. 91. The comptroller may on request in writing accompanied by the prescribed fee. (a) Correct any clerical error in or in connection with an application for a patent; or (b) Correct any clerical error in the name style or address of the registered proprietor of a patent.

Sect. 93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

Sect. 114. (1) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

PATENT RULES, 1890, rule 67. Upon the sealing of a patent the comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

68. Where a person becomes entitled to a patent or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the comptroller, and left at the Patent Office.

69. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorised to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorised in like manner.

70. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to show the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

71. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall be produced to the comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the comptroller.

72. There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

73. A body corporate may be registered as proprietor by its corporate name.

74. Where an order has been made by Her Majesty in Council for the extension of a patent for a further term or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent or

the rectification of the register under section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified or the purport of such order shall otherwise be duly entered in the register, as the case may be.

75. Upon the issue of a certificate of payment under Rule 48, the comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate.

76. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register.

77. An attested copy of every licence granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the comptroller may direct, and the original licence shall at the same time be produced and left at the Patent Office if required for further verification.

78. The register of patents shall be open to the inspection of the public on every week day between the hours of ten and four, except on the days and the times following:—

- (a.) Christmas Day, Good Friday, the day observed as Her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England; or
- (b.) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office:
- (c.) Times when the register is required for any purpose of official use.

### Registration.

#### (v) *In re GREEN'S PATENT.* [1857]

A patentee, in 1853, assigned his patent, but the assignees omitted to register it. In 1855 the patentee assigned the patent to another person, who registered it on the same day. The first assignees registered their assignment a week afterwards. The Court, in 1857, on the motion of the first assignees, ordered the register of the second assignment to be expunged, and with costs, under the 38th sect. of 15 & 16 Vict. c. 83. (24 *Beav.* 145.)

#### (w) *CHOLLET v. HOFFMAN.* [1857].

To a declaration for the infringement of a patent, brought by an alleged assignee (by deed) of the patent, the defendant pleaded, by denying the assignment, *modo et formâ*. On the trial, it appeared that an instrument of assignment had been executed by the patentee, but that it had not been registered under 15 & 16 Vict. c. 83:—*Held*, that as, by sect. 35, the original patentee was, until the entry of the registration, to be deemed and taken to be the sole and exclusive proprietor of the patent, the defendant was entitled to a verdict, although the objection was not specified in the notice of objections delivered by him. (7 *Ell. & B.* 686; 3 *Jur.*, N. S. 935; 26 *L. J.*, Q. B. 249.)

#### (x) *In re MOREY'S PATENT.* [1858]

Under the 38th sect. of the 15 & 16 Vict. c. 83, the Court could, on motion, expunge an entry fraudulently made in the Register of

Proprietors of Patents; it could direct any facts relating to the proprietorship to be inserted on the register, but not the legal inference to be drawn from them. A patentee assigned half a patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a licence, to work and use, to A. B.'s assignment was first registered:—*Held*, that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register, that the licence referred to in B.'s assignment was the deed of assignment to A. subsequently entered. (25 *Beav.* 581; 6 *W. R.* 612.)

(y) *In re* HORSLEY AND KNIGHTON'S PATENT. [1869]

The Court will, on the motion of the persons aggrieved, correct an entry in the Register of Proprietors of Patents, which purports to affect the right of persons not parties to the deed registered. One of two joint patentees by deed assigned his interest in the patent to a third person, and released to him all the rights of action, &c., against him of both the patentees, and the deed was set out completely in the Register of Proprietors:—*Held*, that the other patentee was entitled, under the 38th section of the Patent Law Amendment Act, 1852, to have the entry struck out. (*L. R.*, 8 *Eq.* 475; 39 *L. J.*, *Ch.* 157.)

There was no right of appeal against an order made by the Master of the Rolls to expunge an entry in the register. (*L. R.*, 4 *Ch.* 784; 17 *W. R.* 1000.)

(z) *HASSALL v. WRIGHT.* *Ch.* [1870]

W., a patentee, agreed with H., that H. should be the sole manufacturer under the patent. This agreement was embodied in a deed, which was prepared by the solicitor of W., H. employing no legal adviser. The deed was not registered in accordance with the Patent Law Amendment Act, 1852, s. 35, until after bill filed. Subsequently W. granted a right of manufacture to M., who had full notice of the previous agreement with H. The grant to M. was also unregistered:—*Held*, that, under the circumstances, W. could not avail himself of an objection based upon the non-registration of the agreement with H., and that as the grant to M. was also unregistered, M. also was not entitled to take the objection. *Semble*, that the subsequent registration had relation back to the date of the agreement. (40 *L. J.*, *Ch.* 145.)

(a) *In re* MORGAN'S PATENT. [1876]

This was a motion by a transferee of letters patent to have an entry of a subsequent assignment of the same letters patent in the Register of Proprietors of Patents expunged, under sect. 38 of 15 & 16 Vict. c. 83. A difficulty arose how the notice of motion should be intituled, having regard to the Judicature Act, 1873, and it was *Held*, that it should be intituled in the High Court of Justice. (24 *W. R.* 245.)

(b) *In re* MYER'S PATENT. [1882]

Under the Patent Law Amendment Act, 1852, sect. 38, and the

Judicature Acts, a judge of the High Court had jurisdiction to expunge an entry. (*W. N.* 1882, 53.)

(b\*) **PARNELL'S PATENT.** [1888]

Parnell and Halkett having signed a document relating to their shares in a patent proposed to be taken out by Parnell, and Parnell having taken out a patent, Halkett applied to the comptroller to register the document. The comptroller refused on the ground that the document was dated before the grant of the patent.—*Held*, that, whether this was a good ground or not, the refusal was justified, because the document did not show that the applicant was a proprietor. (5 *O. R.* 126.)

(c) **HEAP v. HARTLEY.** C. A. [1889]

The patentee had granted to the plaintiff an exclusive licence to use his invention within a certain district, and the licence was duly registered. The defendants bought machines outside the district, which had been purchased from the patentee, and brought them into the district and used them:—*Held*, at the trial, that registration was not in itself notice to the world, and that the defendants had not actual notice of the licence. (5 *O. R.* 603.)—*Held*, by the Court of Appeal, that the plaintiff, being only a licensee, was not entitled to sue in his own name without joining the patentee, and that it was therefore immaterial to consider whether sect. 87 of the Act of 1883 did or did not render the act of the defendants an infringement. (42 *Ch. D.* 461; 6 *O. R.* 495.)

**Remuneration** of inventor considered on petition for extension, pp. 120–127.

**Renewal.** The payments of £50 and £100 for renewal are now required at the ends of the fourth or eighth year from the date of the patent, instead of at the ends of the fourth or seventh year, see p. 143.

**Repair** of patented machines, p. 21 (c), 182 (i).

**Repeal.** See Revocation.

**Repugnancy** between title and description, see pp. 565–569  
between provisional and complete specification, pp. 414–421.

## Revocation of Patent.

petition to Court for. Patents Act, 1883, sect. 26, p. 402  
grounds of, sect. 26 (3), p. 402  
by whom presented, sect. 26 (4), p. 402  
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PATENTS ACT, 1883, sect. 26. (1.) The proceeding by *scire facias* to repeal a patent is hereby abolished.

(2.) Revocation of a patent may be obtained on petition to the Court.

(3.) Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

(4.) A petition for revocation of a patent may be presented by—

(a.) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

(b.) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland :

(c.) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims :

(d.) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee :

(e.) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

(6.) Particulars delivered may be from time to time amended by leave of the Court or a judge.

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

(d) REGINA v. BETTS AND STOCKER. [1850]

Where a patent had been granted to two jointly, and one of the patentees had assigned all his interest to the other, *Held*, that both were rightly made defendants in an action of *scire facias*. (19 L. J., Q. B. 531.)

(e) WALKER v. HYDROCARBON SYNDICATE. [1884]

A patentee, whose patent was dated in 1875, petitioned for the revocation of two patents, dated 1880 and 1881, for improvements in apparatus for generating heat from hydrocarbon oils. Evidence of a specification prior to 1875, describing a method similar to the petitioner's was admitted, although no notice had been given of it, to show the state of knowledge in 1875 :—*Held*, that, eliminating from the petitioner's patent matters of common knowledge, the inventions claimed were not similar, and the petition was dismissed. (*Griff.* 238 ; 2 O. R. 3.)



(f) *In re HADDAN'S PATENT.* [1885]

It is the practice now, if the Court thinks fit, to allow a petitioner, under sect. 26 of the Patents Act of 1883, to administer interrogatories to the claimant of a patent. (*W. N.* 1884, 192; 54 *L. J.*, *Ch.* 126; 51 *L. T.* 190; 33 *W. R.* 96.) The petitioner showed that for many years he had been manufacturing food by a process similar to that patented:—*Held*, that the patent must be revoked. (2 *O. R.* 218.)

(g) *In re AVERY'S PATENTS.* C. A. [1887]

Sect. 26, sub-sect. 4 (c) of the Patents Act of 1883 applies only to cases of fraud, and will not be extended to cases of mistake. Avery, a subject of the United States, gave a power of attorney to his agent in England with instructions to take out a patent. The agent appointed Lindsay, who was interested in the proposed patent, his substitute, as Avery's attorney, to apply for the grant. Lindsay being advised by a patent agent that he might properly describe himself as the true and first inventor, applied for and obtained a grant to himself in his own name, without declaring, as required, that the application was made on communication from abroad. Kimber, a solicitor, as attorney for Avery, presented a petition for the revocation of the patent, and a declaration that Avery was the first and true inventor. The petition contained no distinct allegation that Avery was the first and true inventor. Stirling, J., ordered the petition to be amended, by making Avery sole petitioner, and all persons beneficially interested in the patent respondents:—*Held*, that the petition was clearly intended to be under clause (c), and, therefore failed, as there was no fraud proved; but it was dismissed, without prejudice to any petition which Avery might present under clause (d) of sub-sect. 4. (36 *Ch. D.* 307; 4 *O. R.* 152, 322.)

(h) *In re MORGAN'S PATENT.* [1888]

Any person having any qualification mentioned in sect. 26 of the Patents Act of 1883 may petition for revocation. The petitioner alleged that he had, many years prior to the date of the patent, publicly made and sold carriages, made according to the alleged invention; and that, by reason of the matters set forth in the petition, and of the other matters appearing in the particulars of objections (which related to acts of prior user by other persons), the letters patent were invalid:—*Held*, that when the petitioner was once qualified, and his petition presented, it was open to him to impeach the patent on any lawful ground. (58 *L. T.* 713; 5 *O. R.* 186.)

(i) *In re EDMOND'S PATENT.* [1889]

A petition for revocation is in the nature of an "action" or "matter," so that there is power to order it to be tried at the assizes. (*W. N.* 1888, p. 234.) The patent was revoked, on the ground that the patentee had obtained it from the petitioner, and that the petitioner had commonly used the invention before the date of the patent. (6 *O. R.* 355.)

(j) *In re* GOULARD AND GIBBS' PATENT. C. A. [1889]

A petition for the revocation of a patent, under sect. 26 of the Patents Act of 1883, is in every sense an action, except that it is not commenced by a writ, and ought to be tried in the way in which actions usually are tried, and set down accordingly. The respondents to such a petition are entitled to an opportunity of calling *vivâ voce* evidence. (34 *Ch. D.* 396; *W. N.* 1888, 168.) The patent in question was for a new system of distributing electricity for the production of light and power. The system consisted of a combination of (1) an alternating current of high tension; (2) the passage of such current through a number of electrical generators of special construction; (3) the formation by such passage of induced currents, the quality and value of which depend only on the construction of the secondary cells of the generators; (4) the utilisation of these induced currents for the production of light or motive power. The Court of first instance *Held*, that there was not a fatal variance between the complete and provisional specification; but that the complete specification did not sufficiently describe the invention, and that the invention was not subject-matter for a patent. (5 *O. R.* 189.)—*Held*, by the Court of Appeal, that there was no anticipation, as no one had previously hit on a combination of (1) an electric dynamo-machine producing alternate currents of high tension; (2) a long main wire; (3) induction coils, specially constructed, placed along it at intervals, to produce light or motion where required; that the invention was new and useful, and that the specification was sufficient; but *Held*, that taking the construction of the amended specification, for which the patentees contended, viz. to include a combination of a dynamo giving alternate currents of high tension with any induction coils such as those described, the patent was hopelessly bad; (1) as being an entirely different invention from that described in the provisional specification; and (2) because the amendment had greatly extended the scope of the patent. (*W. N.* 1889, 60; 6 *O. R.* 215.)

## (k) DRUMMOND'S PATENT. [1889]

The patentee, being domiciled and resident in Scotland, a copy of a petition for revocation and of the particulars of objections had been served on him there; and he had written to the petitioner's solicitors, that he did not intend to appear, because he was not subject to the jurisdiction of the English Courts. North, J., made an order, that, unless the respondent should appear and object on or before a day named, the petition should be tried with *vivâ voce* evidence, and be set down in the witness actions. If the respondent appeared, it would be open to him to dispute the jurisdiction. (43 *Ch. D.* 80; *W. N.* 1889, 195; 6 *O. R.* 576.)

## (l) EDGE'S PATENT. [1890]

The petitioner, Edge, being the owner of two prior patents for a similar invention, had already brought an action in the Queen's Bench Division, alleging that the patent was applied for so that a third party might fraudulently use the name of Edge. This

petition for revocation was transferred to be tried with the action. (W. N. 1890, p. 149.)

**Revocation** of Order of Privy Council as to extension. See p. 134 (*k*).

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### **Sales,**

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**Scientific** principles are not the proper subject of a patent. See pp. 540–544.

### **Scire Facias.**

PATENTS ACT, 1883, sect. 26. (1.) The proceeding by *scire facias* to repeal a patent is hereby abolished. [See under Revocation.]

### **Scotland.**

PATENTS ACT, 1883, sect. 107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section “Court of Appeal” shall mean any Court to which such action is appealed.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

109. (1.) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at

the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

### Sea,

acts done at, p. 159 (*b*)

acts done on foreign ship in British waters, Patents Act, 1883, sect. 43, p. 145.

### NEWALL v. ELLIOTT. [1864]

A patent limited to the United Kingdom, the Channel Islands, and the Isle of Man, cannot be infringed by any act done on board an English vessel at Malta or on the high seas. (10 *Jur.*, N. S. 954.)

### Seal.

PATENTS ACT, 1883, sect. 84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

**Sealing of Patent**, not to prevent sealing of another patent on an earlier application. PATENTS ACT, 1883, s. 13, p. 80.

**Secret Process**, evidence of will be heard *in camerâ*,

### (I) BADISCHE ANILIN UND SODA FABRIK v. LEVINSTEIN. [1883]

Where in an action for infringement of a patented process the defendant alleges that he attains his result by a secret process, differing from that of the plaintiff, he will not be compelled to answer questions which would disclose that process, but he may, if necessary, describe it to the Court *in camerâ*. (24 *Ch. D.* 156.)

### Secretary of State.

PATENTS ACT, 1883, sect. 44. (1.) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration) assign to Her Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of Her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

(2.) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of Her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3.) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4.) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and

drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

(5.) Such packet shall until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6.) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7.) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the Secretary of State to receive it.

(8.) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

(9.) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10.) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11.) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12.) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorised by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

**Secret User**, does not invalidate patent. See Novelty, pp. 242, 243

**Servant**, invention by, pp. 46 (*h*), 407 (*m*).

(*m*) **BLOXAM v. ELSEE**. N. P. [1825]

If a servant, while in the employ of his master, makes an invention, that invention belongs to the servant, and not to the master. (1 *C. & P.* 558; *Ry. & Mo.* 187.)

**Simultaneous Discoveries**, person discovering invention contemporaneously with patentee may be liable for infringement, p. 157 (*y*).

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### *Statutory Provisions.*

PATENTS ACT, 1883, sect. 5. (1.) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

(3.) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required.

(4.) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

(5.) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.



PATENTS ACT, 1886, sect. 2. The requirement of sub-sect. 4 of sect. 5 of the Patents, Designs and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings but referred to those which accompanied the provisional specification.

PATENTS ACT, 1883, sect. 6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

PATENTS ACT, 1888, sect. 2. For sect. 7 of the principal Act the following section shall be substituted, namely:—7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification or drawings be amended before he proceeds with the application: and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

[For the remainder of the section, see p. 560.]

### *Provisional Specification.*

(n) *In re* NEWALL AND ELLIOTT. [1858]

A. was the inventor of "improvements in apparatus employed in laying down submarine electric telegraph wires." In the provisional specification the invention was thus described: "The cable or rope containing the insulated wire or wires is passed round a cone, so that the cable in being drawn off the coil is prevented from kinking by means of the cone, and there is a cylinder on the outside, which prevents the coil from shifting in its place." In the complete specification, after describing the invention in the same terms, the inventor proceeded to describe some rings which were placed so as to prevent the bight of the rope from flying out when going at a rapid speed, and at the end claimed, first, coiling the wire or cable round a cone; second, the supports placed cylindrically outside the coil round the cone; third, the use of rings in combination with the cone as described:—*Held*, that the validity of the patent was not affected by the omission of all mention of the metal rings in the provisional specification. Byles, J.: "The office of the provisional specification is only to describe generally and fairly the *nature* of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out; otherwise the provisional specification must be as full as the complete specification, and drawn with as much care and deliberation. Indeed, the statute itself indicates this distinction between the provisional and the

final specification; for, it calls the latter the *complete* specification, implying that the former is, or may legally be, in some respects executory and incomplete. Moreover, it enacts (s. 6) that the provisional specification is to describe the *nature* of the invention, and no more; but when the statute comes to speak of the complete specification, its language is altogether different." (4 *C. B.*, *N. S.* 269; 4 *Jur.*, *N. S.* 562; 27 *L. J.*, *C. P.* 337.)

(o) *MACKELCAN v. RENNIE.* [1862]

Action for the infringement of a patent for "improvements in floating docks." It was proved, during the trial at nisi prius, that the construction was not novel, floating docks having been previously constructed of *timber*. The plaintiff then alleged his invention to consist entirely in the use of *iron* in their construction, according to the mode pointed out in the specification. The provisional specification did, but the complete specification did not, mention iron as being used in the construction. Erle, C.J. (affirmed by the Court of Common Pleas), *held*, that the provisional specification could not be prayed in aid for the purpose of supplying a defect in the subsequent complete specification. (13 *C. B.*, *N. S.* 52.)

(p) *NEWALL v. ELLIOTT.* [1864]

Pollock, C.B.: "The object of the statute, which requires a provisional specification, is nothing more than a legislative recognition of the custom which called upon every patentee, when he applies for the patent, to give some notion of what his invention is. That has been followed by an Act of Parliament requiring it to be done; but the object in both cases is to ascertain the identity of the invention, and to make it certain that the patentee shall ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance . . . I have no doubt that the object of the Act of Parliament was not to ascertain the entirety of the invention, but the identity of the invention, so as to enable the Attorney-General, and, in fact, to enable a jury, ultimately to determine whether the invention fully specified was the same invention as that which was presented to the notice of the Attorney-General by the provisional specification." (10 *Jur.*, *N. S.* 955.)

(q) *FOXWELL v. BOSTOCK.* Ch. [1864]

The provisional and complete specifications of a patent ought not so to differ, as that the nature of the invention as described in the one, shall be materially different from the nature of the invention, as described in the other. (4 *De G.*, *J. & S.* 298; 12 *W. R.* 723; 10 *L. T. Rep.*, *N. S.* 144.)

(r) *PENN v. BIBBY* : *PENN v. JACK.* Ch. [1866]

Chelmsford, L.C., in the course of his judgment, said: "It seems clear from these sections (Patent Law Amendment Act, 1852,

sects. 6 and 8) that the office of the provisional specification is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the law officer what is to be the subject-matter of the patent. . . . The filing of the provisional specification, by the express provisions of the statute, protects the invention for six months, and gives the patentee, during this period, the like powers, rights, and privileges, as might have been conferred upon him by letters patent. The object of this protection evidently is, to enable the patentee to perfect his invention by experiments, which, although open and known, will not be a user and publication to the prejudice of letters patent to be afterwards granted, so that he may be in a condition to describe in his complete specification, as the result of his experience, the best manner of performing the invention. It clearly appears, therefore, that the complete specification is, in a sense, supplemental to the provisional specification, not going beyond, nor varying from it as to the nature of the invention, but conveying additional information, which may have been acquired during the currency of the provisional specification, as to the manner in which the invention is to be performed. From this description of the different offices of the two specifications, it follows that upon an issue 'whether the specification, enrolled in pursuance of the letters patent, describes and ascertains the nature of the invention,' if the claim in the complete specification is comprehended within the terms of the provisional specification, that issue will be satisfied. The relation which the provisional specification bears to the complete specification is much the same as that which, before the Patent Law Amendment Act, the title bore to the specification. The observations of Tindal, C.J., in *Cook v. Pearce*, are as applicable to the provisional specification now, as they were to the title formerly." (*L. R.*, 2 *Ch.* 132.) "Nor is it at all necessary that the complete specification should extend to everything comprehended within the provisional specification. Perhaps a better illustration of this proposition could not be given than that which was offered in the course of the argument. If the patentee were to introduce into his complete specification everything which was warranted by the terms of the provisional specification, and afterwards found that a part of that which he had claimed would invalidate his patent for want of novelty, or for any other reason, he might afterwards cure the objection by a disclaimer. Now, if he would be allowed to disclaim in such a case, which is matter of indulgence, he must have a right to waive his claim to any portion of the grant which the allowance of the provisional specification had entitled him to demand." (*Ib.* 134.)

(s) *THOMAS v. WELCH.* [1866]

Any part of the provisional specification of a patent may be omitted in the complete specification, if there is no fraud, and the effect of the remainder is not altered by the omission. (*L. R.*, 1 *C. P.* 192; 12 *Jur.*, *N. S.* 316; 35 *L. J.*, *C. P.* 200.)

(t) *STONER v. TODD*. M. R. [1876]

Jessel, M.R.: "A provisional specification was never intended to be more than a mode of protecting an inventor until the time for filing the final specification. It was not intended to contain a complete description of the thing so as to enable any workman of ordinary skill to make it, but only to disclose the invention, fairly, no doubt, but in its rough state, until the inventor could perfect its details. Again, the provisional specification, as such, is not and cannot be known to the public; it is never published unless with the final specification, when they become parts of the same document, except in cases where the time has passed within which the final specification must be filed or treated as abandoned. That being so, we do not find, as a rule, that complete description in a provisional specification which is required to enable a workman of ordinary skill to carry out the invention." (4 *Ch. D.* 59.)

(u) *LUCAS v. MILLER*. [1885]

It is not the function of a provisional specification to claim anything. (*Griff* 156; 2 *O. R.* 155.)

(v) *LISTER v. NORTON*. [1886]

A provisional specification was the creation of the Act of 1852, which enacts, in sect. 8, that the invention therein referred to may, during six months from the date of application, be used and published without prejudice to any letters patent "to be granted for the same." The phrase, "to be granted for the same," means, in this section, and in the 9th section, for the same invention, and does not refer to the application or petition, and accordingly when a second provisional specification is filed during the six months, there is no express condition in the Act avoiding the protection conferred in respect of the first, and the decision in *Oxley v. Holden* does not allow the Court to say that there is an implied condition. (*Griff* 148; 3 *O. R.* 199.)

(w) *WOODWARD v. SANSUM*. C. A. [1887]

A patentee putting in a provisional specification, showing the nature of his invention is not bound to describe the way in which that can be carried out. (4 *O. R.* 166.)

(x) *SIDDELL v. VICKERS*. [1888]

The remarks made in *Woodward v. Sansum* (see p. 420 (h)) as to provisional specification cited and approved. (39 *Ch. D.* 92.)

#### *Variance between Provisional and Complete Specifications.*

(y) *PENN v. BIBBY*: *PENN v. JACK*. [1866]

The provisional specification of a patent for an improvement in the bearings and bushes for the shafts of screw and submerged propellers, described the invention as consisting in employing wood in the construction of such bearings and bushes. The complete specification, after describing the mode in which the

wood was used, claimed the employment of wood in the construction of the bearings and bushes "as therein described":—*Held*, that this was no such variation between the provisional and complete specification, as would invalidate the patent. (*L. R.* 2 *Ch.* 127; 36 *L. J.*, *Ch.* 455; 15 *L. T. Rep. N. S.* 399; 15 *W. R.* 208.)

(z) THOMAS v. WELCH. [1866]

The provisional specification of a patent for sewing machines, claimed, amongst other improvements, that a certain instrument which moved the work, "or another acting therewith," acted to hold the work during the insertion of the needle, while the complete specification appeared to describe only one instrument as moving and holding the work:—*Held*, that such a variance would not invalidate the patent. (*L. R.*, 1 *C. P.* 192; 12 *Jur.*, *N. S.* 316; 35 *L. J.*, *C. P.* 200.)

(a) WRIGHT v. HITCHCOCK [1870]

The title of the patent being for improvements in the manufacture of frills or ruffles, and the provisional specification describing the invention as relating to a particular manufacture of frills and ruffles, the complete specification described the invention as relating to a particular manufacture of frills, ruffles, or trimmings:—*Held*, that this was no such material variation, as to render the patent invalid. (*L. R.*, 5 *Exch.* 37; 39 *L. J.*, *Exch.* 97.) Kelly, C.B., said: "A third point made is that there is an inconsistency between the provisional and the final specification, the word 'trimming' being added in the latter. But by whatever name it is described, the thing is in itself identical; it is something attached to any part of the dress, either of men or women, whether it is called the frill of a sleeve, or the ruffle of a shirt, or the trimming of a lady's dress. These are all *ejusdem generis*, and the description is only important for the purpose of showing for what purpose the product may be ultimately used when it has been manufactured by means of the plaintiff's invention" (*L. Rep.*, 5 *Ex.* 46.)

.. (b) BAILEY v. ROBERTON. H. L. [1878]

The provisional specification of a patent stated the object of the invention to be the preserving of animal substances in a fresh state; and the patentees therein claimed the use of a solution composed of a certain quantity of gelatine mixed with bisulphite of lime, but in the complete specification they claimed as "solution No. 1" a solution composed of bisulphite of lime alone. In an action for infringement for the use of bisulphite of lime, pure and simple:—*Held*, that the complete specification, if large enough to cover the employment of bisulphite of lime for the preservation of animal substances as practised by the defenders, would claim an invention larger than and different from that disclosed in the provisional specification, and that, therefore, the patent was not valid and effectual to secure to the patentees the

invention used by the defenders, though it might be valid to secure to them the invention described in the provisional specification. (3 *App. Cas.* 1055.)

Lord Blackburn : " When you consider the history of patents in England, there is not very much difficulty in construing the statute of 1852, upon which it all turns, so far as regards this particular case. This is a Scotch case, but I think that the Scotch patent law has entirely adopted and incorporated the English. The patent law, dating from the time of James, gave a monopoly to the invention of the first inventor, it therefore gave a monopoly solely to that invention which was his invention; he could not claim an invention greater than the title of the patent, but the titles were of extreme generality. It is in this particular instance 'for improvements in preserving animal substances.' Almost any kind of thing would come under that description; the mere title gave very little instruction. Then in the time of Queen Anne, the attorney-general of the day invented what was obviously a very great improvement. He made it a condition that the patentee should, within six months, particularly 'describe and ascertain' the invention and the manner in which it was to be performed; if not, it should be void. If that was done at the end of six months, that specification fixed what was the invention for which the patent was granted. Then during the six months it would have been, and before specifications were invented it must have been, a question of evidence as to what was the invention for which he went to the Crown, and for which the Crown granted a monopoly, and the traverse of that would be the proof. Then came the statute of 1852, which introduced a further amendment. It enacted that when persons went to apply for letters patent they should deposit a provisional specification. That provisional specification describes the invention in terms very different indeed from those in which the final specification described it. In this case, instead of saying 'it shall particularly describe and ascertain the nature of the invention and in what manner the same shall be performed,' all that the statute says is that in the provisional specification which the applicant leaves with the law officer of the Crown when he applies for a patent, he shall state the nature of the invention—no more than that; and then, when the law officer of the Crown, to whom it is referred, has looked at it, and finds it does state the nature of the invention, but thinks the nature of the invention as stated is large or too vague, he may require him to amend it; but if not, then he grants his certificate to use the patent publicly, without at all thereby making a present of the discovery to the public; and when it came to be a question whether or no what he was doing during that six months did avoid the patent, I take it the process must have been to say, 'look at the nature of the invention described in the provisional specification, and say whether this which you have been doing, and which you say was a part of the patent, is fairly within the nature of the invention you have described, in that case you are protected; but if it is a new and separate invention, and a different

one, then you are not protected.' I cannot but think that when that is once looked at, it becomes pretty clear that when the nature of an invention has been described in the provisional specification in the way which has been mentioned, if something were found out during the six months to make the invention work better, or with respect to the mode in which the operation may be performed—a thing which is very likely to happen when, in carrying out his invention, the inventor finds that some particular bit will not work so smoothly as he expected, and it is necessary to add a little supplement to it—still the nature of his invention remains the same, and it is no objection that in the complete specification, which comes afterwards, the invention or application is described more particularly and in more detail, or even if it be shown that there has been more discovery made, and so as to make the invention which he has described in the provisional specification really workable. If nothing more is done than that, I think it is good; but as soon as it comes to be more than that, and the patentee says, in the provisional specification, I describe my invention as A, and in the complete specification he says I hereby describe A and also B, then, as far as regards B, it is void, because the letters patent were granted for the invention that was described in the provisional specification, and do not cover the invention that is described in the other." (*Ib.* 1073.) (See *Horrocks v. Stubbs*, *post*, p. 418 (*f*).)

(c) UNITED TELEPHONE COMPANY *v.* HARRISON, COX, WALKER AND COMPANY. [1882]

In the complete specification filed on January 30th, 1878, as modified by disclaimers: Edison claimed: "(3) the method herein specified of recording the undulations of the diaphragm or yielding material, and the reproduction of sound by such material acting upon a diaphragm to communicate to the same vibrations similar to the original ones, substantially as set forth." This recording instrument, which became known as the phonograph, was fully described in the complete specification. The title of the provisional specification was "controlling by sound the transmission of electric currents and the reproduction of corresponding sounds at a distance." After pointing out that the friction of a point or surface in contact with a properly prepared and slowly moving surface is very much increased or lessened by the strength of the electric wave passing at the point of contact, and that from this variation in the friction "a greater or less vibration is given to the mechanism or means that produce or develop the sound at the receiving station, thereby rendering clear and distinct the sound received that otherwise would not be audible," the provisional specification proceeded: "To carry out the peculiarities of my invention under the varying conditions of use, I have devised several modifications of the transmitting, receiving, and intensifying devices employed in this sound telegraph; portions of the apparatus are interchangeably available in transmitting or recording, others are adapted to local use; some are

only available in transmitting, and others only for receiving; and some portions of my improvement can be availed of to make a record of the atmospheric sound waves, or of the electric waves or pulsations corresponding thereto or resulting therefrom." *Held*, by Fry, J., that although some of these words might be held to refer to an instrument like the phonograph, yet that as the invention in the provisional specification was confined to the transmission of sounds by electrical agency to a distance, and could not honestly be intended to include the phonograph if known at the time, there was a fatal variance, and the patent was bad. (21 *Ch. D.* 720, at p. 746.)

(d) *LUCAS v. MILLER.* [1885]

The patentee of an invention for an improved bicycle lamp, described in the provisional specification the mode of opening the lamp and barrel, and afterwards thought it would be an improvement to have a rim within the barrel. *Held*, by Kay, J., that this was not an invention so completely apart from the invention described in the provisional specification as to make the patent bad because it was a part of the claim in the complete specification. (*Griff.* 156; 2 *O. R.* 155.)

(e) *WATLING v. STEVENS.* C. A. [1886]

Esher, M.R.: "If the complete specification sets out and claims an invention independent of that which is in the provisional specification, besides also describing that invention which is in the provisional specification, then the complete specification is bad. It would be equally bad if the invention described in the complete specification were a wholly different invention from that described in the provisional specification, because as has been said the patent then is not given for the invention which is described in the provisional specification. Therefore, if there were only one invention described in the provisional application, and only one in the complete specification, but those two inventions were wholly and substantially different, the patent would be bad. So if an invention is described in the provisional specification, which invention is also described in the complete specification, but in the complete specification another and distinct invention is described and claimed, then it is bad, because with regard to the second invention so described and claimed in the complete specification, there would be no provisional specification to cover it." (*Griff.* 240; 3 *O. R.* 147 at p. 151.)

(f) *HORROCKS v. STUBBS.* [1886]

The claim in the provisional specification was for improvements in machinery for doubling, twisting, and winding threads, and the prime object of the whole invention was the arresting of the whole machine by detector mechanism. In the complete specification claim 8 claimed "the arranging of the oscillating frame so that it can be sustained when lifted by a prop, which is withdrawn when



the lever is lifted to start the winding." This prop was not mentioned in the provisional specification:—*Held*, that as it had to do with piecing the thread and not with arresting the whole machine, and was applicable to a particular isolated portion of the machine, it was not a part of nor fairly developed from or foreshadowed by the provisional specification, and that, therefore, there was a fatal variance. In the course of his judgment Bristowe, V.-C., referred to the following words of Blackburn, L., in *Bailey v. Robertson* (*sup.* p. 417): "As soon as it comes to be more than that, and the patentee says in the provisional specification, I describe my invention as A, and in the complete specification he says, I hereby describe A and also B, then as far as regards B it is void, because the letters patent were granted for the invention that was described in the provisional specification, and do not cover the invention that is described in the other;" and proceeded, "I have always considered that his Lordship must have meant by that, then having regard to B, the patent is void, not as regards but having regard to B. I think that is the true view when you compare the judgment of Lord Cairns with that of Lord Blackburn." (3 O. R. 221, at p. 232.)

(g) *MOSELEY v. THE VICTORIA RUBBER COMPANY.* [1887]

In an action for infringement of a patent for improvements in producing designs on waterproof fabrics, it appeared that the provisional specification spoke of vulcanisation by "the well-known cold vulcanising process." At the date of the provisional specification the best known cold vulcanising process was the cold roller process, but the plaintiff in the complete specification referred to a different process called the cold vapour process:—*Held*, on the facts that the cold vapour process was known and in use at the earlier date; that the term "well-known cold vulcanising process" was sufficient to include the cold vapour process; that even if the provisional specification did not mention the cold vapour process the omission was not sufficient to invalidate the patent, and that if the patentee made the discovery in the interval, he was bound to mention the cold vapour process in the final specification. (4 O. R. 241.)

The provisional specification also mentioned the use of colours as follows: "If the design is to be produced before vulcanisation, I imprint it in colours upon the surface of the farina-coated fabric by suitable means, such for example as those employed in colour printing." The complete specification stated that colours might be used for printing the design, and that they should be mixed with or dissolved in suitable media, which would combine with, temporarily soften or otherwise act upon the surface of the india-rubber so as to cause the colour to adhere thereto or combine therewith, and then named several suitable media:—*Held*, that the omission to mention the suitable media in the provisional specification was no ground for upsetting the patent. (*Ib.* 249.)

*(h) WOODWARD v. SANSUM. C. A. [1887]*

A patentee in his provisional specification described a mode of carrying his invention into effect which was different from that which he stated in the complete specification:—*Held*, that as both modes were really within the same invention, which was described in general terms in the provisional specification, the patent was not bad. A patentee putting in a provisional specification need not describe any way in which it can be carried out, and if he does describe a way, and before filing the complete specification he finds out an improved way of carrying out what is described as his invention in the provisional specification, then he not only may but must give the public the benefit of what he has discovered as regards the mode of carrying the invention into effect, even although there may be improvement and even invention which were not known to him at the time of the provisional specification. (4 O. R. 166.)

*(h\*) HUTCHISON v. PATTULLO. [1888]*

Where the provisional specification contemplated a particular process for the treating of oils and fats, but the complete specification did not treat the process as an essential part of the invention at all, and claimed (1) the process, (2) the combined thickened vegetable or animal oils or fats with mineral oils:—*Held*, that there was a fatal variance. (5 O. R. 351.)

*(i) SIDDELL v. VICKERS. C. A. and H. L. [1888]*

The remarks made by Cotton, L.J., in *Woodward v. Sansum*, as to variance between provisional and complete specification in the mode of carrying out, cited and approved. (39 Ch. D. 92.)

Where it is alleged that one of three processes, claimed in the complete specification, is not covered by the provisional, the provisional specification must be construed with reference to the complete. (5 O. R. 81.) The new machinery of the comptroller and examiner has not superseded the necessity of conformity between the provisional and complete specifications. (7 O. R. 292.)

*(i\*) CRAMPTON v. PATENTS INVESTMENT COMPANY. C. A. [1889]*

Where the variance alleged amounted to nothing more than possibly some additional discovery of the same nature as that indicated in the provisional specification:—*Held*, that it was not fatal. (6 O. R. 287.)

*(j) KING, BROWN AND COMPANY v. ANGLO-AMERICAN BRUSH CORPORATION. [1889]*

In a patent for improvements in apparatus for generating electricity, the Court found that all that was foreshadowed in the provisional specification (in so far as it related to the commutator which was a most important part) was included in the second claim in the complete specification, and that as the fourth claim, which also related to the commutator could not be regarded as mere repetition, there was a material variance between the specifications. (6 O. R. 414.)

(k) *In re GAULARD AND GIBBS' PATENT.* C. A. [1889]

The complete specification had been amended by striking out an erroneous statement which remained in the provisional specification:—*Held*, that the patentees by their amended specification so altered their claim that the invention was not the same as that described in the provisional specification, and was greatly extended in scope, and that the patent was therefore bad. (*W. N.* 1889, 60; 6 *O. R.* 215.)

(k\*) *ANDERSEN AND ANDERSEN'S APPLICATION.* [1890]

*Held*, by the law officer, that there was no disconformity between the applicants' specifications proved sufficiently for him to act upon. (7 *O. R.* 323.)

*Must be Sufficient and Intelligible without Experiments.*

(l) *REG. v ARKWRIGHT.* *Sci. fac.* [1785]

Buller, J.: "It has been truly said by the counsel, that if the specification be such that mechanical men of common understanding can comprehend it, to make a machine by it, it is sufficient; but then it must be such that the mechanics may be able to make the machine by following the directions of the specification without any new inventions or additions of their own." (1 *Web. P. C.* 66; *Dav. P. C.* 106.) "It does not prove that a specification is sufficient because a man from the knowledge he has got from three trials, and seeing people immediately employed about it, is able to make use of it." (*Ib.* 67.)

(m) *ARKWRIGHT v. NIGHTINGALE.* N. P. [1785]

Lord Loughborough: "One of the requirements (of the patent law) is, that a specification shall be enrolled, stating the nature of the invention; the object of which is, that after the term is expired the public shall have the benefit of the invention, but without that condition is complied with, the patentee forfeits all the benefit he derives from the great seal." (*Dav. P. C.* 55; 1 *Web. P. C.* 61.) The clearness of the specification must be according to the subject-matter; it is addressed to persons in the profession having skill in the subject, and if it is understood by them it is intelligible. (*Dav. P. C.* 37; 1 *Web. P. C.* 60.)

(n) *BOULTON v. BULL.* [1795]

Action for the infringement of a patent for lessening the consumption of steam and fuel in fire-engines. The defendants contended (*inter alia*) that the patentee had not sufficiently specified his invention. Eyre, C.J., in the course of his judgment, said: "The substance of the invention is a discovery, that the condensing the steam out of the cylinder, and protecting the cylinder from the external air, and keeping it hot to the degree of steam heat, will lessen the consumption of steam. . . . Now, the specification of such a discovery seems to consist in nothing more than saying to the constructor of a fire-engine, 'for the future condense your steam out of the body of the cylinder, instead of condensing it within it, put something round the cylinder to

protect it from the external air, and to preserve the heat within it, and keep your piston air-tight without water.' Any particular manner of doing this, one should think, would hardly need be pointed out, for it can scarcely be supposed that a workman capable of constructing a fire-engine would not be capable of making such additions to it as should be necessary to enable him to execute that which the specification requires him to do." (2 *H. Bl.* 497.) "Suppose a new invented chemical process, and the specification should direct that some particular chemical substance should be poured upon gold in a state of fusion, . . . it would be hardly necessary to state in the specification the manner in which, or the utensils with which, the operation of putting gold into a state of fusion was to be performed. These are mere incidents with which every man acquainted with the subject is familiar." (*Ib.* 498.)

(o) *HORNBLOWER v. BOULTON*. [1799]

Grose, J., said: "By a proviso in the patent, the patentee is bound particularly to describe and ascertain the nature of his invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and to cause the same to be enrolled in chancery. On which another question arises, namely, whether the specification enrolled be sufficient. The aim of the legislature is obvious; on the one hand, it was to encourage ingenious artificers and able and studious men to invent and bring forward, for the use of the public, new manufactures, the produce of their own ingenuity, by holding out to them the reward of fourteen years' monopoly; on the other hand, to secure to the public the benefit of the discovery, by causing to be enrolled a complete description of the thing to be done, and the manner of doing it, that others might be fully informed of it; and, at the end of fourteen years, to be enabled to work or make the manufacture of which the patentee was the inventor." (8 *T. R.* 100; *Dav. P. C.* 227.) If the specification be such as to enable artists to adopt the invention and make the manufacture, it is sufficient. (*Dav. P. C.* 228.) Lord Kenyon, C.J.: "No technical words are necessary to explain the subject of a patent." (*Ib.* 224.)

(p) *CARTWRIGHT v. EAMER*. [1800]

Per Lord Eldon: "The patent is to be considered as a bargain with the public, and the specification, therefore, is to be construed on the same principle of good faith, as that which regulates all other contracts. If, therefore, the disclosure be such that the invention can be communicated to the public the statute is satisfied" (cited 14 *Ves.* 131, 136). (1 *Good P. C.* 112.)

(q) *HARMAR v. PLAYNE*. [1809]

Ellenborough, C.J., in the course of the argument, said: "When Lord Mansfield said, in the case of *Liardet v. Johnson*, that the meaning of the specification was, that others might be taught to do the thing for which the patent was granted, it must be understood to enable persons of reasonably competent skill in such

matters to make it: for no sort of specification would probably enable a ploughman, utterly ignorant of the whole art, to make a watch." (*Dav. P. C.* 318.) And again: "The object of requiring a specification to be enrolled seems to be to enable persons of reasonable intelligent skill in the subject-matter to tell from the inspection of the specification itself what the invention was for which the patent was granted, and how it was to be executed." (*Ib.* 316.)

(r) *MANTON v. MANTON.* [1815]

Gibbs, C.J.: It is necessary that the patentee "should show that he has accurately explained the nature of his invention in his specification, separating that which is new from that which is old, so as to enable a person of *tolerable* skill to make the thing by means of his specification." (*Dav. P. C.* 349.)

(s) *HILL v. THOMPSON.* [1817]

The intelligibility of the description in the specification is a matter of fact for the jury, but whether or not the patent is defective in attempting to cover too much is a question of law. (3 *Mer.* 626; 1 *W. P. C.* 235; 1 *Carp. P. C.* 377.)

(t) *NEWBERY v. JAMES.* Ch. [1817]

Eldon, L.C.: "In order to support a patent, the specification should be so clear, as to enable all the world to use the invention as soon as the term for which it had been granted was at an end." (2 *Mer.* 451; 1 *Carp. P. C.* 368.)

(u) *R. v. WHEELER.* *Sci. fac.* [1819]

Patent for "a new or improved method of drying and preparing malt." In the specification it was stated, that the invention consisted in exposing malt previously made to a very high degree of heat: but it did not describe any new machine invented for that purpose; nor the state, whether moist or dry, in which the malt was originally to be taken for the purpose of being subjected to the process; nor the utmost degree of heat which might be safely used; nor the length of time to be employed; nor the exact criterion by which it might be known when the process was accomplished. *Held*, that the specification was not sufficiently precise. (2 *B. & Ald.* 345; 1 *Carp. P. C.* 394.)

Abbott, C.J., in delivering the judgment of the Court, said: "It was argued that the term 'malt' is applied to the grain as soon as it has germinated by the effect of moisture, and before it has been dried; that malt in that state might be taken and used for the objects of the defendant's invention; and, as these were to be accomplished by heat, his was an invention for drying malt. But, if this were so, then the specification would be defective in not informing the reader that the malt to be used for the intended object might or ought to be taken in that state, and in leaving him to discover, by experiment, whether it should be taken in that state, or after drying, which, according to the most common use of the

word malt, he might very reasonably suppose." (2 *B. & Ald.* 353.) A specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad. (*Ib.* 354.)

(v) *BRUNTON v. HAWKES.* [1821]

Best, J.: "The specification must embrace two objects; it must first clearly describe the nature of the invention; and secondly, the manner in which it is to be performed." (4 *B. & Ald.* 556.)

(w) *STURTZ v. DE LA RUE.* Ch. [1828]

The specification must describe the invention in such a way that a person of *ordinary* skill in the trade shall be able to carry on the process. (5 *Russ.* 327.)

(x) *CROSSLEY v. BEVERLEY.* N. P. [1829]

It appeared from the evidence that the specification did not give any directions respecting a condenser, which was well known to be an essential part of every gas apparatus. It was objected for the defendant that the things comprised in the specification would not make a gas apparatus, because it would be incomplete for want of a condenser. Tenterden, C.J., however, held, that a workman who was capable of making a gas apparatus would know that he must put that in, and that although the specification did not direct a condenser to be put in, yet, as it did not say that it was to be left out, it was sufficient. (3 *C. & P.* 513; *Mo. & Mal.* 283; 1 *Web. P. C.* 106.)

(y) *FELTON v. GREAVES.* N. P. [1829]

A patent was granted for a machine to sharpen knives and scissors, and, in the specification, this was directed to be done by passing their edges backward and forward, in an angle formed by the intersection of two circular files; and in the specification it was also stated, that other materials might be used according to the delicacy of the edge. It was proved that, for scissors, there ought to be one circular file and a smooth surface, but that two Turkey stones might also succeed. *Held*, that the specification was bad, as it neither directed the machines for scissors to be made with Turkey stones, nor to be made with one circular file and a smooth surface. (3 *C. & P.* 611.)

(z) *DEROSNE v. FAIRIE.* [1835]

Patent for certain improvements in extracting sugar or syrup from cane-juice and other substances containing sugar, and in refining sugar and syrup. In the specification the patentee said: "The invention consists in a means of discolouring syrups of every description by means of charcoal, produced by the distillation of bituminous schistus alone, or mixed with animal charcoal, and even of animal charcoal alone." The specification then stated that the "discoloration" was to be produced by means of a filter of the charcoal, and continued: "The carbonization of bituminous

schistus has nothing particular; it is produced in closed vessels, as is done for producing animal charcoal, only it is convenient before the carbonization to separate from the bituminous schistus the sulphurets of iron which are mixed with it." The specification said nothing as to any previous operation on the syrup before it was submitted to the filter, but it did state that syrup in a proper state might be obtained by a mixture of sugar and water. The defendant objected to the sufficiency of the specification. *Held*, first, upon proof that the invention was applicable with advantage to the syrup, after it had undergone a certain degree of heat, though it failed when applied to the first drawings of the syrup, that the specification was sufficient. Secondly, that it was incumbent on the patentee to prove, that the presence of iron in the bituminous schistus, used in the process of filtering, would not be injurious; or else, that the method of extracting the iron from it was so simple and well known, that a person ordinarily acquainted with the subject could remove it with ease; or, that the bituminous schistus, as known in England, could be used in the process with advantage. (5 *Tyr.* 393; 2 *Cr. M. & R.* 476; 1 *Gale*, 109; 1 *Web. P. C.* 158.)

(a) *CORNISH v. KEENE.* N. P. [1835]

In the absence of evidence on the part of the defendants that persons could not understand, or have been misled by the specification, it is sufficient for the plaintiff to call persons who say that to them it is clear. (1 *Web. P. C.* 502.)

(b) *MORGAN v. SEAWARD.* N. P. [1836]

Alderson, B., in addressing the jury, said: "It is the duty of a party who takes out a patent to specify what his invention really is, and although it is the bounden duty of a jury to protect him in the fair exercise of his patent right, it is of great importance to the public, and by law it is absolutely necessary, that the patentee should state in his specification, not only the nature of his invention, but how the invention may be carried into effect. Unless he be required to do that, monopolies would be given for fourteen years to persons who would not on their part do what in justice and in law they ought to do, state fairly to the public what their invention is, in order that other persons may know what is the prohibited ground, and in order that the public may be made acquainted with the means by which the invention is to be carried into effect. . . . He (the patentee) has described two inventions, and if either of those inventions is insufficiently specified, the patent fails, for if a person runs the hazard of putting two inventions into one patent, he cannot hold his patent, unless each can be supported as a separate patent. (1 *Web. P. C.* 173.). . . The public, on the one hand, have a right to expect and require that the specification shall be fair, honest, open and sufficient; and on the other hand, the patentee should not be tripped up by captious objections which do not go to the merits of the specification."

(*Ib.* 174.). . . The defendant put in evidence a model made according to the specification which would not work on account of one part being a little too small. Alderson, B., said: "A workman of ordinary skill when told to put two things together so as to move, would of course by the ordinary knowledge and skill he possesses make them of sufficient size to move. . . . That is within the ordinary knowledge of every workman." (*Ib.* 176.)

(c) GALLOWAY v. BLEADEN. N. P. [1839]

Tindal, C.J.: The specification must contain "such a fair and clear statement, that a person with a competent degree of knowledge upon the subject-matter to which the patent relates, would be able to make that which the plaintiff enjoys the exclusive privilege of." (1 *Web. P. C.* 524.)

(d) ELLIOTT v. ASTON. N. P. [1840]

Coltman, J., said: "The patentee must give such a description in his specification as would enable a workman of competent skill, conversant with the trade, to carry the invention into effect." (1 *Web. P. C.* 224.)

(e) BICKFORD v. SKEWES. [1841]

The specification is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufactures to which it relates. (1 *Q. B.* 938; 1 *Web. P. C.* 214; 10 *L. J.*, *Q. B.* 302.) The sufficiency of the specification is a question for the jury. (1 *Q. B.* 938; 1 *G. & D.* 736.)

(f) NEILSON v. HARFORD. [1841]

A specification is sufficient, if without invention or addition it enables a person of *ordinary skill and knowledge* of the subject, to construct the patented machine, and such machine is to some extent an improvement.

Parke, B., said to the jury: "You are not to ask yourselves the question, whether persons of great skill, a first-rate engineer, or a second-class engineer, as described by Mr. Farey—whether they would do it; because generally those persons are men of great science and philosophical knowledge, and they would upon a mere hint in the specification probably invent a machine which should answer the purpose extremely well; but that is not the description of persons to whom this specification may be supposed to be addressed; it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge and the ordinary degree of capacity to the subject." (1 *Web. P. C.* 314.) "If experiments are necessary in order to construct a machine to produce some beneficial effect, no doubt this specification is defective. If experiments are only necessary in order to produce the greatest beneficial effect, in that case I think the patent is not void." Abinger, C.B., said: "Where the specification uses scientific



terms, which are not understood except by persons acquainted with the nature of the business, the specification is not bad because an ordinary man does not understand it, provided a scientific man does; but where the specification does not make use of technical terms, where it uses common language, and where it states that by which a common man may be misled, though a scientific man would not—when it does not profess to use scientific terms, and an ordinary man reading the specification is misled by it—it would not be good.” (*Ib.* 341.) The construction of the specification is to be given by the Court, but the intelligibility of it is for the jury. (*Ib.* 295.)

(g) NEILSON *v.* THOMPSON. [1841]

Cottenham, L.C.: “The public are entitled to know for what it is that the patentee claims the invention, that they may be saved inconvenience upon the subject; therefore, the specification must tell the public for what it is that he claims protection.” (1 *Web. P. C.* 283.)

(h) WALTON *v.* POTTER. N. P. [1841]

The specification is the price paid by the inventor for the patent he obtains. (1 *Web. P. C.* 595.)

(h\*) GIBSON *v.* BRAND. N. P. [1841]

The specification ought to be so clearly worded as to enable any person of sufficient understanding on the particular subject to attain the result without doubt or difficulty, it being the price paid by the inventor for keeping the public out of the enjoyment of the manufacture. (1 *Web. P. C.* 629.)

(i) THE HOUSEHILL COMPANY *v.* NEILSON. N. P. [1842]

It is not necessary that the apparatus, described in the specification, should be productive of the greatest amount of benefit; it is sufficient if an ordinary workman, acquainted with the subject, could, by following the specification, construct an apparatus productive of some benefit. Lord Justice Clerk Hope, in addressing the jury, said: “The specification is to be read as addressed to artists, or persons of competent skill in the branch of manufacture or process to which it is applicable. Hence, known machinery need not be described, when the use of them is to be made in carrying out the object of the patent.” (1 *Web. P. C.* 676.) “Workmen of ordinary skill, means those competent in the ordinary business and conducting of the particular trade—to furnish and construct apparatus for the purpose required. Certainly, the pursuer does not satisfy the condition of law, if he says men of the greatest science—first-rate engineers—could understand him, and would know what to do, or what direction to give. That is not enough. The specification must be for the benefit of the trade when the patent is out.” (*Ib.* 692.)

## (j) WALTON v. BATEMAN. N. P. [1842]

It is a question for the jury whether the description of the invention and of the manner of carrying it out is such as will enable a workman of competent skill in that line of business to act upon it. (1 *Web. P. C.* 621.)

## (k) MACNAMARA v. HULSE. N. P. [1842]

Action for the infringement of a patent for "certain improvements in paving, pitching, or covering streets, roads, and other ways." The patentee, in his specification, said: "My invention consists in an improved mode of cutting or forming stone, or *other suitable material*, for paving or covering roads," &c. The specification directed the blocks, to be used for paving, to be bevelled both inwards and outwards, but said nothing as to the precise angle at which the bevels were to be made. The infringement complained of was the manufacture of *wooden* blocks according to the improvement of the plaintiff. Abinger, C.B., said: "If the specification leaves it to experiment to determine what is the proper angle, it is not good; but if any angle is a benefit, it will do." After verdict, his Lordship said: "I may now say that my opinion was against the plaintiff as to the angle not being stated, and that the specification in that respect was insufficient." (1 *Car. & Marsh.* 477; 2 *Web. P. C.* 129.)

## (l) MUNTZ v. FOSTER. N. P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships or other such vessels." The patentee, in his specification, directed copper and zinc to be melted together "in the usual manner, in proportions between 50 per cent. of copper to 50 per cent. of zinc, and 63 per cent. of copper to 37 per cent. of zinc, both of which extreme and all intermediate proportions will roll to a red heat." *Held*, that if it was left so uncertain, upon the face of the specification, whether the quantities were to be taken with reference to the measured quantities that are cast into the fusing-pot, or whether they specify that which will be the result when taken out, as to create in the mind of a workman any degree of doubt, it would be fatal to the specification. (2 *Web. P. C.* 109.)

## (m) BEARD v. EGERTON. [1849]

A specification is sufficient if it is free from any such mistake or obscurity as would mislead a person of fair intelligence. Maule, J., during the argument, said: "A specification is not to compel a person, who is determined to misunderstand, to learn, but to direct one who is willing to understand." (19 *L. J., C. P.* 36; 8 *C. B.* 165; 13 *Jur.* 1004.) The judge is to state what the specification orders to be done, the jury are to say whether it would produce the result. (19 *L. J., C. P.* 38.)

## (n) HEATH v. UNWIN. Ex. Ch. [1852]

Alderson, B., said: "Every specification is to be read as if by

persons acquainted with the general facts of the mechanical or chemical sciences involved in such invention. Thus, if a particular mechanical process is specified, and there are for some parts of it as specified other well-known mechanical equivalents, the specification of those parts is in truth a specification of the well-known equivalent also to those to whose general knowledge we refer, namely, mechanics, and readers of specifications; and so it is with chemical equivalents also in a specification which is to be read by chemists. But it may be that there are equivalents, mechanical and chemical, existing, but previously unknown to ordinary skilful mechanics and chemists. These are not included in the specification, but must be expressly stated there." (2 *Web. P. C.* 245.)

(o) *WALLINGTON v. DALE.* [1852]

The sufficiency of the description of an invention, contained in a specification, is a question for the jury. (7 *Ex.* 888.)

(p) *HOLMES v. LONDON & NORTH WESTERN RAILWAY COMPANY.* [1852]

Jervis, C.J., said: "The object of the condition in the patent requiring a specification is twofold; first, that useful novelties should be given to the public, of which, at the end of the term granted to the patentee, they should have the full benefit; and, secondly, that no person should inadvertently infringe the rights of the patentee during the term for which the patent has been granted." (*Macr. P. C.* 16.)

(q) *CROSSLEY v. POTTER.* N. P. [1853]

Pollock, C.B., said: "This patent is taken out for the making of coach lace, carpets, velvets, and velveteens of all sorts, and it must be competent to do all and every part of that work, by the means stated in the specification, otherwise the patent is not good . . . a patent, the object of which is, not to benefit the world by its communication, but to obstruct, by the very general character of the claims made for conferring peculiar privileges on the patentee; such a patent as that, in my judgment, cannot be supported." (*Macr. P. C.* 245.)

(r) *HILLS v. LONDON GAS LIGHT COMPANY.* [1860]

Pollock, C.B.: "The condition that a patentee shall specify is introduced into letters patent in order to prevent patents being granted for known things, and to secure the public the benefit of new inventions." (5 *H. & N.* 340.)

(s) *MORTON v. MIDDLETON.* [1863]

Lord President: "In judging of the sufficiency of a specification, it is necessary to see whether the patentee sets forth clearly the nature of his invention, and sets it forth so as to serve the double purpose—first, of showing a workman of ordinary knowledge and skill how he can construct the thing specified in the

patent; and second, of showing persons who read the patent what they must avoid doing if they would not infringe the patent." The sufficiency of the specification, as serving this double purpose, is a matter for the jury. (1 *Cr. S.* 3rd series, 721.)

(s) *FOXWELL v. BOSTOCK.* [1864]

The law requires that a specification should be intelligible to a workman of *ordinary* skill and information on the subject. (10 *L. T. Rep.*, *N. S.* 147.)

(t) *SIMPSON v. HOLLIDAY.* Ch. [1865]

Lord Westbury: "When it is stated that an error in a specification which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification, or the drawings it refers to; or which would be at once discovered and corrected in following out the instructions given for any process or manufacture; and the reason is because such errors cannot possibly mislead. But the proposition is not a correct statement of the law, if applied to errors which are discoverable only by experiment and further inquiry; neither is the proposition true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject." (13 *W. R.* 578; 12 *L. T. Rep.*, *N. S.* 99.)

(u) *THOMAS v. WELCH.* [1866]

It is necessary that the specification should state the object of the invention, and the means by which the patentee proposes to effect it. (*L. R.*, 1 *C. P.* 201.)

(v) *BETTS v. NEILSON.* Ch. [1868]

Whether a specification contains a sufficient description can only be ascertained by experiment; and in making the experiment, knowledge and means may be employed which have been acquired since the date of the patent. (*L. R.*, 3 *Ch.* 429.)

(w) *PARKES v. STEVENS.* [1869]

The sufficiency of a specification is not a question of law, but a question of fact in each particular case. (*L. R.*, 8 *Eq.* 358; 38 *L. J.*, *Ch.* 627; affirmed, *L. R.*, 5 *Ch.* 36; 22 *L. T. Rep.*, *N. S.* 635.)

(x) *PLIMPTON v. MALCOLMSON.* M. R. [1876]

Jessel, M.R., said:—"It is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. But then there are various kinds of people who know something about it. If it is a mechanical invention, as this is, you have, first of all, scientific mechanicians of the first class, eminent engineers; then you have scientific mechanicians of the second class, managers of great manu-

factories, great employers of labour, persons who have studied mechanics—not to the same extent as the first class, the scientific engineers, but still to a great extent—for the purpose of conducting manufactories of complicated and unusual machines, and who therefore must have made the subject a matter of considerable study; and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant even from slight hints, and still more from imperfect descriptions, and would be able to supplement, so as to succeed, even from a defective description, and, even more than that, would be able to correct an erroneous description. That is what I would say of the two first classes, which I will call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description or correct an erroneous description. Now, as I understand, to be a good specification, it must be intelligible to the third class I have mentioned, and that is the result of the law.” (*L. R.*, 3 *Ch. D.* 568.)

(y) *HINKS v. SAFETY LIGHTING COMPANY.* *M. R.* [1876]

Where a description in the specification of a lamp-burner omitted to state where the hole for the admission of air was to be made, it was held that the specification was bad. (*L. R.*, 4 *Ch. D.* 607.)

Jessel, *M. R.*: “Then comes the question, how far I am at liberty to correct the specification. The specification does not tell me where the opening is to let in the air. All it says is, ‘A circular hole is made in the cone or deflector, through which the circular flame passes.’ It is said that, though there is no opening in the drawing, yet a workman could correct the drawing by putting in the opening, and he could correct it because he is told there is a cone or deflector, and the cone or deflector of the lamp means something or other which will deflect air, and therefore there must be sufficient air to be deflected and support the light, and make it burn well. But, unfortunately for that argument, a lamp may burn badly although it is patented, and the patentee said it would burn badly, even though the holes were exceedingly small, or as I understood, if there were no holes at all it would burn, but it would be an imperfect combustion. . . . Now, this being so, I am not prepared to say that, when you put your specification into the hands of a skilled workman, he is to exercise invention to make a lamp useful, that he is to correct it without being told anything to correct it by.” (*Ib.* 616.)

(z) *BAILEY v. ROBERTON.* *H. L.* [1878]

The complete specification of a patent for “improvements in preserving animal substances,” said: “The manner in which

our said invention is performed is as follows :—We employ a solution, hereinafter distinguished as solution No. 1, being a solution of bisulphite of lime (usually expressed by the formula  $\text{CaO}, 2\text{SO}_2$ ), in water of the specific gravity 1050.” The specification then described the formation of solutions Nos. 2, 3 and 4, by mixing solution No. 1 with other bodies, and the mode of employing them in preserving various animal substances, but contained no statement as to how the solution No. 1 was to be applied or used for the purposes of the invention. The patentee claimed the use of solution No. 1 for preserving animal substances, and the preservation of particular animal substances by the various other solutions “in manner hereinbefore described.” *Held*, that, if the final specification claimed the independent and separate use of solution No. 1, for preserving animal substances, there was no sufficient description of the manner in which the invention was to be performed. (*L. R.*, 3 *App. Cas.* 1055.) Lord Cairns, L.C., said: “If it is the case that solution No. 1 is set up merely as a basis to be afterwards admixed with No. 2, No. 3 and No. 4, then, inasmuch as your lordships find an accurate and complete description of the manner in which the solutions of No. 2, No. 3 and No. 4 are to be used and applied, certainly the complete specification is open to no charge of being defective as not showing how the invention is meant to be performed. But, on the other hand, if the solution No. 1 is not only set up as a basis to be afterwards admixed with No. 2, No. 3 and No. 4, but to be used by itself pure and simple, then, my lords, I am bound to say that I must concede the cogency of the observations of the learned judges in the court below, that there is absolutely no statement of any kind how the solution No. 1 is to be applied and used.” (*Ib.* 1065.)

(a) *WEGMANN v. CORCORAN.* Fry, J. [1879]

Although the grantee of a patent for an invention communicated to him by a foreigner resident abroad, is only bound to tell the public all that he himself knows, yet, if the original inventor has not told him enough to enable him so to describe the invention as that it can be constructed by the aid only of the specification, the patent will be invalid. (*L. R.*, 13. *Ch. D.* 66.)

(b) *BRITISH DYNAMITE COMPANY AND OTHERS v. KREBS AND OTHERS.* H. L. [1879]

In an action for infringement of a patent for improvements in explosive compounds, and in the means of igniting the same, the defendants denied the novelty of the invention and the sufficiency of the specification. The specification stated: “This invention relates to the use of nitro-glycerine in an altered condition, which renders it far more practical and safe for use. The altered condition is effected by causing the nitro-glycerine to be absorbed in porous unexplosive substances, such as charcoal, silica-paper or similar materials, whereby it is converted into a powder which I call dynamite or Nobel’s explosive powder. By this absorption

of the nitro-glycerine in some porous substances it becomes in a high degree insensible to shocks, and can also be burned over fire without exploding. The safety powder is exploded: (1) when under confinement by means of a spark or any mode of ignition used for firing ordinary gunpowder; (2) without or during confinement by means of a special fulminating cap containing a strong charge of fulminate which is adapted to the end of a fuse, and is strongly squeezed to the latter for the purpose of more effectually confining the charge so as thereby to heighten the effect of the detonation. (3) By means of an additional charge of ordinary gunpowder the explosion of the latter will cause the dynamite to go off even when it is only partially confined. I claim as the invention the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the modes of firing the same by special ignition as herein set forth."

Dynamite was in fact made by pouring nitro-glycerine over a kind of silicious earth called keiselguhr, which was first calcined and reduced to powder.

Orlando Webb, manager of some slate quarries, deposed for the plaintiffs that he and his workmen had tried to make dynamite in 1867 by absorbing nitro-glycerine with powdered slate, using the cuttings from the machines, and that finding this not sufficiently absorbent, he mixed the slate powder with brick-dust, when considerably more liquid was taken up.

The Court of Appeal (Jessel, M.R., James and Thesiger, L.JJ.), reversing Fry, J., gave judgment for the defendants on the ground that the specification did not give directions by which an ordinary workman could without experiment produce a practical useful commercial article; inasmuch as there was nothing to indicate that the material was to be pulverized. And further on the ground that the patentee made a distinct claim to a mode of igniting by means of a special fulminating cap which was not a novelty at the time the patent was taken out.

On appeal, the House of Lords restored the order of Fry, J.

Cairns, L.C.: "The construction of the specification is for the Court to be determined like the construction of any other written instrument, the Court placing itself in the position of some person acquainted with the surrounding circumstances as to the state of art and manufacture at the time, and making itself acquainted with the technical meaning in art or manufacture which any particular word or words may have. When the nature of the invention is thus ascertained by the Court as a matter of construction, the Court has then to inquire whether the manner in which the same is to be performed is sufficiently described in the specification to the comprehension of any workman of ordinary skill in the particular art or manufacture; and this the Court can best do by the evidence of workmen of that description, and by evidence of what workmen of that description have actually done under the patent.

"Now I cannot doubt that looking to the description of the invention, as separate from the description of the way in which

it is to be performed, we have the nature of the invention sufficiently and intelligibly described. . . . But then it is said there is no sufficient description of the manner in which the invention is to be performed. . . . The matter is one which must be determined by evidence. Orlando Webb (admittedly a skilled witness) states that, in 1867, his attention was drawn to this specification and that he made dynamite under it. Neither he nor his workmen had any difficulty in making it. . . . No workman whatever, skilled or unskilled, has been produced by the respondents who states that he has been or would be misled by the specification or unable to make dynamite by following its directions. I come to the conclusion that there is no insufficiency in the specification.

"The second question is as to the extent of the claim. . . . I look upon the means of explosion, even assuming them to be known as applicable to other substances, to be part and parcel of the invention which the patentee was bound to give to the public as a complete invention, and I understand him to claim these means of explosion only as part and parcel of this invention. He does not, as it seems to me, claim the means of explosion *in gross*, but only as *appendant* to dynamite, and he would not be allowed under this patent to claim them for any other purpose. . . . The second claim being as it seems to me merely a claim to the user of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless." (1 *Good. P. C.* 88, at p. 91.)

(b\*) *PHILPOTT v. HANBURY.* [1885]

A patentee is required to particularly describe and ascertain the nature of his invention, and the means of performing the same. Those are two quite different things. The object of requiring the nature of the invention to be stated in the specification is that persons reading it may know with reasonable clearness and facility what they are prohibited from using. The object of requiring the patentee to particularly ascertain the means of performing the same is to prevent him from extending his monopoly by keeping secret the mode in which he did it. (2 *O. R.* 38.)

(c) *EDISON v. WOODHOUSE.* (No 2.) C. A. [1887]

The defendants did not show that the directions in the specification were not practically sufficient to enable a competent person to make the patented articles; but relied on the words used in the specification, and evidence that the temperature would have to be kept up, which the Court found was implied in the specification:—*Held*, that this was not sufficient to invalidate the patent, for if the language of a specification is clear enough to guide a competent workman, the Court cannot hold the language insufficient in point of law. No doubt it is for the Court and not for a workman to construe the specification; but if a workman says it is a sufficient guide to him, and the Court



believes him, the Court must hold that as regards clearness of description the specification is in point of law sufficient. (*Griff.* 95; 3 *O. R.* 183; 4 *O. R.* 99.)

(c\*) *BRAY v. GARDINER.* [1887]

If the patentee's claim to the new thing is so expressed that an intelligent reader must, after fair perusal and reasonable reflection, conclude what the production is of which the patentee has a monopoly, then the nature of the invention (as distinguished from the means of performing it) is sufficiently described. (4 *O. R.* 400.)

(d) *MOSELEY v. THE VICTORIA RUBBER COMPANY.* [1887]

In an action for infringement of a patent for improvements in the production of designs upon waterproof fabrics:—*Held*, as a matter of construction of the specification taken in connection with the evidence that the cold vapour process referred to was sufficiently described. (4 *O. R.* 241.)

(e) *BADISCHE ANILIN UND SODA FABRIK v. LEVINSTEIN.* H. L. [1887]

Two isomeric forms of naphthylamine were known to exist at the date of the plaintiff's patent, but one only, alpha naphthylamine, was known in commerce, the other being only mentioned in scientific books. Beta naphthylamine had only been known for a few years, before which time, and to some extent afterwards, alpha naphthylamine had been known as naphthylamine. The plaintiff's specification, which was, from its nature, addressed to advanced students of organic chemistry, mentioned naphthylamine as an important factor in his process, without stating which. Beta naphthylamine would not produce the desired result:—*Held*, reversing the decision of the Court of Appeal, that the specification was sufficient, and not open to the charge of ambiguity. (12 *App. C.* 710; 4 *O. R.* 449.)

(f) *EDISON AND SWAN ELECTRIC LIGHT COMPANY v. HOLLAND AND OTHERS.* C. A. [1889]

In considering the sufficiency of a specification for an incandescent light dated in 1879, it must be remembered that there was no trade then of manufacturing incandescent lamps, and therefore the specification should be so explicit as to enable an intelligent working man to make an incandescent lamp without having to try experiments. (*T. L. Rep. IV.* 386):—*Held*, by Kay, J., that the directions contained were not sufficient to enable the processes described to be followed out without careful experiments and numerous failures, and that therefore the specification was insufficient. (5 *O. R.* 459). But held by the Court of Appeal that the specification was sufficient. Lindley, L.J.: "Two conditions imposed by the old Patents Act, 15 & 16 Vict. c. 83, sect. 9, in order to sustain a patent are distinct, and compliance with one is not necessarily compliance with the other. The first condition is

that the patentee must state in clear and intelligible language what the invention really is, so that others may know what addition the patentee has made to what was known before, and what they are not at liberty to do without his consent. The second condition is that he must state in clear and intelligible language how the patented invention is to be performed, so that others may learn from it how practically to avail themselves of it." (6 O. R. 243.)

*Must be Candid, and not Misleading or Ambiguous.*

(g) LIARDET v. JOHNSON. N. P. [1778]

"The meaning of the specification is, that others may be taught to do the thing for which the patent is granted, and if the specification is false the patent is void, for the meaning of the specification is, that after the term the public shall have the benefit of the discovery."

In a patent for trusses for ruptures, the patentee omitted what was very material for tempering steel, which was rubbing it with tallow, and for want of that Lord Mansfield held it void. (1 Web. P. C. 53; Bull. N. P. 76.)

(h) REG. v. ARKWRIGHT. *Sci. fac.* [1785]

Buller, J., in addressing the jury, said: "It is clearly settled at law that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret, and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted; for the end and meaning of the specification is, to teach the public, after the term for which the patent is granted, what the art is, and it must put the public in possession of the secret, *in as ample and beneficial a way as the patentee himself uses it.* This I take to be clear law, as far as it respects the specification; for the patent is the reward, which, under the Act of Parliament, is held out for a discovery, and therefore, unless the discovery be true and fair, the patent is void. If the specification, in any part of it, be materially false or defective, the patent is against law, and cannot be supported." (1 Web. P. C. 66; Dav. P. C. 106.) According to the evidence, certain parts of the machine described were useless. Buller, J., said: "If those are of no use but to be thrown in merely to puzzle, I have no difficulty to say, upon that ground alone the patent is void." (Dav. P. C. 118.) "If four things only were necessary instead of ten, the specification does not contain a good account of the invention." (*Ib.* 125.)

(i) TURNER v. WINTER. [1787]

Action for the infringement of a patent for "a method of producing a yellow colour for painting in oil or water, making white-lead, and separating the mineral alkali from common salt, all to be performed in one single process." Three objections were taken to the specification. "First, that, after directing that lead should

be calcined, it directed another ingredient to be taken, which would not answer the purpose, viz. minium. Neither was it said that minium should be calcined or fused; but if it had any reference to the preceding words, then it should be calcined, which would not produce the effect, fusion being necessary. Second, that 'fossil salt' was improperly mentioned. There were many kinds of fossil salt, only one of which, viz. sal gem, would answer the purpose, because it must be a marine salt. Third, that the white substance produced was not that commonly known as white-lead:—*Held*, that, if any of these objections were well founded, it would avoid the patent. (1 *T. R.* 602; *Dav. P. C.* 145; 1 *Web. P. C.* 77.) Buller, J., said: "If the patentee says that by one process he can produce three things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant. Slight defects in the specification will be sufficient to vacate the patent." (1 *Web. P. C.* 82.) "If he (the patentee) make the article for which the patent is granted, with cheaper materials than those enumerated, although the latter will answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention, or enable them to derive the same benefit which he himself does. (*Ib.* 81.)

(j) *HUDDART v. GRIMSHAW.* N. P. [1803]

The insertion or representation of anything as material, not being so in fact, will vitiate the specification. (*Dav. P. C.* 295; 1 *Web. P. C.* 93.)

(k) *WOOD v. ZIMMER.* N. P. [1815]

In this action, to try the validity of Zinck's patent for "a method of making verdigris," it appeared that the method described in the specification was sufficient to make the verdigris, but that Zinck had been accustomed clandestinely to put *aquafortis* into the boiler, whereby one of the ingredients, copper, was dissolved more rapidly; but the verdigris so produced was neither better nor cheaper than that made according to the specification, which did not mention *aquafortis* in any way whatever. Gibbs, C.J.: "It is said that the method described makes verdigris, and that the specification is, therefore, sufficient. The law is not so; a man who applies for a patent, and possesses a mode of carrying on that invention in the most beneficial manner, must disclose the means of producing it in equal perfection, and with as little expense and labour as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public, at the expiration of his privilege, to make it in the same way, and with the same advantages. If anything that gives an advantageous operation to the thing invented be concealed, the specification is void. Now, though the specification should enable a person to make verdigris substantially as good without *aquafortis* as with it, still, inasmuch as it would be made with more labour by the omission of *aquafortis*, it is a prejudicial concealment, and a breach of the term, which

the patentee makes with the public." (*Holt, N. P.* 58; 1 *Web. P. C.* 82.)

(l) *BOVILL v. MOORE.* N. P. [1816]

Gibbs, C.J., in addressing the jury, said: "There is another consideration respecting the specification, which is also a material one, and that is, whether the patentee has given a full specification of his invention, not only one that will enable a workman to construct a machine answering to the patent, but one that will enable a workman to construct a machine answerable to the patent to the extent most beneficial within the knowledge of the patentee at the time; for a patentee, who has invented a machine useful to the public, and can construct it in one way more extensive in its benefit than in another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it, although he will have so far answered the patent as to describe in his specification a machine to which the patent extends; yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of, for exercising the privilege granted to him. . . . If at the time when he obtained his patent he was apprised of this more beneficial mode of working, and did not, by his specification, communicate this more beneficial mode of working to the public, that will have been a fraudulent concealment from the public, and will render his patent void." (*Dav. P. C.* 400.)

(m) *SAVORY v. PRICE.* N. P. [1823]

Action for the infringement of a patent for a method of making seidlitz powder. The specification gave three recipes for preparing the ingredients, which were Rochelle salt, carbonate of soda, and tartaric acid. It was proved that by following the directions given in the specification, the result was obtained, and that it was new and useful. It appeared also that the three recipes were only common processes for preparing the ingredients, which were sold in shops before the date of the patent. The specification did not give any name to the ingredients resulting from the three recipes:—*Held*, that the patent was void. (1 *Ry. & Mo.* 1; 1 *Web. P. C.* 83.) Abbot, C.J., in delivering judgment, said: "It is the duty of any one, to whom a patent is granted, to point out in his specification the plainest and most easy way of producing that for which he claims a monopoly, and to make the public acquainted with the mode which he himself adopts. If a person, on reading the specification, would be led to suppose a laborious process necessary to the production of any one of the ingredients, when, in fact he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or of any of them, may be bought in shops, this specification, tending to make people believe an elaborate process essential to the intervention, cannot be supported." (1 *Ry. & Mo.* 3.)

(n) *STURTZ v. DE LA RUE*. Ch. [1828]

The patent was "for certain improvements in copper and other plate printing." The specification declared that "the nature of the invention consisted in putting a glazed or enamelled surface on paper to be used for copper and other plate printing, by means of white-lead and size." This glaze or enamel was directed to be made by mixing size, in certain proportions, with "the finest and purest chemical white-lead," but the evidence went to show that there was no substance generally known in the trade by that denomination. Lyndhurst, L.C., said: "It is a principle of patent law, that there must be the utmost good faith in the specification. It must describe the invention in such a way, that a person of ordinary skill in the trade shall be able to carry on the process. Here, the specification says, that there is to be added to the size certain proportions 'of the finest and purest chemical white-lead.' A workman would naturally go to a chemist's shop, and ask for 'the finest and purest chemical white-lead;' the answer which he would receive would be, that there was no substance known in the trade by that name. He would be compelled to ask for the purest and finest white-lead; and, according to the evidence, the purest and finest white-lead that can be procured in London will not answer the purpose. It is said that there is a substance prepared on the Continent, which is white-lead, or some preparation of white-lead; and that, by using it in the manner described in the specification, the desired effect is produced. If that be so, the patentee ought to have directed the attention of the public to that circumstance." (5 *Russ.* 327; 1 *Web. P. C.* 83.)

(o) *CROMPTON v. IBBOTSON*. [1828]

The patent was for an improvement in drying and finishing paper. The patentee said in his specification: "The invention I claim consists in conducting the paper, by means of cloth or cloths, against the heated cylinders, which cloth may be made of any suitable material, but I prefer it to be made of linen warp and woollen weft." The evidence showed, that, before the date of the specification, the patentee had tried several fabrics for the purpose, but none had answered except the one made of linen and wool:—*Held*, that the specification was bad, as it tended to mislead the public. Tenterden, C.J.: "Other persons, misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail, and the public, therefore, has not the full and entire benefit of the invention." (*Dan. & L.* 34; 1 *Web. P. C.* 83; 1 *Carp. P. C.* 462.)

(p) *LEWIS v. MARLING*. [1829]

A party took out a patent for an improved shearing machine, to shear woollen cloths, and claimed four things as his invention. One of them was a proper substance to brush the cloth. In describing the machine in the specification, he directed plush to be used for this purpose, but he nowhere stated that this was an essential part of his machine. Before the time of the patentee's

invention some kind of brush had been uniformly used, but it was subsequently ascertained that with this machine no brush was necessary:—*Held*, that this did not invalidate the patent. (10 *B. & C.* 22; 4 *C. & P.* 56; 5 *M. & R.* 66; 1 *Web. P. C.* 493.) Tenterden, C.J., said: “If the patentee mentions that as an essential ingredient in the patent article, which is not so, nor even useful, and thereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful.” (1 *Web. P. C.* 495.) Bayley, J., said: “If the party knew that it (the brush) was unnecessary, the patent would be bad, on the ground that this was a deception, but if he thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms no ground of objection. . . . If the patentee suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad. So, if he says there are many modes of doing a thing, when in fact one only will do, this will also void the patent; but if he makes a full and fair communication, as far as his knowledge at the time extends, he has done all that is required.” (*Ib.* 496.)

(q) *CROSSLEY v. BEVERLEY.* [1829]

Bayley, J.: “It is the duty of the inventor, if between the period of taking out the patent and enrolling the specification he makes discoveries which will enable it better to effectuate the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and that it is not sufficient for him to communicate to the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he has obtained before the specification.” (1 *Web. P. C.* 117.)

(r) *JONES v. HEATON.*

Tindal, C.J.: “The patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification.” (1 *Web. P. C.* 404, (n.))

(s) *DEROSNE v. FAIRIE.* [1835]

A specification must state at least one method which will succeed. (2 *C., M. & R.* 493; 1 *Web. P. C.* 165.)

(t) *MORGAN v. SEAWARD.* N. P. [1836]

Alderson, B.: “If a patentee is acquainted with any particular mode by which his invention may be more conveniently carried into effect, he ought to state it in his specification.” (1 *Web. P. C.* 174.)

(u) *GALLOWAY v. BLEADEN.* N. P. [1839]

Tindal, C.J., referring to the specification, said: “If there is a

want of clearness, so that the public cannot afterwards avail themselves of it, much more if there is any studied ambiguity in it, so as to conceal from the public that which the patentee for a term is enjoying the exclusive benefit of, no doubt the patent itself would be completely void." (1 *Web. P. C.* 524.)

(v) *BICKFORD v. SKEWES.* [1841]

Patent for a miner's safety fuse. The specification directed the use of "gunpowder, or other proper combustible matter," for the manufacture of the fuse. It was objected, on behalf of the defendants, that the plaintiff had failed to show that any other material but gunpowder had ever been used in the fuse; or, if introduced, would answer the purpose desired. Denman, C.J., in delivering the judgment of the Court, said: "The first part of this objection is true in fact; but it seems to us immaterial; for if other materials, not specified (and it is certainly not necessary to specify all), but still within the description given, will answer the purpose, no ambiguity is occasioned, nothing that can mislead the public, or increase the difficulty hereafter of making the instrument, by the introduction of terms which import that the patentee has himself used them. The latter part of the objection, if true in fact, would have been more material, because it does tend to mislead if it be stated that a whole class of substances may be used to produce a given effect, when, in fact, only one is capable of being used successfully." (1 *Q. B.* 948; 1 *Web. P. C.* 218.)

(w) *WALTON v. POTTER.* N. P. [1841]

Tindal, C.J., in addressing the jury, said: "The object of the specification is, that it is the price which the party who obtains the patent pays for it, and it would be a hard bargain on the part of the public, if he were allowed to clothe his discovery and his description in characters so dark and so ambiguous, that no one could make from it when the fourteen years have expired, and he should not have paid the price for which he enjoyed the exclusive privilege, but that he should have it in his own hands still for as long a period as he chooses; and therefore, it is always a proper answer when a patent is set up, to say that you have not so described it, that it may be understood." (1 *Web. P. C.* 595.)

(x) *NEILSON v. HARFORD.* [1841]

A specification, which contains a false statement in a material circumstance, of a nature that, if literally acted upon by a competent workman, would mislead him, and cause the experiment to fail, is bad, and the patent invalidated, although the jury finds that a competent workman, acquainted with the subject, would not be misled by the error, but would correct it in practice. The patentee, in his specification, said: "The shape of the receptacle" (a part of his machine) "is immaterial to the effect." This was held to cast upon the patentee the necessity of proving to the satisfaction of the jury that any shape which could reasonably be

expected to be made by a competent workman, would produce a beneficial effect, and be a valuable discovery. (8 *M. & W.* 806.) At *nisi prius* it was held that the omission to mention anything which may be necessary for the beneficial enjoyment of the invention is a fatal defect, *aliter* if such omission go only to the degree of the benefit. (*Web. P. C.* 317.) The omission to mention in the specification anything which the patentee knows to be useful, is fatal. (*Ib.* 320.)

(y) *MACNAMARA v. HULSE.* [1842]

In a patent for blocks for pavement, the patentee claimed as his invention, that his block was bevelled both inwards and outwards on the same side of the block; but the specification did not state at what angle the bevels should be made; and one witness stated that the angle was material, but another witness stated that any angle would be of some benefit:—*Held*, that if the jury thought that a bevel at any angle would be beneficial, the specification would be good, although it omitted to state any particular angle at which the bevels should be made. (*Car. & M.* 471.)

(z) *WALTON v. BATEMAN.* N. P. [1842]

If a patentee knows a better mode than that which he states in his specification of carrying out his invention, his patent is void. (1 *Web. P. C.* 622.)

(a) *TETLEY v. EASTON.* N. P. [1852]

Pollock, C.B.: “A man has no right to patent a principle, and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it.” (*Macr. P. C.* 76.)

(b) *HEATH v. UNWIN.* Ex. Ch. [1852]

Coleridge, C.J., in the course of his judgment, said: “The specification, to be perfect, must be taken to specify impliedly all the chemical equivalents of those chemical means expressly stated for producing the promised result, which were at the time of specifying known to ordinarily-skilled chemists or to the patentee himself; the latter of these seems to me to be as necessary as the former. If the inventor of an alleged discovery, knowing of two equivalent agents for effecting the end, could by the disclosure of one preclude the public from the benefit of the other, he might for his own profit force upon the public an expensive and difficult process, keeping back the simple and cheap one, which would be directly contrary to the good faith required from every patentee in his communication with the public.” (2 *Web. P. C.* 243.)

(c) *THE PATENT TYPE FOUNDRY COMPANY v. RICHARDS.* Ch. [1859]

The specification of an invention, which consists in the use of known materials in new proportions, is not necessarily bad for



uncertainty, though the patentee does not limit himself to the precise proportions recommended. The patentee is bound, according to the authorities, to state what he considers the best proportions. A specification stated in substance, that the usual practice in the manufacture of type was, to employ lead and antimony, and in some cases to add a small percentage of tin; that the object of the invention was to obtain tougher metal by employing tin in large proportions with antimony, greatly reducing or wholly omitting the use of lead; that the best proportions were seventy-five of tin and twenty-five of antimony, but that this might be, to some extent, varied; and that, if lead were used, it must not exceed fifty per cent. of the whole, one part of antimony to three of tin, or tin and lead, being the best:—*Held*, on demurrer, that the specification was not bad on the face of it for uncertainty, and that the evidence of persons acquainted with the usual modes of manufacture was necessary to determine whether the invention was stated with sufficient precision. (1 *John Rep.* 381; 6 *Jur.*, N. S. 39.)

(d) *MACKELCAN v. RENNIE.* [1862]

Williams, J.: “The plaintiff in this case had obtained a patent for ‘improvements in floating-docks.’ In the course of the trial, it appeared that the construction of floating-docks was not novel. The plaintiff then alleged that his invention did not consist in the construction of floating-docks, but in the application of iron so as to form air-tight and water-tight chambers. The Lord Chief Justice was of opinion that, inasmuch as there was no mention of iron in the complete specification, the plaintiff had not complied with the conditions of the letters patent by duly describing the nature of his invention, and in what manner it was to be carried into effect; and, accordingly, he directed a nonsuit to be entered. We are all of opinion that he was quite right in so doing.” (13 *C. B.*, N. S. 59.)

(e) *SIMPSON v. HOLLIDAY.* [1864]

Patent for “improvements in the preparation of red and purple dyes.” The patentee in his specification said: “I mix aniline with dry arsenic acid, and allow the mixture to stand for some time; or I accelerate the operation by heating it to, or near to, its boiling-point.” The operation would not succeed if conducted by the first of these methods, viz. without heat. Wood, V.-C., said: “If the Court had any notion whatever that it (the first method) was put in with an intent to mislead, then without doubt or hesitation it would hold the patent to be bad; because there are two points in these cases of somewhat confused description in specifications which the Court mainly attend to—whether or no it has been put in with a fraudulent intent to mislead, so as to have a larger claim—on the one hand, that species of fraudulent intent to mislead, which at once leads the Court to decide against the validity of the patent; or, on the other hand, whether, although put in innocently by mistake, and without any fraudulent intent,

it is such a description as will or can mislead any ordinary workman in the operation that he has to carry on." (20 *Newt. Lon. Jour.*, N. S. 108.)

(f) *RALSTON v. SMITH.* H. L. [1865]

Lord Westbury: "There were some objections raised to the specification, and particularly with regard to the uncertainty of the material, the language of the amended specification being that the plaintiff took 'a roller of hard metal, or other suitable material.' I do not think those words 'or other suitable material' contain anything like such a generality of direction as would be fatal to the patent; 'other suitable material' no doubt would mean any material equally sufficient for the purpose with hard metal." (11 *H. L. Cas.* 248; 35 *L. J.*, C. P. 56; 20 *C. B.*, N. S. 47; 13 *L. T. Rep.*, N. S. 4.)

(f\*) *POOLEY v. POINTON.* [1885]

The plaintiff patented a process for making malt bread; in the same year he issued directions as to the proportions to be used, which differed from those in the specification, and in subsequent years he issued corrections, one of which was marked "private":—*Held*, that the specification was insufficient. (2 *O. R.* 167.)

(g) *EDISON v. WOODHOUSE.* [1886]

A patent, dated as to its final specification, May, 1880, claimed an electric lamp with a carbon filament for its illuminating conductor. The patentee took out a subsequent patent, dated as to its provisional specification, December, 1879, for a method of making carbon filaments for electric lamps:—*Held*, that there being no claim in the first patent for the manufacture of carbon filaments, there had been no such want of disclosure as to avoid the first patent. (32 *Ch. D.* 520; 3 *O. R.* 167; 4 *O. R.* 79; 55 *L. J.*, *Ch.* 943; 55 *L. T.* 263; 34 *W. R.* 626.)

(h) *COLES v. BAYLIS, LEWIS AND Co.* [1886]

The plaintiff was the assignee of a patent for the preparation of lithographic surfaces, on which designs had been produced in the ordinary manner by applying suitable materials to the designs, and amalgamating them by fusing so as to form enamelled designs in relief. After the assignment, and before filing the complete specification, the plaintiff gave instructions to a licensee of the patent, headed: "Instructions for working the etching process—the burning etching process." "In the case of transfers from engravings, reliefs, &c. . . . the stone must be etched, &c."; and amongst other directions it was mentioned, that "the prepared stone being blown dry . . . being kept for thirty minutes, the colour being dusted on with cotton wool; when this is done, the whole must be covered with French chalk, fresh cotton wool being used." And it was said, that you must be careful to use good French chalk, for common French chalk would not answer. None of these directions were embodied in the complete specification:—

*Held*, as these were instructions for working the specification, and as the invention might be completed so as to work by following out the specification alone, that whatever might be their effect as showing want of disclosure at the trial, the question was too fine to prevent the granting of an interim injunction. The case was settled before trial. (*Griff.* 58; 3 *O. R.* 178.)

(i) *THOMSON v. BATTY.* [1888]

In the specification of the plaintiff's patent for improvements in compasses, and in the means for ascertaining and correcting its errors, the third claim was for the employment in compasses of a large bowl filled, or partially filled, with a viscous fluid. It was proved that "partially filled" was necessary in order to secure the complete effect, but that "filling" would give some effect:—*Held*, that this was not sufficient to invalidate the patent. (6 *O. R.* 84.)

(j) *SHAW v. JONES.* [1889]

In the complete specification, the claim ran: "We claim the production of printing surfaces, &c., &c., by the combination of type-high geometrical squares, curves, angles, &c." :—*Held*, that the first two "&c.'s" were only put in *ex abundante cautela*, and meant "a printing surface, or any other name that you call it by"; that they were not put in to mislead, and did not vitiate the patent. The other &c. was not attacked. (6 *O. R.* 328.)

*Must Specify an Improvement, and distinguish what is New from what is Old.*

(k) *WILLIAMS v. BRODIE.* [Before 1785]

The invention was an improvement upon an old stove, but in the specification the whole stove was described, including both the old and new parts, without describing the invention as a new improvement upon an old thing, and it was *held*, that the patent was therefore void. (*Cit. Dav. P. C.* 96.)

(l) *HORNBLOWER v. BOULTON.* [1799]

The specification of a patent for a "method of lessening the consumption of steam and fuel in fire-engines," stated that the "method consisted in the following principles," and then described the mode in which those principles were applied to the purposes of the invention. Lord Kenyon, C.J., in delivering judgment, said: "I do not consider it as a patent for the old engine, but only for the addition to, or improvement of, the old engine. . . . It possibly occurred to the inventor, that if the patent were to be obtained for the whole engine, it might be open to cavil, and therefore he took out his patent not for the engine, but for his invention of a method of lessening the consumption of steam and fuel in fire-engines. The method is disclosed in the specification, and it is by the addition of what is there disclosed, and by managing it in the way described. The patent therefore is only for that additional improvement as

described in the specification ; and there is no pretence to say that he claims or could claim the sole making of the old engine." (8 *T. R.* 103.)

(m) *HARMAR v. PLAYNE.* [1809]

The patent in this case was granted for improvements in machinery, secured by previous letters patent. It was admitted by the defendant, that the improvements for which the second patent was granted are included in the second specification, which gives a full and proper description of the whole machine in its improved state. But it was objected, that the second specification does not, in any manner, point out or explain the improvements upon the former patented machine, for which the second patent was granted, and, therefore, that it was insufficient:—*Held*, that the specification was sufficient. (11 *East*, 101 ; *Dav. P. C.* 311.) Ellenborough, C.J., in the course of the argument, said : "The difficulty which presses most is, whether this mode of making the specification be not calculated to mislead a person looking at it, and induce him to suppose that the term for which the patent is granted may extend to preclude the imitation of other parts of the machine than those for which the new patent is granted ; when he can only tell by comparing it with some other patent what are the new, and what are the old parts ; and if this may be done with reference to one, why not by reference to many other patents, so as to render the investigation very complicated ? It may not be necessary, indeed, in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement ; but, on many occasions, it may be sufficient to refer generally to them. As in the instance of a common watch ; it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them." (11 *East*, 107 ; *Dav. P. C.* 318.)

(n) *MANTON v. MANTON.* N. P. [1815]

Gibbs, C.J., in addressing the jury, said : "It is necessary that the patentee should show that he has accurately explained the nature of his invention in his specification, *separating that which is new from that which is old*, so as to enable a person of tolerable skill to make the thing by means of his specification." (*Dav. P. C.* 349.)

(o) *MACFARLANE v. PRICE.* N. P. [1816]

A person ought to be warned by the specification against the use of the particular invention. Therefore, in the specification of a patent for an *improved* instrument, it is essential to point out precisely what is new, and what is old, and it is not sufficient to give a general description of the construction of the instrument without making such distinction, although a plate is annexed, containing a detached and separate representation of the parts in which the improvement consists. (1 *Stark.* 199 ; 1 *Web. P. C.* 74.)

(p) *BOVILL v. MOORE.* N. P. [1816]

Action for the infringement of a patent for a machine or machines for making lace. The specification described the whole machine, without pointing out any particular part or parts of it, as the invention of the patentee. Gibbs, C.J., held, that, if a combination of a certain number of the parts of the machine up to a given point, had existed before the date of the patent, and if the patentee's invention sprang from that point, and added other combinations to it, then the specification, stating the whole machine as his invention, was bad. (*Dav. P. C.* 361.)

(q) *HILL v. THOMPSON.* C. P. [1818]

If the invention be an improvement, it must distinctly appear on the face of the specification to be claimed as such, and not as an original discovery. (1 *Web. P. C.* 247.)

(r) *CARPENTER v. SMITH.* N. P. [1841]

Abinger, C.B., in his remarks to the jury, said: "It is required as a condition of every patent, that the patentee shall set forth in his specification a true account and description of his patent or invention, and it is necessary in that specification that he should state what his invention is, what he claims to be new, and what he admits to be old; for, if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and claims the whole of that as new, and does not state that he claims either any particular part, or the combination of the whole as new, why then his patent must be taken to be a patent for the whole, and for each particular part, and his patent will be void if any particular part turns out to be old, or the combination itself not new." (1 *Web. P. C.* 532.)

(s) *GIBSON v. BRAND.* [1842]

Cresswell, J.: "Every party is bound to tell the public clearly, by his specification, what he claims, and what they may do, or not do, without risk of an action for infringing his patent." (1 *Web. P. C.* 640.)

(t) *CRANE v. PRICE.* [1842]

It is no objection to the validity of a patent that the invention cannot be used except by means of a former patented invention, where the second patentee expressly disclaims any part of such former invention. (4 *M. & G.* 580.) Tindal, C.J., in delivering the judgment of the Court, said: "Unless the grantee of the new letters patent is bound by law to specify whether such former invention, which is excepted, was so excepted on the ground of its being generally known, and used by the public, or because it was the subject of a patent which secured the use of it to a former patentee, the new patent will be good. But that distinction is as much in the knowledge of the public as in that of the grantee of the patent. If, indeed, the new patent had been taken out for an

improvement or alteration of an invention secured by a former patent, then, for obvious reasons, a greater particularity would be necessary to distinguish the new from the old." (*Ib.* 608.)

(u) *M'ALPINE v. MANGNALL.* [1846]

If, taking the whole specification together, and giving its words a fair and reasonable interpretation, the Court can see that the specification only claims an improvement on an old machine, it will be sufficient. (3 *C. B.* 518.)

(v) *HOLMES v. THE LONDON AND NORTH-WESTERN RAILWAY COMPANY.* [1852]

The plaintiff obtained a patent for "an improved turning-table," all the component parts of which, except one, were comprised in a prior patent, the specification of which was not enrolled until after the date of the plaintiff's patent. The plaintiff, in his specification, claimed "the improved turning-table hereinbefore described," without showing that any part of it was old. The jury found that the introduction of certain suspending rods made the table a new instrument:—*Held*, that the specification was bad, as it did not distinguish what was new from what was old. (*Macr. P. C.* 13.)

(w) *TETLEY v. EASTON.* [1853]

A specification describing a patent invention must, unless a contrary intention appears, be deemed to claim all that it describes, not only as a whole taken in combination, but also all the essential parts of which such combination is composed. (2 *Ell. & Bl.* 956; *Macr. P. C.* 82.) Coleridge, J., said: "This rule may, perhaps, admit of some modification in favour of the patentee, in respect of things incidentally mentioned, which are old and universally known to be so; for, if he had occasion to introduce a hinge into his machinery, it would be absurd to expect that he should point out that the hinge was not new." (*Macr. P. C.* 87.)

(x) *LISTER v. LEATHER.* [1858]

A patent for a combination is not a claim that each part thereof is new. (8 *E. & B.* 1004; 3 *Jur., N. S.* 811.) Affirmed on appeal to the Exchequer Chamber:—*Held*, also, that a patent is a patent for a combination, if a combination is distinctly stated in the specification to be a part of the invention, although the combination is not expressly claimed; for a claim was not an essential to a specification, or necessary for the protection of the invention. Nor is it necessary to disclaim those matters which manifestly form no part of the invention. (8 *E. & B.* 1031; 27 *L. J., Q. B.* 295.)

(y) *MORTON v. MIDDLETON.* [1863]

Lord President: "The usual mode of claiming as new merely a combination or arrangement of certain things, not in themselves new, is to set forth, that what the patentee claims is not each of the parts, but the combination and arrangement of them, so as to produce either a new result, or a greater and better one than has

been attained before. But this course is not essential. If it appears from the reading of the document, that, although the patentee does not in so many words say, 'I limit my claim to so and so,'—yet if it plainly enough appears that he actually does only claim so and so, that is enough." (1 *Cr. S.*, 3rd Ser. 722.)

(z) *NEWALL v. ELLIOTT.* [1864]

Pollock, C.B. : "The patentee of a combination is bound to state what parts of the combination he claims to be new, or what parts of the combination he has taken from that general stock of knowledge which is common to all the public." (10 *Jur.*, N. S. 956.)

(a) *RENARD v. LEVINSTEIN.* Ch. [1864]

Lord Justice Knight Bruce: "Considering the different consequences that may arise as to the part of an invention communicated from a foreign country, and as to the part of the same invention, or set of inventions, which may be deemed to be in every respect new, I consider it to be a serious and very arguable question, whether it is or is not incumbent on the patentee to distinguish, to define, and to particularize what is new and what is old." (10 *L. T. Rep.*, N. S. 177.)

(b) *FOXWELL v. BOSTOCK.* Ch. [1864]

In a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty, otherwise, and in a more specific form, than by the general description of the entire machine. It is not sufficient that a person possessed of all the knowledge existing at the time of the patent on the subject-matter of the patent, will discern the improvement; or, that it may be discovered upon a minute comparison and collation of all existing combinations with the new combination that is claimed. The term "combination of machinery" is nothing but an extended expression of the word "machine." (10 *L. T. Rep.*, N. S. 144; 12 *W. R.* 723.) (But see *Harrison v. Anderson Foundry Company*, *post*, p. 450 (g).)

(c) *DANGERFIELD v. JONES.* Ch. [1865]

Where the patented machine or apparatus is entirely new, the patentee is not bound to describe and distinguish the different parts; but where the invention consists of a machine which is only an improvement upon an old machine, he must distinguish and describe all the parts which he claims as new. (13 *L. T. Rep.*, N. S. 144.)

(d) *DAW v. ELEY.* Ch. [1865]

Where a specification, in the first instance, describes the invention in too general terms, but afterwards, in describing the method of performing the invention, refers to certain figures in drawings annexed thereto, and the claim made is for the manufacture of the invention described with reference to those figures, the specification

is sufficient. The patent was for improvements in central-fire breech-loading cartridges. The specification, describing the method of performing the invention, referred to certain figures in drawings annexed thereto, but did not distinguish between what was new and what was old. The patentee claimed "the manufacture of cartridges described with reference to figs. 1, 2, and 1\* ; and I also claim the manufacture of cartridges described with reference to figs. 3, 4, and 3\* :"—*Held*, that the patent might be upheld by limiting the claim (as in *Seed v. Higgins*) for the manufacture of cartridges described with reference to the above-mentioned figures. (*L. R.*, 3 *Eq.* 500 n, 513 ; 14 *W. R.* 126 ; 13 *L. T. Rep.*, N. S. 399.)

(e) *PARKES v. STEVENS.* [1869]

Where a patentee has taken out a fresh patent for improvements on his original invention, it is sufficient, if, reading his second specification with the first, an artisan would have no substantial difficulty in ascertaining what was claimed. (*L. R.*, 8 *Eq.* 358 ; judgment affirmed, *L. R.*, 5 *Ch.* 36.) Sir W. M. James, V.-C., in the course of his judgment, said : "It is obvious that a patentee does not comply, as he ought to do, with the condition of his grant, if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy, and if a person desiring to find out what was new and what was claimed as new, would have to get rid of a large portion of the specification by eliminating from it all that was old and common-place, all that was the subject of other patents, or of other improvements, bringing to the subject not only the knowledge of an ordinarily skilled artisan, but of a patent lawyer or agent." (*L. R.*, 8 *Eq.* 365.) See also *Murray v. Clayton* (*L. R.*, 7 *Ch.* 585, 587).

(f) *WRIGHT v. HITCHCOCK.* [1870]

A patent was taken out by W. for "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The specification described a process of plaiting fabrics by means of a reciprocating knife in combination with a sewing-machine :—*Held*, that looking at the whole specification and claim, the sewing-machine was treated as a known invention already in use, and that it was distinct from the mode of crimping or plaiting to which the plaintiff laid claim. (39 *L. J.*, *Ex.* 97 ; *L. R.*, 5 *Ex.* 37.)

(g) *HARRISON v. ANDERSTON FOUNDRY COMPANY.* H. L. [1876]

Referring to the case of *Foxwell v. Bostock* (4 *De G. J. & S.* 298), Lord Cairns, L.C., said : "It is said to have been determined in that case, that where there is a patent for a combination there must be a discovery or explanation of the novelty, and the specification must show what is the novelty and what the merit of the invention. I cannot think that, as applied to a patent for a combination, this is, or was meant to be, the effect of the decision in *Foxwell v. Bostock*. If there is a patent for a combination, the combination itself is, *ex necessitate*, the novelty ; and the com-



bination is also the merit, if it be a merit, which remains to be proved by evidence." (*L. R.*, 1 *App. Cas.* 577.) Lord Hatherley, referring to the same case, said: "It was there held—and that, I think, was all that was held—that it is not competent to a man to take a well-known existing machine, and having made some small improvement, to place that before the public and say, 'I have made a better machine. There is the sewing-machine invented by so and so; I have improved upon that. That is mine; it is a much better machine than his.' That will not do; you must state clearly and distinctly what it is in which you say you have made an improvement. To use an illustration which was adopted, I think, by Lord Justice James in another case, it will not do, if you have invented the gridiron pendulum, to say, 'I have invented a better clock than anybody else,' not telling the public what you have done to make it better than any clock which is known." (*Ib.* 583.)

(h) *CLARK v. ADIE* (First App.). H. L. [1877]

Where a person has invented an improvement in the form of a particular apparatus or machine, but combines that individual improvement with other things which are not his invention, his specification must claim that particular individual thing, and not leave it doubtful whether the claim is made for the whole combination, of which that thing really only forms a part. (*L. R.*, 2 *App. Cas.* 315.) Lord Hatherley: "The case of *Foxwell v. Bostock* (4 *De G. J. & S.* 298) decides this, that where you take a well-known machine (as the sewing-machine was in that case and as the horse-clipper was in this), an instrument which was well-known before the date of the patent, you may, if you think fit, improve all the various parts of that machine by introducing into two or three of its definite parts, if there are so many, that which is new either by way of combination, or by way of discovery, and you may claim for each of those parts into which you have so introduced something new, the privilege of protection, just as if you had taken out letters patent for each of those new things separately—and you may claim for those parts A, B and C, which, considered as separate things, are in themselves deserving of a patent—you may claim for them, when united, a beneficial result which may entitle you to a patent for the whole machine. But, I apprehend, my lords (and I do not read the decision in the case of *Foxwell v. Bostock* as deciding more than I am stating), you must, in some way or other, inform those whom you are dealing with, by which I mean the general public—whom you wish to exclude for a certain limited number of years from using your invention,—you must inform them, in some mode or other, whether you have subdivided, if I may use the term, your machine into those separate parts and claim for each part the merit of novelty, or whether you are simply making a combination of things *per se* old, but which have never been used before in combination, and which make up, as you say, your machine, for which you claim protection as a novel and useful machine, and

which machine must not be made by anybody but yourself. If you claim protection also for a portion of the machine you must make it plain, I do not say necessarily by words or by any particular mode, but, in some definite mode or other, you must point out what is the combination of parts which you ask to have protected, and what are the subordinate parts which also you ask singly and respectively in themselves to have protected." (*Ib.* 328.)

(i) *EADES v. STARBUCK WAGON COMPANY.* [1881]

In an action for infringement of a patent for improvements in the construction of tramcars, described as being a method of making the body of a tramcar so as to swivel upon the under-frame:—*Held*, that the specification was bad, because it did not describe either an addition to or improvement upon an old invention, but it specified an invention for turning tramcars, which was in fact the subject of an old patent of which the patentee, when he took out his patent, had never heard. (*W. N.*, 1881, 160.)

(j) *MOORE v. BENNETT.* H. L. [1880-4]

When a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but you must condescend upon that which is improved. Upon the principle that the specification should not be vague but should give sufficient information, it ought not to disguise the real invention by a claim so wide that any one would suppose something to be claimed as new which is not. Where the claim is for a combination and not for particular subordinate things included in that combination, if the combination is a new one, and if the manner of arriving at it and working it, and the purpose for which it is useful are all properly, sufficiently and correctly described in the specification, so that any one acquainted with the subject will know in what respect it differs from the things which have gone before, then it would be contrary to the whole policy which allows such combinations to be the subject of a patent, to say that besides describing the manner of doing it in a way which would show every one acquainted with the subject what was the novelty in the thing, you are to go on, and although you do not want to claim subordinate parts as distinct from the entire combination, nevertheless you must specify the subordinate parts as constituting new elements. (*Griff.* 158, 1 *O. R.* 129.)

If the case of *Foxwell v. Bostock* were to be taken as it was understood before it was explained in *Harrison v. Anderston Foundry Company*, it would make it impossible to draw a good specification for a combination of old materials without such a degree of prolixity as would render it practically impossible. (1 *O. R.* 149, *Griff.* 162.)

(k) CARTSBURN SUGAR REFINING COMPANY v. SHARP. [1884]

A patent for an improvement must distinctly specify the part of the machine which is alleged to be improved, and the particular improvement for which protection is claimed.

In the specification the first claim was, "First, in a sugar-moulding machine the rotatory drum and series of moulds combined with the hopper and distributors and the packer is inclined towards and adapted to fill the moulds substantially as described." The only part of this, which could be said to be novel, was the packer:—*Held*, by Lord Kinnear, that the claim was bad, inasmuch as no one would, without a knowledge of the previous patents, suppose from the specification that the novelty for which protection was claimed was the packer. (1 O. R. 181.)

(l) ROWCLIFFE v. MORRIS. [1885]

In an action for infringement of a patent for improvements in frames for spring mattresses, it appeared that the invention was in fact a combination of four old parts, viz. (1) a rectangular frame, (2) a transverse adjustable bar resting thereon, (3) adjustable screws passing into or through the bar, and (4) webbing fixed to the end of the framework and held in tension by the adjustable screws:—*Held*, by Bristowe, V.C. (after a careful consideration of *Foxwell v. Bostock*, and *Harrison v. Anderston Foundry Company*), that, as there was nothing in the specification to show that the invention claimed was limited to the combination, the patent was invalid. (3 O. R. 17.)

(l\*) FAIRBURN AND HALL v. HOUSEHOLD AND ROSHER. [1886]

The plaintiffs' patent, which was for improvements in tramcar engines, was held invalid on the ground that the specification did not indicate with any approach to clearness or certainty what the patentee claimed as new. (3 O. R. 128.)

(l†) WATLING v. STEVENS. C. A. [1886]

The plaintiff's patent was for improvements in spring tip-vans. The specification was sufficiently clear to inform any person of adequate knowledge that what really was claimed was the combination of three things: friction rollers to move the frame; mechanism by which the rolling back produced the tipping; and the control over the angle of the tip:—*Held*, that the specification, although it was as near as possible to being bad, did just sufficiently discriminate between what was new and what was old. (3 O. R. 41, 153.)

(m) PROCTOR v. BENNIS. C. A. [1887]

Where a patent is taken out for a combination, and the combination is the invention, if that invention is new, it is immaterial to its validity whether the patentee has pointed out how far he does or does not claim particular portions, though if an alleged infringement consists only in taking part of the combination it is

necessary that the patentee should have claimed the part so taken as new. *Curtis v. Platt* (see p. 192 (n)), distinguished on the ground that there the result was old, and the novelty of the invention consisting only in improvements in a known machine for producing that known result, the patentee was strictly tied down to the mode described of effecting the improvements. (36 *Ch. D.* 740.)

(m\*) *KAYE v. CHUBB.* H. L. [1888]

Watson, L.: "If you claim a combination you need not say which of the parts are old." (5 *O. R.* 641, at p. 649.)

(n) *BOYD v. HORROCKS.* C. A. [1889]

The plaintiff's patent was for improvements in machinery for winding yarn or thread. In the specification the plaintiff said, "In a sixth detector arrangement, which is shown in fig. 14, the detectors are wires hanging on the yarns or threads, and guided on a swinging plate carried on by a horizontal wire or rod and having fixed on it the catch-plate holding up the slip lever arm. . . . I do not claim the combination of the swinging plate with the detector wires and rotating wiper shaft, but merely the application to that combination of the catch-plates with their arrangement in relation to the lever." Arrangements by which, when a thread is broken, a portion of the machinery, leaving the rest going on, had been stopped by means of detector wires, were very old:—*Held*, that the plaintiff's invention being to do, what had been done long ago, by improved means, the rule laid down in *Curtis v. Platt* applied, viz. that where there is a well-known machine, and there is an improvement in a part of that machinery for effecting the old object, though in a better way, you must confine the patentee to the improvement which he claims in effecting that particular object. The question does not come to be whether the alleged infringement is or is not a mechanical equivalent, but have you really taken in substance that which was the invention of the plaintiff:—*Held*, also, that, owing to the disclaimer, catches in the claim could not refer to any catch, whatever might be the means of effecting it, that the machinery being old the plaintiff ought to be confined to the particular details invented by him and introduced as improvements into the old machinery, and that as the defendant did not use catch-plates anything like the plaintiff's there was no infringement. (6 *O. R.* 152.)

#### *Claiming too much.*

(o) *R. v. ELSE* *Sci. fac.* [1785]

Where a patent claimed the exclusive liberty of making lace, composed of silk and cotton thread mixed, and not any particular mode of mixing, it was held to be void, on proof that silk and cotton thread had been before mixed on the same frame for lace, although not in the same mode. (1 *Web. P. C.* 76.)

(p) *HUDDART v. GRIMSHAW.* N. P. [1803]

Ellenborough, C.J., in addressing the jury, said: "In claiming the benefit of a patent, it is required that there shall be enrolled a specification, which shall convey to the public a corresponding advantage with that of the individual whose sole right is protected for that time, so that any person looking at a specification, who is skilled in the subject, may be able to accomplish the end; and if, in stating the means necessary to the production of that end, he oversteps the right, and appropriates more than his own, he cannot avail himself of the benefit of it." (*Dav. P. C.* 279; 1 *Web. P. C.* 86.)

(q) *BOVILL v. MOORE.* N. P. [1816]

Gibbs, C.J., in the course of his remarks to the jury, said: "If the plaintiff has in this specification asserted to himself a larger extent of invention than belongs to him, if he states himself to have invented that which was well known before, then the specification will be bad, because that will affect to give him, through the means of this patent, a larger privilege than could legally be granted to him." (*Dav. P. C.* 404.) If the patentee has claimed too much, it is immaterial whether he has done so fraudulently or inadvertently. (*Ib.* 414.)

(r) *HILL v. THOMPSON.* Ch. [1817]

Eldon, L.C.: "The specification must not attempt to cover more than that which, being both matter of actual discovery, and of useful discovery, is the only proper subject for the protection of a patent. And I am compelled to add, that if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled. On the other hand, there may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. But, in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of the materials. If there be a patent both for a machine and for an improvement in the use of it, and it cannot be supported for the machine, although it might for the improvement merely, it is good for nothing altogether, on account of its attempting to cover too much." (1 *Web. P. C.* 237; 3 *Mer.* 629.)

(s) *BLOXAM v. ELSEE.* [1827]

The patent was for a machine for making paper in single sheets, without seam or jointing, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length:—*Held*, that this imported that paper, varying in width between those extremes, should be made by the same machine, and that the patentee at the time of taking out the patent, not having any

machine capable of producing paper of different widths, the patent was void. (6 *B. & C.* 169; 9 *D. & R.* 215.)

(*t*) *LEWIS v. MARLING.* [1829]

A patent is not voided by the specification claiming as part, but not as an essential part of the invention, something which proves useless. (5 *M. & R.* 66; 10 *B. & C.* 22; 4 *C. & P.* 56.; 1 *Web. P. C.* 493.)

(*u*) *MINTER v. MOWER.* [1837]

“Patent for an improvement in the construction, making, or manufacturing of chairs.” The specification thus concludes: “What I claim as my invention is, the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair as above described.” It appeared from the evidence, that a chair, acting upon the same principle as that which the patentee claimed, had been constructed and sold by a person of the name of Brown, before the date of the patent; this chair had, however, been encumbered by additional machinery:—*Held*, that the specification was bad. (6 *A. & E.* 735; 1 *N. & P.* 595; *W. W. & D.* 262; 1 *Web. P. C.* 142.) Denman, C.J., said: “The specification claimed more than the plaintiff had invented, and would have actually precluded Brown from continuing to make the same chair that he had made before the patentee’s discovery. We are far from thinking that the patentee might not have established his title by showing that a part of Brown’s chair could have effected that for which the whole was designed. But his claim is not for an improvement upon Brown’s leverage, but for a leverage so described that the description comprehended Brown’s.” (6 *A. & E.* 745.)

(*v*) *GIBSON v. BRAND.* [1842]

If the patentee claims as his invention improvements in machinery, or a new combination of machinery, and the jury find that he has only invented an improved process, the patent is void. (1 *Web. P. C.* 631; 4 *M. & G.* 179; 4 *Scott, N. R.* 844.)

(*w*) *GAMBLE v. KURTZ.* [1846]

Where a patent was granted for improvements in apparatus for the manufacture of certain chemical substances, and the jury found that the apparatus itself was not new, but that the patentee’s mode of connecting the parts of that apparatus was new, the Court directed the verdict to be entered for the defendant, as the patentee had claimed more than was new. (3 *C. B.* 425.)

(*x*) *BEARD v. EGERTON.* [1849]

Maule, J.: “If you describe in a specification two ways of doing a thing, and by one way it cannot be done, the specification is bad.” (19 *L. J., C. P.* 40.)

(y) *R. v. CUTLER.* [1849]

The specification of a patent for "improvements in the construction of the tubular flues of steam boilers," described two modes of performing one part of the invention, either of which it was stated would produce the effect. At the trial the judge told the jury that, if either mode succeeded, the patent might be good, notwithstanding the imperfection of the others:—*Held*, that this was a misdirection. Denman, C.J., delivering the judgment of the Court, said: "I told the jury that if either of those methods were proved satisfactorily to do the work, the patent might be good, notwithstanding the imperfection of the other. The case of *Lewis v. Marling* had been quoted as establishing that doctrine, but on examination we find that the Court then only said that the claim of some part of the machine which turned out to be useless, did not vitiate the patent. This is certainly a very different thing from describing a part of the machine as capable of co-operating in the work, when in fact it is incapable, even though, at the same time, other means are described which might be effectually employed. The reader of the specification, relying upon it, might attempt to use the former mode in constructing the machinery, which would fail of its purpose from being too accurately made according to the patentee's instructions." (*Macr. P. C.* 137; 14 *Q. B.* 372 (n.))

(z) *TEFLEY v. EASTON.* N. P. [1852]

By making a general claim, a patentee cannot include in his patent improvements of which he was ignorant at the date of his patent. (*Macr. P. C.* 77.)

(a) *CROSSLEY v. POTTER.* N. P. [1853]

Pollock, C.B.: "In my mind, the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves specially to one good thing, and a jury will always take care that if that be a real invention, no man, under colour of improvement, shall be allowed to interfere with that which is the offspring of their genius." (*Macr. P. C.* 256.)

(b) *BOOTH v. KENNARD.* [1857]

Action for the infringement of a patent for "improvements in the manufacture of gas." The specification stated that the mode of using seed, and constructing the apparatus, might be the same as the apparatus used in the ordinary mode of making gas with coal, but that the inventor preferred placing the seed in a red-hot retort, of which a plan was given. The claim was as follows: "I claim for making gas direct from seeds, and matter herein named, for practical illuminations, or other useful purposes, instead of making it from the oils, resins, or gums, previously extracted from such substances." A previous patentee had, by his specification, proposed, for the manufacture of gas, to use fatty substances, such as greaves or graves; also the residuum after the oil had been expressed from seeds, such as oil-cake; also beech-nuts, mast, cocoa-

nuts, and other matters abounding in oil, and he proposed to use these substances separately and in combination:—*Held*, that the claim was too large, being a claim to make gas direct from seeds by any mode after a prior patent for making it by a particular mode, and, *Semble*, that irrespective of the prior patent, the specification was bad. (2 *H. & N.* 84; 26 *L. J. Ex.* 305.)

(c) *THOMAS v. FOXWELL.* Ex. Ch. [1859]

The patentee of a sewing-machine, in his specification, claimed “the application of a shuttle in combination with a needle, as shown in sheet 1, for forming and sewing loops of thread or other substance, for the purpose of producing stitches either to unite or ornament fabrics, whatever may be the means employed for working such shuttle and needle when employed together:”—*Held*, that this claim was not confined to the single application of a shuttle in combination with a needle, as shown in sheet 1; but extended generally to the application of a shuttle with a needle for the attaining the object therein stated; and, as the shuttle and needle had been used together previously, the patent was void. (5 *Jur.*, *N. S.* 37; affirmed in Ex. Ch., 6 *Jur.*, *N. S.* 271.)

(d) *SEED v. HIGGINS.* H. L. [1860]

The plaintiff took out a patent for an improvement in machinery used for roving cotton. His specification claimed the discovery of the application of the principle of centrifugal force for such purpose, but he filed a disclaimer, declaring that he intended to claim only the application of centrifugal force in the particular manner represented in drawings attached to the specification:—*Held*, that, taking the specification and disclaimer together, they sustained the patent for the invention of the particular machine described in the drawings. (8 *E. & B.* 755, 771; 27 *L. J.*, *Q. B.* 148, 411.) Affirmed in the House of Lords (8 *H. of L. Cas.* 550.) Lord Chelmsford, in delivering his judgment in the House of Lords, said: “Assuming that the specification had been originally bad, on account of the generality of the claim, I see nothing in the Act of Parliament which prevents such an objection as this being removed, the only limitation to a disclaimer of any part of the specification being that it shall not extend the exclusive right granted by the letters patent.” (8 *H. L. Cas.* 568.)

(e) *SIMPSON v. HOLLIDAY.* H. L. [1866]

A patent for “improvements in the preparation of red and purple dyes,” thus described the process: “I mix aniline with dry arsenic acid, and allow the mixture to stand for some time, or I accelerate the operation by heating it to, or near to, its boiling point, until it assumes a rich purple colour.” It was proved (and not denied by the patentee) that it was necessary to apply heat in order to produce the colour; but evidence was given that a competent workman would apply heat:—*Held*, however, that this description in the specification was bad, and the patent founded



thereon was invalid. (13 *W. R.* 577; 12 *L. T. Rep.*, *N. S.* 99. Affirmed in the House of Lords, *L. Rep.*, 1 *H. L.* 315; 35 *L. J.*, *Ch.* 811.) Westbury, L.C., hearing the case on appeal from Wood, V.-C., in the course of his judgment, said: "If the true construction of the specification be, that two distinct processes are described as being both efficient, and are both claimed as part of the invention, but one is found upon trial to be inefficient and useless, it is plain that the patent has been granted on a false suggestion, and is, therefore, invalid and bad at law." (13 *W. R.* 578.)

(f) *RUSHTON v. CRAWLEY.* Ch. [1870]

Sir R. Malins, V.-C.: "The public must be told in very distinct language in every specification, what are the articles they may use, and what they may not use. Therefore, if a man makes a discovery, and, instead of limiting himself in his specification to that which properly is the discovery (if it be one); makes his specification too extensive, and claim more than he is entitled to claim, that is calculated to embarrass the public; and is, I apprehend, a fatal objection to the patent." (*L. R.*, 10 *Eq.* 527.)

(g) *ARNOLD v. BRADBURY.* Ch. [1871]

Where a patentee, in his specification, professes to do by machinery what has never been done before by machinery, and describes the machinery by which he does it, his claim is not too large on the face of it, because it claims generally to perform the operation "by machinery." A patentee in his specification described an improved ruffle or frill, and the machinery by which he proposed to make such improved ruffle, and to fasten it to a plain fabric by a single series of stitches. By his claim he claimed "the production by machinery of ruffles, and the simultaneous attachment of them to a plain fabric by a single series of stitches:"—*Held*, that the claim was not, on the face of it, too large. (*L. R.*, 6 *Ch.* 706.)

(h) *GANDY v. RIDDAWAY.* C. A. [1885]

The plaintiff's claim was for constructing belts or bands for driving machinery of cotton canvas or duck woven hard. There were ten kinds of hard-woven canvas, and belts for the purposes specified could not be made out of all of those kinds, but only out of some of them:—*Held*, that the specification was bad, as the claim was for making belts out of the whole class, whereas for business purposes they could only be made from a part of that class. (2 *O. R.* 49.)

(i) *WATLING v. STEVENS.* C. A. [1886]

The plaintiff's patent was for improvements in spring tip vans, and was claimed as applicable to vans on two or four wheels. It was proved that the invention was useful in the case of four-

wheeled vans, and that it was applicable, but not that it was an improvement, in the case of two-wheeled vans:—*Held*, that the claim was not too wide. (3 *O. R.* 147.)

(f) *KURTZ v. SPENCE.* [1887]

Although a patentee is not bound to prove his invention to be commercially useful, nor to explain which of several methods is the best, yet he is bound to state what methods are possible, and to avoid stating as possible the methods, if any, which are not. The plaintiffs had claimed the use of peroxide of manganese, whether hydrated or anhydrous, and it appeared that the anhydrous oxide was for commercial purposes useless:—*Held*, that the patent was void. (5 *O. R.* 161.)

(g) *COLE v. SAQUI.* [1888]

A patentee may say in his specification that his invention is capable of application to other purposes beyond those specified without thereby invalidating his patent. (5 *O. R.* 489.) Reversed on Appeal, but on another ground. (6 *O. R.* 41.)

### *Construction of Complete Specification.*

Patents Act, 1883, Form D; The Form of Patent concludes as follows: “And lastly we do by these presents for us, our heirs and successors grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.”

(h) *FORSYTH v. RIVIERE.* [1819]

Patent for a “method of discharging or giving fire to artillery, and all other fire-arms, mines, chambers, cavities and places in which gunpowder, or other combustible matter, is or may be put for the purpose of explosion.” The specification pointing out how the invention was to be carried out:—*Held*, that the patentee was entitled to the exclusive application of the detonating mixture as priming, whatever the construction of the lock by which it was discharged. (1 *Web. P. C.* 97.)

(i) *HULLETT v. HAGUE.* [1831]

Lord Tenterden, C.J.: “I cannot forbear saying, that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them.” (2 *B. & Ad.* 377.)

(j) *HAWORTH v. HARDCASTLE.* [1834]

Tindal, C.J.: “There can be no rule of law which requires the Court to make any forced construction of the specification, so as to extend the claim of the patentee to a wider range than the facts would warrant; on the contrary, such construction ought to be made as will, consistently with the fair import of the language used, make the claim of invention co-extensive with the new discovery of the grantee of the patent.” (1 *Web. P. C.* 485.)

A patentee is to be presumed not to claim things which he must have known to be in general use. (*Ib.* 484.)

(k) *MINTER v. WELLS.* [1834]

In summing up his invention, a patentee stated it thus:—"My invention is the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair, as above described:"—*Held*, that this was not a claim to the principle of the lever, but to an application of that principle to a certain purpose, by certain means, and that the patent was good. (1 *C. M. & R.* 505; 5 *Tyr.* 163; 1 *Web. P. C.* 134.)

(l) *DEROSNE v. FAIRIE.* [1835]

The patentee, who was a Frenchman, used in his specification the word "discolouring" to signify depriving of colour, and the word "baked," instead of the word crystallized:—*Held*, that this did not render the specification void. (5 *Tyr.* 393; 2 *Cr. M. & R.* 476; 1 *Web. P. C.* 158; 1 *Gale*, 109.) Matters of construction that arise on the face of the specification are for the Court, subject to the sense put upon the terms of art by the jury. (1 *Web. P. C.* 156.)

(m) *MINTER v. MOWER.* N. P. [1835]

It is quite indifferent whether a word used in a specification is the correct description of the thing, provided it describes it so that no man can doubt what it is. (1 *Web. P. C.* 141.)

(n) *RUSSELL v. COWLEY.* [1835]

A patent claimed the invention of manufacturing tubes by drawing them through rollers, using a mandrel in the course of the operation. A later patent claimed the invention of manufacturing tubes by drawing them through fixed dies or holes, but the specification was silent as to the use of the mandrel:—*Held*, that the Court, taking the whole of the latter specification together, would infer that the mandrel was not to be used, and that the latter patent was good. (1 *C. M. & R.* 864; 1 *Web. P. C.* 463.) Parke, B.: "In the construction of a patent, the Court is bound to read the specification so as to support it, if it can fairly be done." (1 *Web. P. C.* 470.)

(o) *BICKFORD v. SKEWES.* [1841]

The language of the specification ought not to be astutely construed, so as to overthrow a patent. (1 *Q. B.* 950; 1 *Web. P. C.* 219.)

(p) *NEILSON v. HARFORD.* [1841]

The construction of the specification is for the Court, the meaning of the words and surrounding circumstances having been ascertained by the jury. Parke, B., delivering the judgment of the Court of Exchequer, held it a just rule of construction, to judge of the meaning of a particular phrase by taking the whole instrument together; and he construed the word "effect" in one part of the

specification as meaning beneficial effect, because it was evidently used in that sense in some other parts of the specification. (1 *Web. P. C.* 372.)

(q) *GIBSON v. BRAND.* [1842]

A patent was obtained for a new and improved process or manufacture of silk, and silk in combination with certain other fibrous substances. By the specification, the inventors declared the nature of the invention to consist of eight several and distinct parts or heads, the sixth being "the application of an improved process to the throstle machine, on the principle of the long-ratch, for the new and useful purpose of spinning silk waste;" and the seventh, "certain improvements effected by them in the throstle machine, by which the utility in spinning silk waste was greatly augmented." After describing the old process of converting silk waste into yarn, the specification proceeded to describe the novel process by which the plaintiffs produced their new or improved manufacture; and concluded thus:—"We desire it to be understood that we disclaim those parts of the process, or mechanism, which were, or may have been, previous to the granting of our patent, well known or in use for the same purposes; but we restrict our claims to the eight several heads of invention mentioned in the early part of the specification, all of which we believe to be new, and of great public utility:"—*Held*, that this was a claim, either of a new invention, or a new combination of parts of the throstle machine; and the jury having found "that the invention was not new, but an improved process, not a new combination," that the patent could not be supported. (4 *Scott, N. R.* 844; 4 *M. & G.* 179; 1 *Web P. C.* 631.)

(r) *MACNAMARA v. HULSE.* N. P. [1842]

Action for the infringement of a patent for "certain improvements in paving, pitching, or covering streets, roads, and other ways." The patentee, in his specification, said: "My invention consists in an improved mode of cutting or forming stone, or other suitable material, for paving or covering roads." The infringement complained of was the manufacture of wooden blocks according to the improvement of the plaintiff. Abinger, C.B., said: "I think that the words 'any other suitable material' include a wood pavement, though probably the plaintiff never contemplated it." (*Car. & Marsh.* 477; 2 *Web. P. C.* 129.)

(s) *THE HOUSEHILL COMPANY v. NEILSON.* [1843]

The letters patent and specification constitute one instrument, and are to be interpreted according to the ordinary sense of the terms. (1 *Web. P. C.* 679.)

(t) *MUNTZ v. FOSTER.* N. P. [1844]

Action for the infringement of a patent for "an improved manufacture of metal plates for sheathing the bottoms of ships and other such vessels." The patentee, in his specification, said: "I

take that quality of copper known in the trade by the appellation of 'best selected copper,' and that quality of zinc known in England as 'foreign zinc.'" Tindal, C.J., in summing up to the jury, said: "You have had evidence before you that 'best selected copper' is the very purest that can be had. What I understand, therefore, when he says, 'I take that quality of copper known in the trade by the appellation of "best selected copper,"' he takes it of that degree of purity of which the best selected copper was known at the time to consist. He adds also, 'and that quality of zinc known in England as foreign zinc.' I do not understand him to mean it should be made of foreign zinc alone, but of zinc of that quality wherever it was made." (2 *Web. P. C.* 104.)

(u) *ELLIOTT v. TURNER* Ex. Ch. [1845]

The specification described the invention to consist in the application to the covering of buttons, of such figured woven fabrics "wherein the ground, or the face of the ground thereof, is produced by a warp of *soft or organzine silk*, such as is used in weaving satin and the classes of fabrics produced therefrom." The jury asked how they were to understand the word "or" in the specification; whether it was used disjunctively, or whether "organzine" was the construction of the word "soft." The judge told them, that, in his opinion, unless the silk was organzine, it was not within the patent:—*Held*, that this direction was erroneous; for that the judge should not have told the jury, absolutely, that soft and organzine silk were the same, but that the words were capable of being so construed, if the jury were satisfied that, at the date of the patent, there was only one description of soft silk,—and that organzine,—used in satin weaving; but, otherwise, that the proper and ordinary sense of the word "or" was to be adopted, and the patent held to apply to every species of soft silk, as well as to organzine silk. (2 *C. B.* 446; 15 *L. J.*, *C. P.* 49.)

Words of a specification are to be construed according to their ordinary meaning, unless it be shown by something in the context (which may be explained by evidence) that a different construction ought to be adopted. (*Ib.*)

(b) *M'ALPINE v. MANGNALL*. [1846]

Patent for "improvements in machinery or apparatus for stretching, drying, and finishing woven fabrics." The specification, after explaining the mode of conducting the operation, continues:—"We are perfectly aware that many simple contrivances might be devised for effecting the object of our improvements, viz. giving vibrating motion to the selvages of the cloth, for the purposes above stated; but as it is not practicable to describe every possible method in detail, we desire it to be understood that any mode even of moving one side or selvage of the cloth whilst the other remains stationary, we shall consider to be an evasive imitation of our invention, if for the purpose of drawing the threads into diagonal positions by mechanical means instead

of manual labour :”—*Held*, that the patentee claimed, not the whole machine, but only those improvements which gave the vibrating motion to the fabric while in the course of drying. (3 C. B. 496; 15 L. J., C. P. 298.)

(w) BARBER v. GRACE. [1847]

The specification of a patent for “improvements in the process of finishing hosiery, and other goods manufactured from lamb’s-wool, &c.,” stated the invention to consist in submitting hosiery, and other similar goods, to the finishing process of a *press* heated by steam, &c., in the manner hereinafter mentioned. A description was then given, by letters, of a drawing which represented a press, which consisted of a box heated by steam, up to which another box similarly heated was to be pressed by means of hydraulic pressure, or by screws or other well-known means. After describing the method of pressing the goods between these hot boxes, the specification concluded by confining the inventor’s claim to the submitting hosiery and similar goods to the pressure of hot boxes or surfaces heated by steam as above described :—*Held*, that the specification did not claim a general mode of applying hot surfaces to fabrics, but that it was merely for the particular machine described in the specification, and that a method of finishing hosiery goods, by passing them through heated rollers, was not included in the patent. (1 *Exch.* 339; 17 L. J., *Exch.* 122.) Pollock, C.B., said : “Were the Court to hold that rollers are included in this patent, the effect of it would be, that if the party could have kept his process a secret in point of fact, and have given the public nothing but what they could gather from the specification, he might have had the exclusive use of rollers under the protection of the law for fourteen years, and at the end of that period the public would be wholly ignorant that rollers were capable of being used, and had been used, for such a process, or that they were the object of the patent.” (1 *Exch.* 344.)

(y) STEVENS v. KEATING. *Exch.* [1848]

Patent for “a process or method of combining various materials so as to form stuccoes, plasters, and cements, and for the manufacture of artificial stones, marbles, &c., used in buildings.” The specification described the process of making a cement from gypsum to consist in mixing with powdered gypsum, strong alkali (*ex. gr.* best American pearl-ash) dissolved in a certain proportion of water; this solution to be neutralized with acid (sulphuric acid being the best), the mass to be kept in agitation, and the acid to be added gradually till the effervescence should cease; and then a certain proportion of water to be added (if other alkali were used, the quantity to be varied in proportion to its strength); and the mixture having been brought to a proper consistence by the further addition of powdered gypsum, to be dried in moulds, and finally subjected to a furnace capable of producing a red heat. The specification concluded by stating

that other alkalies and acids beside those before mentioned would answer the purposes of the invention, though not so well, and that the inventor claimed the method or process thereinbefore described:—*Held*, that the specification was bad. “It must either be a claim of all acids and alkalies, or of all acids and alkalies that will answer the purpose. If it be a claim of all acids and alkalies, it is clearly bad, as there are some which will not answer the purpose. If it be a claim of those only which will answer the purpose, it is as clearly bad, in consequence of not stating those which will answer the purpose, and distinguishing them from those which will not, and so preventing the public from being under the necessity of making experiments to ascertain which of them will succeed and which will not.” (2 *Exch.* 772; 19 *L. J.*, *Ex.* 57.)

At *Nisi Prius* Pollock, C.B., said: “Some observations have been made at the bar on the subject of patents and specifications, and the different rules of construction that have been maintained at different periods. I take the rule to be, that you are not to intend anything in favour of a specification or patent, and certainly not to intend anything against it; you are to deal with it just as you find it; you are to put the true and right and fair construction upon every allegation and every fact connected with it, and you are to find what is the true and fair and just result. You are not to lean in favour of the public against the patent, which it is to be regretted was many years ago rather the fashion of the courts of justice, under the notion that it was a monopoly, that all monopolies were odious, and that, therefore, you were to intend everything against them; although, on the other hand, in modern times, it is said the leaning is the other way, I do not think there ought to be any leaning one way or the other.” (2 *Web. P. C.* 187.)

(z) *BEARD v. EGERTON.* [1849]

A specification of a patent for “a new and improved method of obtaining the spontaneous reproduction of all the images received on the focus of the camera obscura,” in describing the process, stated: It is to be divided into five operations. The first consists in polishing and cleaning the silver surface of the plate, in order to properly prepare or qualify it for receiving the sensitive layer or coating (iodine), upon which the action of the light traces the design; the second operation in the applying that sensitive layer or coating to the silver surface; the third, in submitting, in the camera obscura, the prepared surface or plate to the action of light, so that it may receive the images. The description of the first operation—preparing the silver surface of the plate—directed that nitric acid dissolved in water should be applied three different times, the plate being each time sprinkled with pounce, and lightly rubbed with cotton; adding, “When the plate is not intended for immediate use or operation, the acid may be used only twice upon its surface after being exposed to heat; the first part of the operation, that is, the preparation as far as the second application of the

acid, may be done at any time; this will allow of a number of plates being kept prepared up to the last slight operation; it is, however, considered indispensable, that, just before the moment of using the plates in the camera, or the reproducing the design, to put at least once more some acid on the plate, and to rub it lightly with pounce, as before stated; finally, the plate must be cleaned with cotton from all pounce dust which may be on the surface, or its edges." In a subsequent part of the specification, having described the second operation, viz., the application of the iodine, the inventor observed: "After this second operation is completed, the plate is to be passed to the third operation, or that of the camera obscura; whenever it is possible, the one operation should immediately follow the other:"—*Held*, that, taking the whole specification together, the direction as to the third application of acid was not to be understood to be a direction to apply the acid after the second operation, viz., the coating the plate with iodine,—which, it was proved, would render the whole process abortive,—but to apply it as part of the first operation; and that the specification gave sufficient information to an operator of reasonable skill, and was therefore sufficient. (8 C. B. 165; 13 Jur. 1004; 19 L. J., C. P. 36.)

(a) *SELLERS v. DICKINSON*. [1850]

Pollock, C.J.: "The specification should be met with candour and indulgence." (5 Ex. 324.) Rolfe, B.: "The Court should read a specification as a person of ordinary understanding would do, not loosely conjecturing anything, but, at the same time, not scanning it as if it were a special plea." (*Ib.* 326.)

(b) *THE ELECTRIC TELEGRAPH COMPANY v. BRETT*. [1851]

Patent "for improvements in giving signals and sounding alarms in distant places, by means of electric currents transmitted through metallic circuits." Subsequently to the patent, it was discovered that the return current could be conducted back to the battery through the earth as effectually as through a continuous metallic circuit. The defendant contended that, by using this method, they did not infringe the plaintiff's patent. Cresswell, J., delivering the judgment of the Court of Common Pleas, said: "With respect to the specification, it is to be observed, that the claim of the patentees being for improvements not all immediately connected with, or dependent on, each other, but all applicable to giving signals, &c., by means of electric currents, the plan adopted in the specification, was, to give an account of the whole system or mode of transmission of electric currents for the purpose of giving signals, and the modes of giving those signals, specifying afterwards those parts claimed as improvements, and either expressly disclaiming, or leaving unclaimed, all that was not expressly claimed. It is obvious, that in such a specification, that part which describes the matter claimed, is to be much more strictly construed than that which, though necessarily mentioned, is not spoken of as a new matter, or as the subject of a grant, but only as something known,



and necessary to be referred to for the purpose of explaining the claim. Considered in this view, we think the specification, in speaking of metallic circuits, may properly be considered as comprehending all circuits which are metallic, as far as it is material to the improvements claimed that they should be so; and that the expression in question is not to be construed with more strictness and precision than is necessary to enable it to fulfil that purpose of explanation for which it was introduced." (10 *Com. B.* 880.) "It appears to us reasonable to hold that a claim for a patent for improvements in the mode of doing something by a known process, is sufficient to entitle the claimant to a patent for his improvements, when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to improvements claimed, and their application." (*Ib.* 881.)

(c) *NEWTON v. VAUCHER.* [1851]

Specifications are to be read in connection with their titles. (6 *Exch.* 864.)

(d) *HOLMES v. THE LONDON AND NORTH WESTERN RAILWAY COMPANY.* [1852]

The plaintiff obtained a patent for "an improved turning-table," all the component parts of which, except one, were comprised in a prior patent, the specification of which was not enrolled until after the date of the plaintiff's patent. The plaintiff, in his specification, claimed "the improved turning-table hereinbefore described," without showing that any part of it was old. The jury found, that the introduction of certain suspending rods made the table a new instrument. Jervis, C.J., in delivering judgment, said: "The claim in substance is this—'for an improved turning-table.' Now, that will not have the effect of making everything that follows a combination, merely because he claims the turning-table." (*Macr. P. C.* 27.) Maule, J., after pointing out that the patentee had not distinguished what was new from what was old, said: "If it be impliedly said in the specification, that the suspension rods are new, and an improvement on what existed before, the same implication arises as to every other part." (*Ib.* 29.)

(e) *TETLEY v. EASTON.* N. P. [1852]

Pollock, C.B.: Specifications are to be construed in a candid and fair spirit, and if any mistake in one part can be corrected by other parts of the specification, such correction should be made. (*Macr. P. C.* 74.)

(f) *HASTINGS v. BROWN.* [1853]

A specification in a patent, for a particular construction of windlasses, stated that the object was "to hold, without slipping, a chain cable of any size." Before the date of the patent, con-

structions were known by which a windlass might be made to hold a single chain cable of any assigned size:—*Held*, that the specification did not unequivocally show, that the object was to construct a single windlass which might hold different chain cables, whatever their size, and that such a windlass was, therefore, not protected by the patent. (1 *E. & B.* 450; 22 *L. J., Q. B.* 161; 17 *Jur.* 647.)

(g) *PALMER v. WAGSTAFF.* [1854]

Pollock, C.B.: “A patent or specification should be construed in the sense which the patentee intended, and if any expressions are ambiguous, we should endeavour to give effect to the intention; and, moreover, I think that every patent should be expounded favourably to the patentee. But we ought not to violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate.” (9 *Exch.* 501.)

(h) *UNWIN v. HEATH.* H. L. [1855]

Crompton, J.: “I think that it would be a narrow and dangerous construction to limit the invention, claimed in express words, by the mode and process of working which the plaintiff sets forth, as a means of carrying his invention into effect.” (25 *L. J., C. P.* 12.)

(i) *BOVILL v. PIMM.* [1856]

The construction of a specification is a question of law when the facts are not disputed. (11 *Exch.* 740.)

(j) *HILLS v. LONDON GAS LIGHT COMPANY.* [1857]

Though the construction of a patent or specification is ordinarily for the judge, yet where a specification mentioned “the precipitated or hydrated oxides of iron,” and there was (on the issue of novelty) a prior patent proved, the specification of which mentioned carbonate of iron, and the scientific evidence showed that real carbonate of iron was difficult to be preserved, that it was not commonly sold in the shops (though it existed as a chemical substance), and what was sold for it would be, in fact, a hydrate, through absorption, but that carbonate would not be understood chemically as meaning hydrate; the judge, having ruled that the specification was to be construed commercially not scientifically, that carbonate commercially meant the “hydrate,” and that, on the issue of novelty, the plaintiff must be nonsuited, the Court, after great doubt, set aside the nonsuit, and granted a new trial. (27 *L. J., Exch.* 60.) See same case, *infra*, 469 (*l*).

(k) *THOMAS v. FOXWELL.* Ex. Ch. [1859]

The patentee of a sewing machine in his specification, claimed “the application of a shuttle in combination with a needle, as shown in sheet 1, for forming and sewing loops of thread or other

substance, for the purpose of producing stitches either to unite or ornament fabrics, whatever may be the means employed for working such shuttle and needle when employed together." By a disclaimer he stated, "I do not claim the use in a machine of several needles and shuttles, nor do I claim any of the mechanical parts separately of which the machinery shown in the drawing is composed:"—*Held* (affirming the judgment of the Court of Queen's Bench (5 *Jur.*, *N. S.* 37)), that the claim was not confined to the single application of a shuttle in combination with a needle, as shown in sheet 1, but extended generally to the application of a shuttle with a needle, for attaining the object therein stated. (6 *Jur.*, *N. S.* 271.)

(l) *HILLS v. THE LONDON GAS LIGHT COMPANY.* [1860]

In a patent for an improved mode of manufacturing gas, the plaintiff claimed a mode of purifying gas by means of "hydrated or precipitated oxide of iron:"—*Held*, that this included only precipitated hydrates. (5 *H. & N.* 312; 29 *L. J.*, *Ex.* 409.) Bramwell, B.: "It appears to us, upon looking at the specification, that the plaintiff uses those equivalent expressions, because he says, 'hydrated or precipitated,' and that oxide of iron may be conveniently prepared for these purposes, and so on; and therefore it is obvious that when he uses that word hydrated, he uses it as synonymous with precipitated; and consequently, when he speaks of using hydrated or precipitated oxides, he means such hydrated oxides as are precipitated." (5 *H. & N.* 368; 29 *L. J.*, *Ex.* 424.)

(m) *OXLEY v. HOLDEN.* [1860]

Patent for "certain improvements in the doors and sashes of carriages." One part of the invention consisted of a metal plate, with a slot and a stud or pin working in a groove on each side of the sash or frame; and the patentee claimed "the metal fittings and the mode of applying the same, described herein as the second part of my invention." The description of the metal fittings was inseparably interwoven, throughout the specification, with the mode of applying them:—*Held*, that this was a claim, not for the metal fittings themselves, but for the mode of applying them, and consequently, that the patent was sustained by proof that the application was new, though the stud and plates themselves were old. (8 *C. B.*, *N. S.* 666; 30 *L. J.*, *C. P.* 68; 8 *W. R.* 626; 2 *L. T. Rep.*, *N. S.* 464.)

(n) *SEED v. HIGGINS.* H. L. [1860]

Lord Campbell, L.C.: "Where novelty or infringement depend merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises how far one machine, or a material part of one machine, imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact which must be left to the jury." (8 *H. L. Cas.* 561.)

(o) *BETTS v. MENZIES*. H. L. [1862]

Blackburn, J., said: "I agree with what was said by Mr. Justice Crompton, in the Court below, that if the general claim to the use of an invention were cut down and limited to the use of the invention in the particular way pointed out by reason of the words 'as herein described,' it would be a narrow rule of construction, generally working to the detriment of patentees; and, what weighs more with me, generally giving an effect to specifications different from what the persons drawing them intended, or those reading them understand." (10 *H. L. Cas.* 140.)

(p) *HILLS v. EVANS*. Ch. [1862]

The construction of a specification, as the construction of all other written instruments, belongs to the Court; but the explanation of the words or technical terms of art, the phrases used in commerce, and the proof and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents) are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which it is the province and right of a jury to decide. But when those portions of a specification are made the subject of evidence, the direction to be given to the jury with regard to the construction of the rest of the patent, which is conceived in ordinary language, must be a direction upon the hypothesis of the jury arriving at a certain conclusion with regard to the meaning of those terms, the signification of those phrases, the truth of those processes, and the result of the technical procedure described in the specification. (31 *L. J.*, Ch. 457; 8 *Jur.*, N. S. 525.)

(q) *MACKELCAN v. RENNIE*. [1862]

In construing a specification, it is not competent to the inventor to pray in aid the provisional specification, in order to explain or enlarge the meaning of the complete specification. (13 *C. B.*, N. S. 52.)

(s) *RALSTON v. SMITH*. H. L. [1865]

R., in his specification, described his patent for improvements in embossing and finishing woven fabrics, as enabling him, upon a roller, either spirally or longitudinally, or in a circular form, to groove, or flute, or engrave, or mill, or otherwise indent any design. The fact was, that if the design was engraved longitudinally it would destroy the material. R. therefore, in a disclaimer, altered "upon" into "around the roller:"—*Held*, that the construction of the specification, as amended by the disclaimer, excluded spiral engraving, and confined it to circular engraving or grooves. (11 *H. L. Cas.* 223; 35 *L. J.*, C. P. 49; 13 *L. T. Rep.*, N. S. 1; 20 *C. B.*, N. S. 28.)

(t) *THOMAS v. WELCH*. [1866]

A specification, to which drawings were attached, after describing an instrument marked "g," continued, "It is the arranging an

instrument 'g,' as herein described, which, while it is the means of holding the fabric . . . is also the means by which the step-by-step movement is given to the fabric, which constitutes the peculiarity of my invention :"—*Held*, that this was not a claim of all instruments which were at once the means of holding and moving the fabric : nor, on the other hand, of the exact machine, with all its arrangements, contained in the drawings ; but a claim to the exclusive right to use "g," or any similar instrument, for the purpose of holding and moving the fabric at the same time. (*L. R.*, 1 C. P. 192.)

(u) *SIMPSON v. HOLLIDAY*. [1864-66]

A patentee, in his specification of a patent for preparing red and purple dyes, said : "I mix aniline with dry arsenic acid," &c. At the date of the patent an arsenic acid entirely free from water was known to chemists as anhydrous arsenic acid, but could not be commonly bought in the trade. This would not produce the dyes. A hydrated acid, containing from 12 to 14 per cent. of water was commonly sold by manufacturers, which was dry to the touch, and known in the trade as "dry arsenic acid." This would produce the dyes. Wood, V.-C., found, on the ground that the specification was addressed to manufacturers, and not to scientific chemists, that "dry arsenic acid" meant dry hydrated arsenic acid. (20 *Newt. Lon. Jour.*, N. S. 118.)

In the House of Lords Lord Westbury, L.C., hearing the case on appeal from Wood, V.-C., in the course of his judgment, said : "With respect to the rules that govern the construction of specifications, they are the ordinary rules for the interpretation of written instruments, having regard especially to the fact that the specification must clearly fulfil the obligation imposed on the patentee by the proviso contained in all letters patent, viz., that the grant shall be void if the patentee shall not particularly describe and ascertain the nature of his invention, and in what manner the same is to be performed. It is, therefore, made a settled rule, that the specification must be so expressed as to be perfectly intelligible to a workman of ordinary knowledge, and it must follow, that if there be any obscurity or ambiguity in the specification which is likely to mislead, this defect ought not to be helped by any refined or secondary interpretation of the language. It was contended before me, and the Vice-Chancellor is reported to have said, that it has been settled by authority that the most liberal construction is to be given to the patent that will sustain it, especially in those cases where the Court is satisfied that the invention is really new and useful. (20 *Newt. Lon. Jour.*, N. S. 107.) When it is stated that an error in a specification, which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification, or the drawings it refers to ; or which would be at once discovered and corrected in following out the instructions given for any process or manufacture ; and the reason is, because such errors cannot possibly mislead. But the proposition is not a correct statement of

the law, if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. . . . If the words, 'the most liberal construction' are intended to denote some principle of interpretation different from the ordinary rules for the construction of written instruments, I am not aware of any such authority." (13 *W. R.* 578; 12 *L. T. Rep.*, *N. S.* 99.)

(v) *JORDAN v. MOORE.* [1866]

A. obtained a patent for "certain improvements in the construction of ships and other vessels navigating on water." By his specification the patentee claimed as his invention, amongst others, (1) the construction of ships "with an iron frame, combined with an external covering of timber planking for the sides, bilges and bottoms; (6) the construction of iron frames adapted to an external covering of timber for the sides, bilges and bottoms, as described:"—*Held*, that the expression "iron frame" in the first claim, was not confined to an iron frame, such as that specified in the sixth claim, but comprehended whatever might, according to the ordinary use of language, be called "an iron frame," and that, as there had existed ships with iron framings similar to that which the plaintiff claimed, the claim was too large. (*L. Rep.*, 1 *C. P.* 624; 35 *L. J.*, *C. P.* 268.)

(w) *WRIGHT v. HITCHCOCK.* [1870]

A patent was taken out for "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The specification described a process of plaiting fabrics by means of a reciprocating knife in combination with a sewing machine. The first claim was for the general construction, arrangement and combination of machinery for producing plaited frills or trimmings in a sewing machine; the second was for the application and use of a reciprocating knife for crimping fabrics in a sewing machine; and the third, for the peculiar manufacture of crimped or plaited frills or trimmings "as hereinbefore described," and illustrated by a drawing:—*Held*, first, that the patent was not for the manufactured product, but for the process of manufacturing it; secondly, that the patent was not limited to the manufacture of plaited fabrics by the knife in combination with a sewing machine. (*L. Rep.*, 5 *Ex.* 37; 39 *L. J.*, *Ex.* 97.)

(x) *NEILSON v. BETTS.* H. L. [1871]

After a patent has stood inquiry and the test of time, courts do not encourage verbal objections to the form of the specification. (*L. Rep.*, 5 *H. L. Cas.* 1; 40 *L. J.*, *Ch.* 317; 19 *W. R.* 1121.)

(x\*) *NEWTON v. HALBARD.* [1872]

Grove, J.: "A specification should not be construed in a technical or captious spirit, but with a fair intention to give it effect if it be reasonably intelligible." (*John*, 152.)

## (y) HINKS v. SAFETY LIGHTING COMPANY. [1876]

Patentees of lamp-burners claimed by their specification as their invention the construction of burners "in the manner described and illustrated in the figures, that is to say, the employment in the same burner of two or more flat or curved wick-cases or holders in which two or more flat wicks are placed, so as to produce thereby one or more flat flames, or elliptical or nearly circular flames." The figures referred to showed burners with two wicks passing through a double-slotted cone. The use of two wicks with a single-slotted cone was old:—*Held*, that the claim could not be read as limited to burners with a double-slotted cone, and that the patent was bad for want of novelty. (4 Ch. D. 607.)

Jessel, M.R.: "I am anxious, as I believe every judge is who knows anything of patent law, to support honest, *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections, or on mere cavillings with the language of their specifications, so as to deprive the inventor of the benefit of his invention. This is sometimes called a 'benevolent' mode of construction. Perhaps that is not the best term to use, but it may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention if it can be supported on a reasonable construction of the patent. Beyond that the 'benevolent' mode of construction does not go." (*Ib.* 612.)

## (z) HARRISON v. ANDERSTON FOUNDRY COMPANY. H. L. [1876]

Lord Chelmsford: "In the construction of a specification, it appears to me that it ought not to be subjected to what has been called a benign interpretation or to a strict one. The language should be construed according to its ordinary meaning—the understanding of technical words being, of course, confined to those who are conversant with the subject-matter of the invention—and if the specification is thus sufficiently intelligible, it performs all that is required of it." (*L. R.*, 1 App. Cas. 581.)

## (a) DUDGEON v. THOMPSON. H. L. [1877]

Lord Blackburn: "The duty of the Court is fairly and truly to construe the specification, neither favouring the one side nor the other—neither putting an unfair gloss or construction upon the specification for the purpose of saving the patent if it is said that the patent is void, nor putting an unfair gloss or construction upon it in order to extend the patent and make it take in something which you may think was an unhandsome taking of the fruits of his invention from the patentee, if it is not really an infringement of the patent." (*L. R.*, 3 App. Cas. 53.)

## (b) PLIMPTON v. SPILLER. M. R. [1877]

Jessel, M.R., in delivering judgment, said: "It is the duty of the judge to construe a specification fairly, with a judicial anxiety

to support a really useful invention, if it can be supported upon a reasonable interpretation of the patent ; or, as Mr. Aston said, that a judge is not to be astute to find flaws in small matters in a specification, with a view to overthrow it. . . . When we come to read the claim, I think it is fair to say that, if it can be read in two ways, one claiming something that has a merit of novelty, and the other claiming something which would show the man to be ignorant of all the ordinary appliances used in every workshop in the world, it is the duty of the judge to adopt the construction which makes the patent reasonable and sensible, rather than that construction which makes the patent utterly absurd." (6 Ch. D. 422.) James, L.J. : " You must always construe a claim with reference to the whole context of a specification." (*Ib.* 427.)

(c) CLARK v. ADIE (Second App.). H. L. [1877]

Adie obtained a patent for " improvements " in a horse-clipping machine, and granted to Clark a licence to manufacture machines in accordance with the patent. The improvements described in Adie's specification comprised, among other items, the parallelism of the teeth of the comb, and the addition of an extra comb-plate when required, so as to regulate the length to which the hair might be clipped. Clark manufactured clippers not having parallel teeth nor an extra comb-plate, but, in other respects, similar to those patented by Adie, and resisted payment of the royalties under the licence in respect of these clippers, on the ground that the remaining items were old, and that the specification must be so construed as to exclude these items from the claim :—*Held*, that upon the natural construction of the specification it included a claim, not only in respect of the parallel teeth and extra comb-plate, but also in respect of the other matters, and that, as the specification was not ambiguous or doubtful, prior specifications were not of any weight to control its construction. The word " parallel " was construed in its popular and not in its mathematical sense. (2 App. Cas. 423.)

Lord Cairns, L.C., said : " A point was raised in the course of the argument, as to whether certain evidence ought or ought not to be admitted in this case. That evidence was of this kind : there had been previous patents granted to different persons, for the purpose of making horse-clippers of various kinds, and the present patent being a patent for ' improvements in the machinery for clipping horses,' it was said that those prior patents ought to be admitted in evidence for the purpose of showing the state of the manufacture before the present patent was granted, and that, they being so admitted, your lordships would find in them descriptions of the machine which were identical, or all but identical, as to the formation of the teeth, with the machine which the appellant, the licensee, was using. And then it was said, if that is so, the present patent claiming machinery which would be covered by former patents, would be invalid, and you ought to put upon this specification the construction, if it is possible to do so, which would deliver it from the peril of being held invalid by reason of the prior specifications. . . . I do not think it will be necessary for your



lordships to lay down any precise rule as to the reception or the rejection of evidence in this case. . . . It was said that if the specification before the House was ambiguous or doubtful, a construction might be put upon it which would save this specification from invalidity by reason of prior publication. My lords, it is unnecessary to consider that argument, for the specification appears to me not to be doubtful or ambiguous." (*Ib.* 430.)

Lord Blackburn: "In construing the specification, we must construe it like all written documents, taking the words and seeing what is the meaning of those words when applied to the subject-matter; and in the case of a specification, which is addressed not to the world at large but to a particular class, for instance, skilled mechanics, possessing a certain amount of knowledge, it is material for the tribunal to put itself in the position of such a class, namely, skilled mechanics, and to see what the words of the specification mean when applied to such a subject as skilled mechanics would know, and as the tribunal has now, by the admission of evidence or otherwise, put itself in a position to understand, and then to say what the words of the specification mean when applied to such a subject-matter. For that purpose I am not at all prepared to say that the other patents and specifications would not in the present case be admissible evidence, as having more or less weight (in this case I think they would have but little weight) or value as putting the Courts in the position of knowing what was the subject-matter they were dealing with, and what the words meant, and whether they had a different construction from what they would have if construed without that knowledge. But when it is attempted, as it certainly was in argument before us, to say that inasmuch as these specifications show, or are alleged to show, matters which, upon a fair construction of the specification claimed by the patentee, were old at the time that the patent was taken out, and were generally known to be old, therefore the specification must be so construed as not to include them; that seems to me to be both contrary, as far as I know, to the course of decision and contrary to principle." (*Ib.* 436.)

The judgment of the Court of Appeal was delivered by James, L.J., who said: "The admissibility was put on some expressions in the judgment of the learned judges in the case of *Trotman v. Wood* (16 *C. B.*, *N. S.*, 479), relating to *Trotman's* anchors. They are only *dicta*, because no such evidence was acted on in that case. It was never meant by the learned judges, and it cannot be effectually contended, that there is any principle to be applied to the construction of specifications which differs from that applicable to the construction of every written instrument whatever. Of course, in ascertaining the meaning of words used, you endeavour to put yourself as much as possible in the position of the person using them. . . . You assume that a patentee would not be so absurd as to claim that which he knew, and that which he knew everybody else knew, to be old, and you would, if possible, avoid that absurdity, if by any legitimate construction of the words used you could do so." (3 *Ch. D.* 142.)

(d) WEGMANN v. CORCORAN. C. A. [1879]

The plaintiff obtained a patent for "an improved machine or apparatus for treating or preparing meal." The specification described a machine by which meal was to be passed from hoppers between wooden rollers, and then between a pair of rollers called "squeezing rollers," and continued thus:—"The squeezing rolls are to have a surface consisting of material containing so much silica as not to colour the meal or flour. I prefer to make them of iron, coated with china, and finely turned with diamond tools." The patentee claimed, secondly, "the application of squeezing rolls having a surface consisting of material containing so much silica as not to colour the meal or flour, and so as to have the hardness required for the purpose set forth." The invention was said by the Court to consist in the use of squeezing rollers of a peculiar material not in common use, and of a particular construction, different from that of ordinary homogeneous rollers, and to be applied under conditions directed to the effecting of novel results.

It was proved by evidence that china having the composition of oriental china, which contains about 73 per cent. of silica, ceased to be manufactured in this country, except in very small quantities, at the end of last century, and was replaced by much softer china, containing only about 40 per cent. of silica. No china softer than oriental china was suitable for the fulfilment of the objects of the patent. It was also necessary that the china should contain a due proportion of alumina (about 23 per cent.), to correct the brittleness due to the large quantity of silica. In practice the rollers were constructed by placing a cylinder of such china round an iron centre, with a bedding of sulphur between the iron and china.

The only other practicable method of construction was to leave the cylinder hollow, being attached to an iron axis by flanges:—*Held*, that the specification was insufficient and misleading, inasmuch as—

- (1) The term "china" would include, if not primarily import, the material manufactured under that name in this country at the present time, and that would not answer the purpose.
  - (2) The material particularly described is described by a generic term, which comprises a variety of species, the large majority of which would be unsuitable for the purpose required.
  - (3) The expression "iron coated with china," would import something like an enamelling with china, but a roller so constructed would not answer the purpose.
  - (4) The material used not being the subject of manufacture in this country, and the construction of the rollers novel, the patentee ought to have described both with particularity, but this was not done.
  - (5) Every step in the application of the invention, as specified, would necessitate experiment.
- (13 *Ch. D.* 65.)

(e) ROBERTS *v.* HEYWOOD. V.-C. H. [1879]

The inventor of a painting machine, by his final specification, claimed the various parts of the machine, and, by his eighth claim, "the shallow sliding-tray, T, arranged and used substantially in the manner and for the purpose specified," being, in fact, an ordinary moveable tray, used for catching the drippings of the paint from the brushes and other parts of the machine, and being a thing commonly known and used before the date of the patent. He also claimed the general construction and combination of the several parts of the machine:—*Held*, in an action for infringement, that the patent was bad for want of novelty, inasmuch as it was impossible to construe the claim for the sliding-tray otherwise than as a distinct claim for a separate invention, and that the plaintiff's cause of action must fail on that ground. Hall, V.-C.: "Mr. Aston put to me the test case of a purchaser of one of the machines not having got the tray, and he might also have put the case of a purchaser having got the tray, but it had become worn out or broken; then, if this patent were good, it would be impossible for him to replace it without buying it from the plaintiff or infringing the patent; he would be precluded by the eighth claim. That shows that the specification does claim the tray as a separate invention and novelty." (27 *W. R.* 454.)

(f) WESTINGHOUSE *v.* LANCASHIRE AND YORKSHIRE RAILWAY COMPANY. [1882-4]

Grove, J.: "Practically 'substantially as herein described' come to nothing; . . . they do not alter the law or carry it a step further because the patentee, when he claims his invention, claims in connection with the drawings, and when he describes the nature of his invention, any person who substantially adopts that invention as claimed by him infringes his patent, and not a bit the more or the less because the patentee puts in the word substantially." (*Griff.* 244; 1 *O. R.* 98, 229 at p. 241.)

(f\*) CROPPER *v.* SMITH AND HANCOCK. C. A. [1884]

The idea that a benignant construction was one that ought to be invoked arose from the fact that judges were at one time supposed to be astute to defeat patents; but it was only an application of a principle of construction which is not at all special to the subject-matter of patents, viz., that when you can see what the true construction of the document is—or, in other words, what the true intention of the parties is as expressed in their language—you must not allow yourself to be drawn away from the true view by over nicety in criticism of expression. (1 *O. R.* at p. 89.)

(g) COUCHMAN *v.* GREENER. C. A. and H. L. [1884]

Where in an action for royalties the defendant is estopped from disputing the validity of the plaintiff's patent, if there is any doubt on the construction the Court may, notwithstanding the estoppel,

look at former patents, for the purpose of seeing what is the proper construction of the plaintiff's patent, but when once the patent is construed, the only question is, was the article in question within the patent or not. (1 *O. R.* 197 at p. 199.)

(g) *JACKSON v. WULSTENHULMES.* C. A. [1884]

The plaintiff's patent was for improvements in the construction of segmental toothed wheels:—*Held*, on the construction of the specification that the patentee did not claim the turning or fitting of the exterior rim or doing the same process to the wheel, which was what he relied on in the Court of Appeal as constituting an infringement. (1 *O. R.* 105.)

(h) *NEEDHAM v. JOHNSON.* C. A. [1884]

Lindley, L.J.: "I do not like the expression 'benevolent' interpretation. I do not believe in it. The question is whether a given construction is the true construction; but, of course, if any patent is capable of more constructions than one, the general rule would be applied, that you would put upon it that construction which makes it a valid patent, rather than a construction which renders it invalid. There is no particular benevolence in that. It is a general principle of interpretation applicable to all documents, but of course those who talk about the benevolent interpretation do not mean more than that. They do not mean that you are to put on a specification an interpretation which will turn that into an infringement which is not an infringement. Benevolent interpretation has nothing to do with infringement; it has to do with the validity of specifications." (*Griff.* 168; 1 *O. R.* 49 at p. 58.)

(i) *PHILPOTT v. HANBURY.* [1884–5]

A patentee must give the nature of his invention in reasonably accurate language. Grove, J.: "I do not say that he can possibly do it so as to prevent a critic finding some fault with it. Therefore I should read the specification liberally, and apply my mind to it in this way: Is this specification such that a fair man, willing or wishing to understand the specification, can reasonably gather from it what the patentee considers his invention, and what he says he prohibits the public from using?" (*Griff.* 185; 2 *O. R.* 33 at p. 38.)

(i\*) *OTTO v. STEEL.* [1886]

Inasmuch as it is the province of the Court to construe the specification, a judge of first instance is bound by a decision of the Court of Appeal upon the proper construction of the same specification, although given in an action between different parties. (3 *O. R.* 109.)

(j) *HOCKING v. HOCKING.* C. A. and H. L. [1886]

In certain circumstances it may be admissible to refer to an existing specification in order to show what was the state of public

knowledge, and what was the public use then going on of certain things, in order, knowing that, properly to construe the words which are in use in the specification in question. If the words of the specification are clear, of course these specifications cannot help in any way, nor could the public knowledge at the time help in any way; but if they are doubtful, then it may be legitimate and useful to look to all matters which would help the judge to determine what was the state of public knowledge at the time when the patent was granted. (*Griff.* 129; 3 *O. R.* 291.) Where there has been a disclaimer the Court must look at and construe fairly the disclaimer with the claim which still remains, and not because something is disclaimed give a hard construction to that which is still claimed. (4 *O. R.* 439.) Although it is true that a grantor should not defeat his own grant, yet this principle cannot be allowed to induce the Court to construe a specification differently because the defendant is the patentee and assignor to the plaintiff. (6 *O. R.* 69.)

(k) UNITED TELEPHONE COMPANY *v.* BASSANO. C. A. [1886]

Looking to the context (in the Edison patent, No. 2909, of 1877), the scientific witnesses said that they thought the words diaphragm or tympan must mean a diaphragm capable of being acted upon, and being made to vibrate by the motion of the air caused by the human voice, or in some other way. That was their construction of the specification, but the Court itself must look really at the specification, and give it its true construction, having got such help as it can find from the scientific witnesses as to the meaning in art of the words used. (*Griff.* 220; 3 *O. R.* 295.)

(l) FLETCHER *v.* GLASGOW GAS COMMISSIONERS. [1887]

Lord Maclaren: "Where an invention consists in the discovery of something that can be called a principle with a mode of making it effective in practice, the courts are always very indulgent in the construction of a specification, and very liberal towards the inventor in the inclusion within the scope of the patent of anything that can be regarded as a mechanical or chemical equivalent of the process." (4 *O. R.* 386 at p. 388.)

(m) HUTCHISON *v.* PATTULLO. [1888]

The patentee limited his first claim in clear and distinct terms to the subjecting of oils and fat in shallow layers to the joint action of air and heat, substantially as and for the purposes described:—*Held*, on the construction of the specification, that the second claim, which was "the combining of oxidised or thickened vegetable or animal oils or fats with mineral oils, substantially as and for the purpose hereinbefore described," did not cover every method of oxidation by heat and air, but only the mixing of fat oils already treated in the manner described or in some equivalent manner. (5 *O. R.* 351.)

(n) AUTOMATIC WEIGHING MACHINE COMPANY v. KNIGHT. C. A. [1889]

Lindley, L.J.: "We are told by the statute that we are to construe all patents in the most beneficial sense to the advantage of the patentee. Why that clause should have been put in I do not know. I should have thought the true rule was to ascertain the real meaning of the specification. . . . We certainly shall not be obeying that command if we give to any specification so wide a construction as to render the patent good for nothing. That will not do. We must construe it so as to uphold the patent, and make it good so far as we can. With regard to this specification, as with regard to almost all others that come before us, they are so drawn that it is conceivable to put a construction on them so wide as to render them worthless. But then on the other hand it is generally possible to construe them so narrowly as to render them useless. But we must ascertain the real meaning, and must, in obedience not only to this command, but common sense, construe it so as to uphold it if it can be reasonably done." (6 O. R. 297 at p. 307.)

(o) KAYE v. CHUBB. H. L. [1888]

Although it is not for a witness to construe a specification, it is quite allowable to ask him in an ordinary way what he understands by it. (5 O. R. 650.)

(p) VORWERK & SON v. EVANS. [1890]

In an action for infringement of a patent for improvements in waist bands, and in the means of weaving webs suitable for such uses, the specification stated that although three rollers were shown in the drawings, it was to be understood that two rollers, or any suitable number greater than three, might be used. The claims were—first, for the waist band; secondly, for the taking-up motion with conically-formed rollers arranged as described:—*Held*, that the patentee claimed the waist band only when made by the means described; that, having regard to the state of knowledge, the second claim must be taken to be for the means of weaving described; and that, seeing that the use of two rollers was well known, and that no express description of how to use two rollers was given, the specification did not cover the use of two rollers, so that the defendants who had used two rollers had not infringed. (7 O. R. 167, 265.)

*How affected by subsequent Discoveries.*

(q) CROSSLEY v. BEVERLEY. N. P. [1829]

Action for the infringement of a patent for "an improved gas apparatus." In the specification the patentee said: "My improved gas apparatus is for the purpose of extracting inflammable gas by heat from pit-coal, or tar, or any other substance from which gas or gases capable of being employed for illumination can be extracted by heat." It was objected to the sufficiency of the speci-

fication, that the retort described would not do for making gas from oil. Before the date of the specification, however, oil had never been employed for that purpose:—*Held*, that the specification was sufficient. (3 *C. & P.* 513; *Mo. & Mal.* 283; 1 *Web. P. C.* 106.) Tenterden, C.J., said: “I think it quite clear in this specification, when he speaks of coal and other matters, he means matters *ejusdem generis*. The patentee must be understood to mean things that were in use, and not things which would produce gas, as everything inflammable would, but, from being so expensive, were never expected to be in use.” (1 *Web. P. C.* 107.)

(l) *LEWIS v. MARLING.* [1829]

A party took out a patent for an improved shearing machine, to shear woollen cloth, and claimed four things as his invention—one of them was a proper substance (plush) to brush the cloth. In describing the machine in the specification, he directed plush to be used for this purpose, but he nowhere stated that this was an essential part of his machine. Bayley, J., said: “At the period when this specification was made, the plush was in use, and there is no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument where something of that kind was always thought material; and I am of opinion that the subsequent discovery, that the plush was unnecessary, is no objection to the validity of the patent.” (4 *C. & P.* 57; 10 *B. & C.* 27; 1 *Web. P. C.* 496.)

(m) *NEILSON v. HARFORD.* [1841]

If the apparatus, described in a specification, can be used beneficially in its simplest form, it is no objection that great improvements may have been made. (8 *M. & W.* 806.)

(n) *HEATH v. UNWIN.* H. L. [1855]

Parke, B.: “The specification must be read as persons acquainted with the subject would read it, at the time it was made; and if it could be construed as containing any chemical equivalents, it must be such as are known to such person at that time; but those which are not known at the time as equivalents, and afterwards are found to answer the same purpose, are not included in the specification.” (25 *L. J., C. P.* 19.)

(o) *SIMPSON v. HOLLIDAY.* Ch. [1864]

Where a patentee describes, in his specification, his invention in the best form that science could then give it, it is immaterial that a cheaper way of carrying out the invention has been subsequently discovered. (20 *Newt. Lon. Jour., N. S.* 116.)

### The Claim.

(p) *KAY v. MARSHALL.* Ch. [1836]

Lord Cottenham, L.C., said: “It (the claim) is introduced, lest in describing and ascertaining the nature of his invention, and by

what means the same is to be performed (particularly in the case of a patent for an improvement), the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. It is not to be looked to as the means of making a machine according to the patentee's improvements. If, therefore, the specification, as containing the description, be sufficiently precise, it cannot be of any consequence that expressions are used in the claim which would be too general if they professed to be part of the description." (2 *Web. P. C.* 39; 1 *My. & Cr.* 383.)

(q) *WALTON v. BATEMAN.* N. P. [1842]

Action for the infringement of a patent for "certain improvements in cards for carding wool," &c. The claim was for "the application and adaptation of caoutchouc or india-rubber as the fillet or sheet, or medium in which the dents or teeth are to be set together in the manufacture of cards, and thereby obtaining a superior elasticity and durability to cards as above described." In describing the method of carrying out the invention, the patentee recommended that a piece of linen should be fastened to the back of the india-rubber. Cresswell, J., said to the jury: "I was called on to express some opinion as to whether the plaintiff claimed, as an essential part of his patent, the application of linen, but I cannot help thinking there is some little confusion in the use of the term, 'what he claims as an essential part of his patent.' He claims, as distinctly as possible, the application of india-rubber as a substitute for leather in making the backs of cards in order to get an elastic bed; that is what he claims, and there is nothing about the cloth in that. But it is not sufficient that a man should claim a principle. He must add to it in his specification a mode of working out that principle practically, and that he does now; for you will find he recommends, as the best mode of working that out, the application of the cloth, but he does not profess to say it cannot be done without. If he had said, it cannot be done without, I should have thought he would have said the linen was essential to the working out of his principle." (1 *Web. P. C.* 622.)

(r) *HEATH v. UNWIN.* H. L. [1855]

Pollock, C.B.: "The right of the plaintiff does not turn upon the extent of his claim, but upon the communication made to the public as to the mode of accomplishing his object, and he has no right to claim anything but that which he has communicated to the public, however large in point of language his claim may appear to be." (5 *H. L. Cas.* 540; 25 *L. J., C. P.* 20.)

(s) *TETLEY v. EASTON.* [1857]

A patentee describing his invention in the specification, is to be taken to claim as part of his invention all that he describes as



the means by which it is to be carried into effect, unless he clearly expresses a contrary intention. (2 C. B., N. S. 706; 26 L. J., C. P. 269.)

(t) HINKS v. SAFETY LIGHTING COMPANY. M. R. [1876]

Jessel, M.R.: "It is for the patentee to tell the world that of which he claims a monopoly; to tell them, 'You may do everything but this; but this you must not do, this is my invention.'

"With the view of getting this into a narrow compass, it has long been the practice of patent agents to insert in specifications the distinct claim of what they say is comprised in the patent, meaning that nothing else is comprised, that everything else is thrown open to the public, or, to put it in other words, if a man has described in his specification a dozen new inventions of the most useful character, but has chosen to confine his claim to one, he has given to the public the other eleven, and he has no right to be protected as regards any one of the other eleven if he wishes to recall that gift which he has made by publishing the specification." (4 Ch. D. 612.)

(u) PLIMPTON v. SPILLER. C. A. [1877]

James, L.J.: "The real object of what is called a claim, which is now much more commonly put in than it used to be formerly, is not to claim anything which is not mentioned in the specification, but to disclaim something. A man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of things which are perfectly known and in common use—he describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention, and the mode of carrying that invention into effect, by way of security, he says: 'But take notice, I do not claim the whole of that machine, I do not claim the whole of that *modus operandi*, but that which is new, and that which I claim is that which I am now about to state.' That really is the legitimate object of a claim, and you must always construe a claim with reference to the whole context of a specification." (6 Ch. D. 426.)

(v) WESTINGHOUSE v. LANCASHIRE AND YORKSHIRE RAILWAY COMPANY. [1884]

It is necessary to look at the whole of the specification, and at the state of knowledge at the time of its publication, in order to decide whether a particular claim is a claim to a combination of several things some new some old, or a claim to several distinct inventions. (Griff. 244; 1 O. R. 98, 229.)

(w) JACKSON v. WOLSTENHULMES. C. A. [1884]

Patent for improvements in the construction of segmental toothed wheels. Bowen L.J.: "The fitting and turning is not

really treated as part of the invention nor is it claimed. It is mentioned in the previous part of the specification, but when we come to the claim at the end the claim omits it. It must be remembered that claims are for the security of patentees, to prevent it being said that the patentee has claimed more than can be really supported as his invention." Fry, L.J.: "I put the question to myself in another way. Supposing it were old, and supposing it were claimed, how could you disclaim it?" (1 *O. R.*, 105 at p. 109.)

(x) *GANDY v. REDDAWAY*. C. A. [1885]

The claim was for "constructing belts or bands for driving machinery, of cotton canvas or duck, woven hard and stitched and saturated and soaked with oil, such as linseed oil, or any combination thereof, as herein described or set forth, or any modification thereof." It was proved that there were ten kinds of cotton canvas woven hard, and that some of them were not sufficiently pliable for use with small pulleys.

Esher, M.R.: "What do you find in this claim? . . . It means this, that if you take any of that class of cotton canvas, known in the market as 'hard woven canvas' to make belting for machinery in the ordinary way for an ordinary machine, that will do. There is no distinction pointed out that it will only do for machinery of one particular size, and that it will not do for another. It is that that will do for belting. If that is the construction on the face of it, could that construction be altered or modified by evidence? I think it might. If it could be shown that although those words 'cotton canvas woven hard' do, on the face and surface of them, claim the whole class, yet no ordinary workman of ordinary skill and knowledge would think of taking any more than one part of that class, why then I should say that the effect would be that this would be a claim, not for that part which no ordinary workman would ever take, because that would be absurd and make it bad at once, but it would bring the true construction of the specification and claim, with that knowledge to be only for that part which an ordinary workman might take. . . . But if that was the true solution, it was for the plaintiff to show it, and they never asked a question to show it. . . . The claim is too large and the specification must be held to be bad." (*Griff.* 101; 2 *O. R.*, 49 at p. 52.)

(y) *LUCAS v. MILLER*. [1885]

The claim is in point of fact a disclaimer; it shows what parts and what parts only of the whole invention you mean to protect by your patent. (*Griff.* 156; 2 *O. R.*, 155.)

(z) *EASTERBROOK v. GREAT WESTERN RAILWAY COMPANY*. [1886]

The office of the claim is to protect the patentee from the danger of being supposed to make claims beyond those which he elects to make, and it must therefore limit his patent rights to what it fairly embraces. (*Griff.* 81; 3 *O. R.* 94.)

(a) FAIRBURN *v.* HOUSEHOLD. C. A. [1886]

In an action for infringement of a patent for improvements in tram-car engines, the main question was whether the patentee had sufficiently indicated that in the water-lifting part of his apparatus the water was to rise into the vacuum chamber in a divided column. Lindley, L.J.: "Not only has he not claimed it, but he has never pointed out the importance of it. . . . And it appears to me it would extend the scope of patents to a degree which would be alarming to inventors and other persons engaged in scientific pursuits, if you were to hold with regard to a patent like this, that a small portion of it, adopted by somebody else not in combination with the rest of the invention, but solely and separately and without in fact ever having pointed out that the part so taken solely and separately was of the essence of the invention, is to be held to be infringement." (*Griff.* 96; 3 *O. R.*, 128, 263 at p. 267.)

(b) EDISON *v.* WOODHOUSE. (No. 2.) C. A. [1887]

Every claim in every patent must be read and construed with reference to the specification, and not as if the claim were an isolated sentence having no connection with or reference to what precedes it. To see what is meant by carbon gas or liquid we must turn to the specification, and when we do so we cannot conceive that anyone reading the patent with a view to understand it would ever dream that carbonic oxide or carbonic acid could ensure the purpose or could be meant by carbonic gas (*Griff.* 90; 3 *O. R.* 183; 4 *O. R.* 99.)

(c) SIDDELL *v.* VICKERS. C. A. [1888]

By sub-sect. 5 of sect. 5 of the Patents Act, 1883, it is now for the first time required that the complete specification must end with a distinct statement of the invention claimed. "Distinct" here means independently and apart from the mere description of the nature of the invention, and of the way in which it is to be carried into effect. But this subsection is a mere direction to be attended to by the comptroller and the law officer when the matter comes before them; and if they are satisfied, then unless independently of this provision, the specification is so indefinite as to make the patent bad, the mere fact that there is not a compliance with this or with other provisions of section 5, will not make the patent bad. (39 *Ch. D.* 92.) *Affd.* in H. L. (7 *O. R.* 292.)

(c<sup>1</sup>) KELLY *v.* HEATHMAN. [1890]

The patentee claimed for his telescopic ladder (1) that two ladders occupy the place of one; (2) the working by a cord; (3) the simple bracket lever:—*Held*, that he meant to claim the combination of the three things, and that the claim was sufficiently distinct, or if not, that the patent was not thereby invalidated. (7 *O. R.* 343.)

(d) LEADBEATER *v.* KITCHIN. C. A. [1890]

In order to interpret the claim you must look at the claim and all the rest of the specification together. (7 *O. R.* 235.)

*Effect of Drawings annexed to Specification.**(d) BOULTON v. BULL.* [1795]

Rooke, J.: "I am not aware of any rule of law which requires a model or a drawing to be set forth, or which makes void an intelligible specification of a mechanical improvement, merely because no drawing or model is annexed." (2 *H. Bl.* 481.)

*(e) Ex parte Fox.* Ch. [1812]

A specification must be sufficient independently of the drawings. (1 *V. & B.* 67; 1 *Web. P. C.* 431.) [But see *Poupard v. Fardell*, p. 487 (n).]

*(f) BOVILL v. MOORE.* N. P. [1816]

The drawings annexed to the specification need not be well executed, or skilfully drawn; they are sufficient if they enable a workman of fair and competent skill in mechanism to make the patented machine. (*Dav. P. C.* 369.)

*(g) BRUNTON v. HAWKES.* N. P. [1820]

Abbott, C.J.: "If a drawing, or figure, enables workmen of ordinary skill to construct the improvement, it is as good as any written description." (1 *Carp. P. C.* 410.)

*(h) BLOXAM v. ELSEE.* N. P. [1825]

Abbott, C.J., said: "An inventor of a machine is not tied down to make such a specification, as, by words only would enable a skilful mechanic to make the machine, but he is to be allowed to call in aid the drawings which he annexes to the specification; and if, by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient." (1 *C. & P.* 564.)

*(i) MORGAN v. SEAWARD.* N. P. [1836]

Drawings are to be taken as part of the specification. (1 *Web. P. C.* 173.)

*(j) HASTINGS v. BROWN.* [1853]

A drawing may be taken to explain an ambiguity in the written description of the invention contained in the specification. (1 *E. & B.* 454.)

*(k) MORTON v. MIDDLETON.* [1863]

Drawings connected with the specification, and referred to in the letter-press, are to be examined and construed in connection with the specification; and, therefore, their intelligibility is a matter for the jury. (1 *Cr. S.*, 3rd Ser. 722.) The absence of a scale attached to drawings with a specification is an imperfection; and when any question as to identity of proportions arises, their absence becomes a matter of importance. (*Ib.* 724.)

*(l) FOXWELL v. BOSTOCK.* Ch. [1864]

Lord Westbury, C.: "It was contended by the plaintiff's counsel, and perhaps justly, that a patent for a new machine

would be good if the specification contained nothing but clear drawings of the machine and a description of them." (4 *De G., J. & S.* 303; 10 *L. T. Rep., N.S.* 146.)

(m) *DAW v. ELEY*. Ch. [1867]

Where a specification in the first instance describes the invention in too general terms, but afterwards, in describing the method of performing the invention, refers to certain figures in drawings annexed thereto, and the claim made is for the manufacture of the invention described with reference to those figures, the specification is sufficient. (*L. R.* 3 *Eq.* 500 (n.); 14 *W. R.* 126; 13 *L. T. Rep., N. S.* 399.)

(n) *POUPARD v. FARDELL*. Ch. [1869]

Malins, V.-C.: "A specification may consist of a drawing alone, and *Ex parte Fox* is clearly overruled." (18 *W. R.* 129.)

(o) *CLARK v. ADIE* (First App.). H. L. [1877]

In the drawing of a machine attached to a specification there was shown an intervening space, or opening, between two parts of the machine, the subject of the patent; it was intended as the arching of a cutter-plate, but this was not referred to and explained in the specification. In the specification there was the statement of an evil in existing machines, and upon careful examination by a skilful person, he might suppose that the space exhibited in the drawings was intended to obviate this evil, but there was no statement to that effect, nor was the form of the opening described, and described as a necessary quality of improvement in the machine. This form was afterwards relied upon as one of the great improvements in the combination of the patented apparatus:—*Held*, that as it had not been properly explained, described, and claimed, the specification was defective. (2 *App. C.* 315.)

(o<sup>1</sup>) *STEWART AND BRIGGS v. BELL'S TRUSTEE*. [1883]

An inference from the drawings cannot be held to control the clear language of the specification. (11 *Crt. of Sess. C., 4th series*, 236.)

(o\*) *FAIRBURN v. HOUSEHOLD*. C. A. [1886]

It is not sufficient for a patentee to insert in his drawing an important part of his invention, if he neither claims it nor points out the importance of it in the specification. (3 *O. R.* 263.)

### Comparison of Specifications.

(p) *MUNTZ v. FOSTER*. N. P. [1844]

Tindal, C.J.: "The identity of the inventions described in two specifications is a question for the jury." (2 *Web. P. C.* 105.)

(q) *ALLEN v. RAWSON*. [1845]

Coltman, J., delivering the judgment of the Court, said: "It was objected that it should have been left to the jury to say

whether the present patent and Robertson's patent were the same as to the method of diagonal or cross felting. On looking at the judge's notes, it appears that there was no evidence given to show that the two were the same: and, standing as the question did nakedly on the two specifications, the constructions of them, according to the authority of *Neilson v. Harford*, was for the judge, and not for the jury." (1 *C. B.* 571.)

(r) *TETLEY v. EASTON.* N. P. [1852]

Pollock, C.B.: "The question as to the identity of two inventions described in the specifications is for the Court." (*Macr. P. C.* 68.)

(s) *BUSH v. FOX.* H. L. [1856]

In an action for an alleged infringement of a patent, where the defence is that the supposed invention is not new, the judge may compare the plaintiff's specification with the specification of a previous patent, and may on such comparison direct the jury to find a verdict. (5 *H. L. Cas.* 707; *Macr. P. C.* 178; 2 *Jur., N. S.* 1029; 25 *L. J., Ex.* 251.)

(t) *BOOTH v. KENNARD.* [1857]

*Held*, upon the authority of *Bush v. Fox*, that as the want of novelty in the plaintiff's invention appeared clearly from the two specifications in evidence, it was for the Court, and not for the jury, to determine the identity of the two supposed inventions. (2 *H. & N.* 84; 26 *L. J., Exch.* 305.)

(u) *THOMAS v. FOXWELL.* [1858]

Lord Campbell, C.J.: "We by no means lay down, as a general rule, that upon a question of novelty of invention such as this, raised by the comparison of two specifications, it must necessarily be a pure question of law for the Court. The specifications may contain expressions of art and commerce, upon which experts must be examined, and there may be conflicting evidence raising a question of fact to be determined by the jury. But it is quite clear that there may be cases in which the Court would be bound to decide the question of novelty exclusively: for the two specifications might be, *in ipsissimis verbis*, the same; and, if they be in such plain and common language that the judge is sure he understands their meaning, he is bound to construe them as he does other written documents. (5 *Jur., N. S.* 38; affirmed on appeal, 6 *Jur., N. S.* 271.)

(v) *HILLS v. LONDON GAS LIGHT COMPANY.* [1860]

The plaintiff obtained in 1849 a patent for the purification of coal gas by means of hydrated oxides of iron. In 1847, F. having obtained a patent for the purification of gas by chloride of calcium, specified a mode of making the chloride of calcium by decomposing muriate of manganese, iron or zinc, and said, "the oxides or carbonates which result are useful for the said purifica-

tion of gas, and need not be removed." The oxides so prepared would be hydrates:—*Held*, that the Court, on a comparison of F.'s specification with that of the plaintiff, could not say, as a matter of law, that F. had anticipated the plaintiff's invention. (5 *H. & N.* 312; 29 *L. J. Ex.* 409.) Bramwell, B., in delivering the judgment of the Court, said: "We hold that there are certain cases in which, upon the mere collocation of the two specifications, or the specification of a patent and a previous written document, the Court may say that the patentee has been anticipated. Undoubtedly that is so; the process may be described in identically the same words, or, if there be a variety in the words, there may be no variety in the process. Probably it will be found that in the case of what are called mechanical patents, the Court can do so more readily than in the case of chemical patents, or in other cases where the invention depends on what may be called the occult qualities of matter—those in fact which are not the subject of popular knowledge." (5 *H. & N.* 363.)

(w) *BETTS v. MENZIES.* H. L. [1862]

As specifications describe external objects, though the language in two specifications be identically the same, it would be impossible to predicate of the two that they described exactly the same identical external object, unless the terms of art used in both the specifications could be ascertained to have been the same at the date of both the patents. The question of identity of signification belongs to the province of evidence, and not to the province of construction. (10 *H. L. Cas.* 117; 31 *L. J., Q. B.* 233; 11 *W. R.* 1; 7 *L. T. Rep., N. S.* 110.) Wilde, B., in his answers to the House of Lords, said: "If the terms of the two specifications are identical, and if it is not disputed that the terms of art used in the one have the same meaning as the same terms used in the other, which, from the lapse of time between the dates of the two patents may not always be the case, the Court ought to determine that the first publication anticipated the second, without evidence, and without any proof that either the first or second was practicable. If, though not identical, the language used in the two, when construed by the Court, describes identically the same process, machine, or manufacture, the Court may, subject to the same remark as to the terms of art, decide at once upon the question of anticipation. But if after construction, and after the meaning of the parties in the two documents has been ascertained by the Court, there be any difference between the two things described, which may be essential or material to the invention, and which is contended by either of the parties to be essential or material to the invention, the Court cannot decide such a controversy; it has neither materials nor means for so doing, and it must go to a jury. In a word, the Court can pronounce two identical descriptions to portray two identical inventions; but when the descriptions are different, the identity in substance of the two inventions is a matter to be established by extrinsic evidence." (10 *H. L. Cas.* 134.)

**(x) HILLS v. EVANS. Ch. [1862]**

In the comparison of two specifications, each of which is filled with terms of art, and with the description of technical processes, the duty of the Court is confined to giving the legal construction of such documents taken independently, but the comparison of the two instruments, and ascertaining whether the words, as interpreted by the Court, and contained in one specification, do or do not denote the same external matter as the words, as interpreted and explained by the Court, contained in the other specification, is a matter of fact, and within the province of a jury. (31 *L. J.*, *Ch.* 457; 8 *Jur.*, *N. S.* 525; 6 *L. T. Rep.*, *N. S.* 90.)

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*Manufacture.*

PATENTS ACT, 1883, sect. 46. In and for the purposes of this Act, "Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensa-

tions with penal laws and the forfeiture thereof") and includes an alleged invention (a).

(a) The 6th section of the Statute of Monopolies is as follows :—" Provided also, and be it declared and enacted, that any declaration before mentioned (against monopolies) shall not extend to any letters patents and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient: the said fourteen years to be accompted from the date of the first letters patents or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be, if this Act had never been made, and of none other."

(y) *DARCY v. ALLIN.* [1602]

"Where any man, by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, and that for the good of the realm, that in such cases the king may grant to him a monopoly patent, for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth bring by his invention to the commonwealth, otherwise not." (*Noy's R.* 182; 1 *Web. P. C.* 6).

(z) *THE CLOTHWORKERS OF IPSWICH.* [1615]

"If a man hath brought in a new invention, and a new trade within the kingdom in peril of his life, and consumption of his estate or stock, or if a man hath made a new discovery of anything; in such cases the king, of his grace and favour, in recompense of his costs and travail, may grant by charter unto him, that he only shall use such a trade or traffic for a certain time, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it; but when the patent is expired, the king cannot make a new grant thereof. For when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it." (*Godbolt's R.* 252; 1 *Roll R.* 4.)

(a) *MITCHELL v. REYNOLDS.* [1713]

"The grant of the sole use of a trade is void, but a grant of a trade newly invented, and for a time, is good; for the public has an advantage in the invention of a useful trade, which, after a limited time, is to be public; and the inventor's industry is sufficiently encouraged by the sole use of it secured to him by charter for such a time; but a second grant would be void, even in this case; and the statute 21 Jac. 1, c. 3, limits the time for which such grant may be made to fourteen years." (10 *Mod. R.* 130; 1 *P. Wms.* 181.)

(b) *BOULTON v. BULL.* [1795]

Heath, J., speaking of the word "manufacture" in 21 Jac. 1, c. 3, s. 6, said: "What then falls within the scope of the proviso?

Such manufactures as are reducible to two classes. The first class includes machinery, the second substances (such as medicines) formed by chemical and other processes, where the vendible substance is the thing produced, and that which operates preserves no permanent form. In the first class the machine, and in the second the substance produced, is the subject of the patent. I approve of the term manufacture in the statute, because it precludes all nice refinements; it gives us to understand the reason of the proviso that it was introduced for the benefit of trade. That which is the subject of a patent, ought to be specified, and it ought to be that which is vendible, otherwise it cannot be a manufacture." (2 *H. Bl.* 482.) Chief Justice Eyre said, when referring to the same subject: "It was admitted in the argument at the bar, that the word 'manufacture' in the statute was of extensive signification, that it applied not only to things made, but to the practice of making, to principles carried into practice in a new manner, to new results of principles carried into practice. Let us pursue this admission. Under things made, we may class, in the first place, new compositions of things, such as manufactures in the most ordinary sense of the word; secondly, all mechanical inventions, whether made to produce old or new effects: for a new piece of mechanism is certainly a thing made. Under the practice of making we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art producing effects useful to the public. When the effect produced is some new substance or composition of things, it should seem that the privilege of the sole working or making, ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance. . . . When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used, or for the process, if it be a new method of operating, with or without old mechanism, by which the effect is produced." (*Ib.* 493.)

(c) *HORNBLOWER v. BOULTON.* [1799]

Kenyon, C.J.: "I have no doubt in saying, that this (Watt's patent) is a patent for a manufacture, which I understand to be something made by the hands of man." (8 *T. Rep.* 99; *Dav. P. C.* 225.)

(d) *REX v. WHEELER. Sci. Fac.* [1819]

Abbott, C.J., delivering the judgment of the Court of King's Bench, said: "It is well known that the granting of monopolies was restrained by the statute 21 Jac. 1, c. 3, to the sole working or making of any manner of new manufactures, and to the true and first inventor of such manufactures. Now the word 'manufactures' has been generally understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine or instrument, or some part of an engine or instrument, to be employed,

either in the making of some previously known article, or in some other useful purpose, as a stocking-frame, or a steam-engine for raising water from mines. Or it may, perhaps, extend also to a new process to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind. But no merely philosophical or abstract principle can answer to the word manufactures. Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy this word." Supposing a new process to be the lawful subject of a patent, the word "method" may be properly used as synonymous with process. (2 *B. & Ald.* 349; 1 *Carp. P. C.* 397.)

(e) *MINTER v. WELLS.* [1834]

The patentee claimed "the application of a self-adjusting leverage to the back and seat of a chair, whereby the weight on the seat acts as a counter-balance to the pressure against the back of such chair, as above described:"—*Held*, that the patent was good, as the claim was, not for a principle, but for the application of a principle so as to produce a specified effect in a specified manner. (5 *Tyr.* 163; 1 *C.*, *M. & R.* 505; 1 *Web. P. C.* 134; 1 *Carp. P. C.* 639.)

(f) *CORNISH v. KEENE.* [1837]

The patent was "for an improvement or improvements in the making or manufacturing of elastic goods or fabrics applicable to various useful purposes." The patentee, in his specification, said: "The third object is to produce cloth from cotton, flax, or other suitable material, not capable of felting, in which shall be interwoven elastic cords or strands of india-rubber, coated or wound round with a filamentous material." To produce such a cloth, the patentee introduced into the fabric threads or strands of india-rubber, which had been previously covered by winding filaments tightly round them; they were then applied as warp or weft, or as both, according to the direction of the elasticity required. The strands of india-rubber were, in the first instance, stretched to their utmost tension, and rendered non-elastic; and being in that state introduced in the fabric, they acquired their elasticity by the application of heat after the fabric was made. Tindal, C.J., in delivering the judgment of the Court of Common Pleas, said: "Now the first objection made to the patent so described is, that the invention is not the subject-matter of a patent; that it is neither a new manufacture, nor an improvement of any old manufacture, but is merely the application of a known material in a known manner, to a purpose known before. The question, therefore, as to this point is, does it come under the description of 'any manner of new manufacture,' which are the terms employed in the statute of James? That it is a manufacture, can admit of no doubt; it is a vendible article, produced by the art and hand of man, and of all the

instances that would occur to the mind when inquiring into the meaning of the terms employed in the statute, perhaps the very readiest would be that of some fabric or texture of cloth. Whether it is new or not, or whether it is an improvement of an old manufacture, was one of the questions for the jury, upon the evidence before them; but that it came within the description of a manufacture, and so far is an invention which may be protected by a patent, we feel no doubt whatever. . . . The use of elastic threads or strands of india-rubber, previously covered by filaments wound round them, was known before; the use of yarns of cotton, or other non-elastic material, was also known before; but the placing them alternately side by side together as a warp, and combining them by the means of a weft when in extreme tension, and deprived of their elasticity, appears to be new, and the result, viz., a cloth in which the non-elastic threads form a limit, up to which the elastic threads may be stretched, but beyond which they cannot, and therefore cannot easily be broken, appears a production altogether new. It is a manufacture at once ingenious and simple." (3 *Bing. N. C.* 570; 6 *L. J., C. P.* 225; 4 *Scott*, 337; 2 *Hodges*, 281; 1 *Web. P. C.* 513; 2 *Carp. P. C.* 371.)

(g) *MORGAN v. SEAWARD.* [1837]

Parke, B., in delivering the judgment of the Court, said: "The word 'manufacture' in the statute (21 Jac. 1, c. 3, s. 6) must be construed in one of two ways: it may mean the machine when completed, or the mode of constructing the machine." (2 *M. & W.* 558; 1 *Jur.* 528; 1 *Web. P. C.* 193; 2 *Carp. P. C.* 100.)

(h) *NEILSON v. HARFORD.* [1841]

Patent for an invention "for the improved application of air to produce heat in fires, forges, and furnaces, where bellows and other blowing apparatus are required." The patentee, in his specification, described his invention thus:—"A blast or current of air must be produced by bellows or other blowing apparatus in the ordinary way, to which mode of producing the blast or current of air this patent is not intended to extend. The blast or current of air so produced, is to be passed from the bellows or blowing apparatus into an air vessel or receptacle made sufficiently strong to endure the blast, and through or from that vessel or receptacle by means of a tube, pipe, or aperture, into the fire, forge, or furnace. The air vessel or receptacle must be air tight, or nearly so, except the apertures for the admission or emission of the air; and at the commencement and during the continuance of the blast, it must be kept artificially heated to a considerable temperature." Parke, B., in delivering the judgment of the Court, said: "It is very difficult to distinguish it (the patentee's specification) from the specification of a patent for a principle, and this, at first, created in the minds of some of the Court much difficulty; but, after full consideration, we think that the plaintiff does not merely claim a principle, but a machine embodying a principle, and a very valuable one. We think the case must be considered as if, the principle being well

known, the plaintiff had first invented a mode of applying it by a mechanical apparatus to furnaces; and his invention then consists in this—the interposing a receptacle for heated air between the blowing apparatus and the furnace. In this receptacle he directs the air to be heated by the application of heat externally to the receptacle, and thus he accomplishes the object of applying the blast, which before was of cold air, in a heated state to the furnace.” (8 *M. & W.* 806; 11 *L. J., Ex.* 20; 1 *Web. P. C.* 331.)

(i) *WALTON v. BATEMAN.* N. P. [1842]

Action for the infringement of a patent for “improvements in cards for carding wool, cotton, silk, and other fibrous substances, and for raising the pile of woollen and other cloth.” After describing the manner in which the invention was to be carried out, the patentee continued: “And I do hereby confine my claim of invention to the application and adaptation of caoutchouc or india-rubber as the fillet or sheet, or medium in which the dents or teeth are to be set together in the manufacture of cards, and thereby obtaining a superior elasticity and durability to cards as above described.” Cresswell, J., in summing up to the jury, said: “There is sufficient of a new manufacture in this case to justify and maintain the patent that has been granted. I think that there is a new principle developed, carried out, and embodied in the mode of using that principle.” (1 *Web. P. C.* 613.)

(j) *CRANE v. PRICE.* [1842]

If the result produced by a previously unknown combination of two previously known methods is either a new article or a better article, or a cheaper article to the public than that produced before; such combination is an invention or manufacture intended by the statute, and may be the subject of a patent (see p. 502). (12 *L. J., C. P.* 81.)

(k) *STEAD v. WILLIAMS.* N. P. [1843]

Cresswell, J., stated it as his opinion that there might be a valid patent for a method of paving with wood. (2 *Web. P. C.* 134.)

(l) *HEATH v. UNWIN.* N. P. [1843]

The plaintiff obtained a patent for certain improvements in the manufacture of iron and steel. The specification described the invention as consisting in “the use of carburet of manganese in any process whereby iron is converted into cast steel,” and directed the unfused carburet of manganese to be put into the pot containing the steel in a fused state. The patentee claimed as his invention “the use of carburet of manganese in any process for the conversion of iron into steel.” The defendant manufactured cast steel by placing oxide of manganese and carbonaceous matter into the pot at the same moment as the steel. They produced the same effect upon the steel as the carburet of manganese, but at a cheaper rate. This method of producing the effect was not known at the time of taking out the patent. Abinger, C.B.: “The materials or elements

of carburet of manganese, as used by the defendant, being out of all proportion cheaper than the carburet of manganese itself, the use of such materials in the said composition is a new discovery or invention, and not within the letters patent." (2 *Web. P. C.* 217.) Parke, B., in the course of his answer to the question proposed by the House of Lords, said that the defendant in this case might have taken out a patent for this new mode of working. (25 *L. J., C. P.* 20.)

(m) *BENTLEY v. FLEMING.* N. P. [1844]

A machine does not cease to be the subject of a patent, merely because of the length of time during which the inventor may keep it by him, after it has been made a complete workable machine. (1 *C. & K.* 587.)

(n) *THE ELECTRIC TELEGRAPH COMPANY v. BRETT.* [1851]

Patent "for improvements in giving signals and sounding alarums in distant places by means of electric currents transmitted through metallic circuits." Subsequently to the patent, it was discovered that the return current could be conducted back to the battery through the earth as effectually as through a continuous metallic circuit, and this was the method used by the defendants. The defendants contended that the patent would protect the improvements of the patentee only when such improvements were applied to circuits that were metallic throughout, and therefore that they were entitled to employ the patentees' improvements. Cresswell, J., delivering the judgment of the Court, said: "It appears to us reasonable to hold, that a claim for a patent for improvements in the mode of doing something by a known process, is sufficient to entitle the claimant to a patent for his improvements, when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to the improvements claimed and their application." One of the claims of the patentee was an improvement "whereby a set of combined conducting wires, as aforesaid, having a voltaic battery and a set of buttons or finger keys, and also a dial with magnetic needles for giving signals, as well as an apparatus for sounding alarums at each end of the set, may also have duplicates of such dials, with needles and apparatus for alarums at intermediate places between the two ends; all such duplicates operating simultaneously with each other, and with the two end dials and alarums, to give like signals, and to sound like alarums." The jury found "that the sending of signals to intermediate stations was new to the plaintiffs." The defendants contended that this was a claim to the invention of a principle, and therefore that it was not the subject matter of a patent. Cresswell, J., said: "We think that the patentees not only communicated the idea or principle that duplicate signals might be given, but showed how it might be done, *i.e.*, by duplicate apparatus at each station, and that this is a fit subject of a patent. It was, indeed, contended that it was obvious and

self-evident that a circuit having a distant coil could have intermediate ones also, which would operate in the same manner; but it appears to us, that though it might be probable *à priori* that such would be the case, it was matter of experiment that it could practically be done, and that the invention of the patentees, though simple, was one for which a patent might be granted." (10 *Com. B.* 838; 20 *L. J.*, *C. P.* 123; 15 *Jur.* 579.)

(o) *NEWTON v. VAUCHER.* [1851]

The defendant had obtained a patent for an improvement in packing hydraulic and other machines, by means of a lining of soft metal, the effect of which was to make certain parts of the machine air and fluid tight. Subsequently to this the plaintiff discovered that soft metal had the effect of diminishing friction, and of preventing the evolution of heat when applied to the surfaces in contact of machines in rapid motion, and subject to pressure. And he accordingly obtained a patent "for certain improvements in the construction of boxes for the axles or axle-trees of locomotive engines, &c., and also for improvements in oiling or lubricating the same." (6 *Exch.* 859; 21 *L. J.*, *Exch.* 305.) Parke, B., said: "Upon looking at his (the plaintiff's) specification, which embodies a new principle in a new machine, it differs materially from the defendant's, which is for the purpose merely of packing; for in the plaintiff's invention it is essential that there should be not only the intervention of soft metal, but that there should also be a hard rim covered in part with that soft metal, or some other means, to prevent the soft metal from expanding, and getting out of its place. But any other hard rim, covered with soft metal, or substances covered with soft metal, are part of that machine. That is no part of the defendant's invention. Therefore, I think the discovery of the person under whom the plaintiff claims, is not merely a discovery of a new principle, but a new principle embodied in a new machine. Then, that being so, if the plaintiff claims a patent for that new principle embodied in a new machine, and that only for the purpose of diminishing friction, and the application of it is only to cases where there is pressure as well as motion, that patent is perfectly good." (6 *Exch.* 865.)

(p) *BUSH v. FOX.* [1854]

Coleridge, J.: "Manufacture includes both process and result." (*Macrory's P. C.* 176.)

(q) *HARWOOD v. GREAT NORTHERN RAILWAY COMPANY.* [1860]

Blackburn, J.: "The word 'manufacture' extends not only to principles that may be supposed to be patented, but to the modes of applying those principles, in practical use, in the result." (29 *L. J.*, *Q. B.* 202.)

(r) *HILLS v. LONDON GASLIGHT CO.* [1860]

Before the date of the plaintiff's patent, it was known that hydrated oxides of iron would absorb sulphuretted hydrogen; but



it was not known that they could be practically used in the purification of coal-gas from sulphuretted hydrogen:—*Held*, that a patent might be had for applying hydrated oxides to absorb sulphuretted hydrogen from coal-gas. It was also known that sulphuret of iron, produced by the action of sulphuretted hydrogen upon hydrated oxide of iron, would be re-oxidised by being exposed to the action of atmospheric air. But it was not known that when the sulphuret was produced by exposure of hydrated oxide of iron to the action of sulphuretted hydrogen, mixed with coal-gas, the re-oxidation of the iron might not be prevented by cyanogen, compounds of ammonia, and tarry matter which would be mixed with it:—*Held*, that a patent might be had for re-oxidising the iron by exposure to the air after it had been used in the purification of coal-gas. (5 *H. & N.* 312; 29 *L. J., Ex.* 409.)

(s) *MORTON v. MIDDLETON.* [1863]

Action for the infringement of a patent for improvements in the construction of pillars, &c., applicable to the construction of gate-posts, &c. Lord President: "Although the object of other pillars that have been used may have been the same as the object contemplated by this one, yet, if the invention here in a great and material degree attains that object better, then we must hold that there is novelty in it, and that it might be protected by a patent." (1 *Cr. S., 3rd Series*, 722.)

(t) *RALSTON v. SMITH.* H. L. [1865]

It is not every useful discovery that can be made the subject of a patent, but the words "new manufacture," in 21 Jac. 1, c. 3, will comprehend not only a production, but a means of production. It will comprehend a new machine, or a new combination of machinery, a new process, or an improvement of an old process (11 *H. L. Cas.* 223; 13 *L. T. Rep., N. S.* 1; 35 *L. J., C. P.* 49; 20 *C. B., N. S.* 28.)

(t\*) *ARNOLD v. BRADBURY.* [1871]

On a motion for issues the defendants objected that the patent was bad for want of subject-matter. Hatherley, L.C.: "If he (the patentee) produces a machine and dispenses with a process which is avowed to be injurious, I cannot, in the absence of evidence, take on myself to say that that would not be the subject-matter of a patent." (*L. R.* 6 *Ch. App.* 706, at p. 714)

(u) *CANNINGTON v. NUTTALL.* H. L. [1871]

The appellants were the assignees of a patent for "improvements in the manufacture of glass." All the principles upon which the patentee's method was based were well known, but their combination was both new and useful:—*Held*, that the combination was the subject-matter of a valid patent. (*L. Rep.*, 5 *H. L.* 205; 40 *L. J., Ch.* 739.) Lord Westbury: "Now, the only thing that appears to have been regarded by the patentee, Mr. Pocheron, as a new discovery, was the application of the external air to the

sides of the tank. My lords, it was a discovery certainly, but it was a thing for which, independently of the other apparatus, probably no patent could have been obtained. I may construct an apparatus, and may, in point of fact, make the merit and benefit of that apparatus depend upon the application of some dynamic force which is perfectly well known, but my invention consists in the construction of the apparatus in such a manner as to bring some natural agency or natural power to bear upon and effect the object which I desire to effect, and that I do by means of an apparatus constructed so as to bring into action that dynamic power. . . . Now here the refrigerating effect of the air upon the sides of the tank was not a thing for which a patent could be obtained; but an apparatus so constructed as to bring into operation that particular property of the external atmospheric air, so as to produce a most useful effect, constitutes an invention to which the merit attaches of novelty, and for which a patent may be taken out." (*L. Rep.*, 5 *H. L.* 225.)

(v) *GOSNELL v. BISHOP*. C. A. [1888]

Patent for improvements in stretchers for trousers held good. Bowen, L.J.: "Where there has been for some time a long unsatisfied demand, and then suddenly an article springs into existence and satisfies it, the length of time during which the demand has remained uncomplied with is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle that otherwise would seem, from the mere existence of the long unsatisfied demand, to have existed somewhere or in some shape. But it may be that the demand itself is quite new, and that the novelty of the demand has produced immediately, and without any operation of ingenuity, an obvious article to satisfy it." (5 *O. R.* 151, at p. 158.)

(w) *THOMSON v. BATTY*. [1889]

The partially filling a bowl with viscous fluid for the purpose of steadying a compass card might by itself properly be subject-matter for a patent. (6 *O. R.* 96.)

(w\*) *VORWERK & SONS v. EVANS*. C. A. [1890]

Kekewich, J.: "In examining any subject-matter of patent you must regard it with reference either to the thing that produces it or the thing which it produces. You must regard it either as a machine that will produce some work or you must regard it as the production of some machine." (7 *O. R.* 176, at p. 171.) Doubted by the Court of Appeal, because if there is a new thing produced and that is useful and complies with other requirements there may be a good patent for that. (7 *O. R.* 265.)

#### *Combination.*

(x) *BOULTON v. BULL*. [1795]

Buller, J., said: "Mechanical and chemical discoveries all come within the description of manufactures; and it is no ob-

jection to either of them that the articles of which they are composed were known and were in use before, provided the compound article, which is the subject of the invention, is new." (2 *H. Bl.* 487.)

(y) *HUDDART v. GRIMSHAW.* N. P. [1803]

Lord Ellenborough: "I suppose it will not now be disputed that a new combination of old materials, so as to produce a new effect, may be the subject of a patent." (*Dav. P. C.* 267.)

(z) *HILL v. THOMPSON.* Ch. [1817]

Lord Eldon: "There may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials." (1 *Web. P. C.* 237.)

(a) *BRUNTON v. HAWKES.* [1821]

A machine, each part of which was in use before, but in which the combination of the different parts is new, and a new result produced, is good subject-matter for a patent. (4 *B. & Ald.* 550.)

(b) *LEWIS v. DAVIS.* N. P. [1829]

The shearing of cloth from list to list by shears, and the shearing it from end to end by means of rotary cutters were known and in use before the date of the patent. The patentee constructed a machine to shear from list to list by means of rotary cutters, and this was held to be a new manufacture within the statute of James, and a sufficient invention to sustain a patent. (3 *Car. & P.* 502; 1 *Web. P. C.* 488; 1 *Carp. P. C.* 471.)

(c) *SAUNDERS v. ASTON.* [1832]

Patent for "certain improvements in constructing or making buttons." The specification stated the improvements to consist in the substitution of a flexible material for metal shanks on buttons. It then described the modes in which this material might be fixed to the button. Several of these modes were old, but one method, which consisted in the use of a metal collet or ring with teeth, was new. Littledale, J., agreeing with the rest of the Court, said: "Neither the button nor the flexible shaft was new, and they did not, by merely being put together, constitute such an invention as could support this patent. It is contended that the operation of the collet, under the present patent, is new; but that is not stated in the specification as the object of the invention, and it is in fact only one mode of carrying it into effect; it appears on the plaintiff's case that there were other ways of producing the same result." (3 *B. & Ad.* 881; 1 *L. J., K. B.* 265; 1 *Carp. P. C.* 510.)

(d) *CARPENTER v. SMITH.* N. P. [1841]

There may be a valid patent for a new and improved combination of mechanical parts which are already known in combination. (1 *Web. P. C.* 538.)

(e) CRANE v. PRICE. [1842]

Patent for "an improvement in the manufacture of iron." The invention consisted in the application of anthracite, or stone coal, combined with a hot air blast, in the smelting or manufacture of iron from ironstone, mine, or ore. The patentee in his claim said: "I do not claim the using of a hot air blast separately in the smelting and manufacture of iron as of my invention, when uncombined with the application of anthracite, or stone coal, and culm; nor do I claim the application of anthracite, or stone coal, in the manufacture or smelting of iron, when uncombined with the using of hot air blast. But what I do claim as my invention is, the application of anthracite, or stone coal, and culm, combined with the using of hot air blast in the smelting and manufacture of iron, from ironstone, mine, or ore, as above described." The application of a hot blast to the smelting of iron had previously been patented by Neilson. Tindal, C.J., in delivering the judgment of the Court said, the question is, "whether, admitting the using of the hot air blast to have been known before in the manufacture of iron with bituminous coal, and the use of anthracite, or stone coal, to have been known before in the manufacture of iron with cold blast, but that the combination of the two together (the hot blast and the anthracite) were not known to be combined before in the manufacture of iron, whether such combination can be the subject of a patent.

"We are of opinion, that if the result produced by such a combination is either a new article, or a better article, or a cheaper article to the public, than that produced before by the old method, that such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent. Such an assumed state of facts falls clearly within the principle exemplified by Abbott, C.J., where he is determining what is or what is not the subject of a patent, namely, it may, perhaps, extend to a new process to be carried on by known implements or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or a better or more useful kind. And it falls, also, within the doctrine laid down by Lord Eldon, that there may be a valid patent for a new combination of materials previously in use for the same purpose, or even for a new method of applying such materials. But the specification must clearly express that it is in respect of such new combination or application.

"There are numerous instances of patents which have been granted, where the invention consisted in no more than in the use of things already known, and acting with them in a manner already known, and producing effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public." Referring to the validity of a patent for an improvement on a prior patent, his lordship said, the defendants contend "that the taking out of a patent for an invention, which invention cannot be used or enjoyed by the public except by means of the former invention of another person, which former invention is itself

the subject-matter of a patent still in force, is void by law. Undoubtedly, if the second patent claims, as part of the invention described in it, that which had been the subject-matter of a patent then in force, it would be void, on the double ground that it claimed that which was not new (which indeed would equally be the case if the former patent had expired), and also that it would be an infringement of, and inconsistent with, a former grant of the king still in force, which latter consideration alone would make a new grant void. But in this case there is an express disclaimer of any part of the invention extending to the use of the hot air blast which was covered by Neilson's patent, the specification describing that the application of the hot air blast was well understood and extensively applied in many places where ordinary fuel is employed. The validity, therefore, of the plaintiff's patent cannot be impeached on either of the grounds above adverted to. . . . Now it is further argued that, in point of law, no patent can be taken out which includes the subject-matter of a patent still running or in force. No authority was cited to support this proposition. . . . And upon reason and principle there appears to be no objection. The new patent, after the expiration of the old one, will be free from every objection, and whilst the former exists, the new patent can be legally used by the public by procuring a licence from Neilson, or by purchasing the apparatus from him or some of his agents; and the probability of the refusal of a licence to anyone applying for it, is so extremely remote, that it cannot enter into consideration as a ground of legal objection." The patent was held to be good. (4 *M. & G.* 580; 5 *Scott, N. R.* 338; 12 *L. J., C. P.* 81; 1 *Web. P. C.* 393; 2 *Carp. P. C.* 669.)

(f) *ALLEN v. RAWSON.* [1845]

Where the use of soap and water in the process of felting, instead of acidulated water, was known, and the use of rollers was also known, it was held that a patent for the application of soap and water in combination with rollers, was a good subject-matter for a patent. (1 *C. B.* 551.)

(g) *BOVILL v. KEYWORTH.* [1857]

The plaintiff's invention consisted in exhausting the air from the cases of millstones, combined with the application of a blast to the grinding surfaces. The patentee specifically disclaimed the precise details of carrying out his invention as described in his specification. It was proved by the defendants that both the blast and the exhaust had previously been used separately in working mills. The Court *Held*, that "the whole of the plaintiff's process, if the combination be new, is certainly the subject of a patent." (7 *E. & B.* 725; 3 *Jur., N. S.* 817.)

(h) *LISTER v. LEATHER.* [1858]

Lord Campbell, C.J., in delivering the judgment of the Court of Queen's Bench, said: "If the combination, the subject of the patent, was new and useful, though each of the parts which entered

into it were old, still the combination might be the subject of a valid patent. . . . A patent for a combination is not a claim that each part thereof is new. On the contrary, each part may be old, and yet a new and useful combination of such old parts may be valid, as has been often decided. . . . A valid patent for an entire combination for a process gives protection to each part thereof that is new and material for that process, without any express claim of particular parts, and notwithstanding that parts of the combination are old." (8 *E. & B.* 1004; affirmed in Exchequer Chamber, 8 *E. & B.* 1031; 27 *L. J.*, *Q. B.* 295; 4 *Jur.*, *N. S.* 947.)

(i) *POTTER v. PARR.* [1860]

In an action for infringement of a patent for improvements in spinning machinery, it appeared that the patentee had in a previous patent described a conical drum, which had turned out to be in parts defective. The patentee alleged that he had cured these defects, by employing a radiating apparatus combined with an improved system of curves, and contended that he might take out a patent for the radiating apparatus, which he had in this way made perfect:—*Held*, that as he had already made known the principal part of the machine, he could not take out a fresh patent for a combination, including that and the improvements, without expressly stating that the patent was for a new combination only. (2 *B. & S.* 216 (n).)

(j) *MORTON v. MIDDLETON.* [1863]

Lord President: "There can be no doubt as to the general law, that there may be a new arrangement and combination of things that were formerly in use, but which are to be so arranged in a novel way as to produce either a new effect or a better effect than before." (1 *Cr. S.*, 3rd Series, 721.)

(j\*) *FOXWELL v. BOSTOCK.* [1864]

Lord Westbury said: "If a combination of machinery for effecting certain results has previously existed, and is well known, and an improvement is afterwards discovered, consisting, for example, of the introduction of some new parts, or an altered arrangement in some particulars of the existing constituent parts of the machine, an improved arrangement or improved combination may be patented." (12 *W. R.* 725.)

(k) *SPENCER v. JACK.* [1864]

The jury having found that the invention, which was a combination of things previously well known, was "a substantial improvement":—*Held*, that the question whether it could be the subject of a patent must be answered in the affirmative. (11 *L. T. Rep.*, *N. S.* 242.)

(l) *DANGERFIELD v. JONES.* [1865]

Patent for "an improved mode of, and apparatus for, bending wood for the handles of walking sticks, umbrella and parasol

sticks, and other purposes." The patentee, in his specification, said, that after softening the end of the stick which is to be bent, by placing it in moist sand, with the application of heat when necessary, it is to be held securely in the jaws of a clamp or vice, and the extremity of the stick then drawn round or bent over a tube or hollow mandrel, provided with an annular half-round recess. Inside this tube or hollow mandrel a gas jet or burner is introduced for imparting heat to the tube or mandrel, which heat is transmitted to the stick from its being drawn in close contact therewith. The stick is kept in this position by means of a band of steel, which is bent over the stick to retain it in a bent position. The patentee claimed "the application of a flame of gas or other combustible fluid or liquid as described, for softening the fibres of the wood while being bent in combination with a clamping apparatus for securing the wood in its bent form until the fibres are set, so that the hook may remain permanently as herein set forth":—*Held*, that this was a proper subject for a patent. Vice-Chancellor Wood, in the course of his judgment, said: "If, having a particular purpose in view, you take the general principles of mechanics, and apply one or other of them to a manufacture to which it has never been before applied, that is a sufficient ground for taking out a patent, provided that the Court sees that that which has been invented is new, desirable, and for the public benefit." (13 *L. T. Rep.*, *N. S.* 142.)

(m) *WRIGHT v. HITCHCOCK*. [1870]

The plaintiff obtained a patent "for the invention of improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." His specification described the invention as relating to a peculiar manufacture of frills or ruffles, and a peculiar kind of mechanism to be applied to a sewing machine for producing the same, by which the fabric was folded, or crimped by a reciprocating knife, and the folds stitched by the sewing machine, so as to be kept permanently in their place. Anterior to the date of the patent, frills or ruffles were made by hand, the materials being folded by a knife, and then sewn. The Court *Held* the plaintiff's invention to be a good subject-matter of a patent. (*L. Rep.*, 5 *Ex.* 37; 39 *L. J.*, *Ex.* 97.)

(n) *MURRAY v. CLAYTON*. [1872]

Bacon, V.-C.: "A combination of things not in themselves new, but which combination is perfectly new in the form in which the inventor has cast it, and producing new and more beneficial results, may be the subject of a patent. (*Huddart v. Grimshaw*, *Web. P. C.* 85.) But I am aware of no case in which it has been held that the mere arrangement of common elementary mechanical materials, and the construction by means of such arrangement of a machine which produces no other result than that which had been previously accomplished by other mechanical arrangements and constructions, would support a patent. If it were so, there would be no protection to the public or to earlier patents against the inge-

nunity of any artizan who might have the skill to arrange the old mechanism in a new shape, and thereby to appropriate to himself the fruits of previous inventors in the proper sense of that term, so that the privilege and reward which the law only concedes to art and wit and invention might be bestowed upon mere skill in handicraft." (*L. R.*, 7 *Ch.* 577.) James, L.J., in reversing this judgment, said: "I find it very difficult to reconcile this proposition with what has been said by many judges in many cases, and more particularly in the case of *Crane v. Price*. Now, no doubt *Crane v. Price* has been questioned, and if I may be permitted to say so, with all respect to the very powerful tribunal which decided that case, I have never been satisfied with the decision. That, however, was simply because I could not see how the word 'combination' could be properly applied to the introduction of a particular kind of fuel into a machine which had been patented for the use of every kind of fuel in the making of iron; and neither I nor, so far as I am aware, any other judge has ever questioned the principles upon which that case was decided. . . . That being so, I cannot concur with the Vice-Chancellor in saying that the patent of the plaintiff was to be invalidated upon the principle which he has laid down, because, if the evidence is to be believed, what the plaintiff has done is, that he has produced a thing in a more expeditious manner, in a more economical manner, and of a better quality." (*L. R.*, 7 *Ch.* 584; 20 *W. R.* 650.)

(o) *BAMLETT v. PICKSLEY*. [1875]

The plaintiff's patent was for improvements in machines for mowing, by which the cutting-knife might be made to revolve quicker for mowing grass than for cutting corn. The shaft which drove the knife was mounted parallel to the axle of the wheels, and on this axle were mounted toothed-wheels of different diameters. The shaft could be moved longitudinally, so as, by the aid of pinions, to be driven by the large or small wheel as required. An identical arrangement of shaft and wheels had already been used in haymaking for driving the tossing-rakes faster or slower: —*Held*, that this was not a combination, although it was called a combined reaping and mowing machine, but merely an application of a known machine to an analogous purpose. Grove, J.: "*Crane v. Price* has been cavilled at, and can only be upheld on the ground that there a new product was produced of a different class and character. Whether it is supportable on that ground or not some learned judges have doubted" (at p. 43). A patentee cannot make a combination within the meaning of the patent law by calling it a combination. A combination, in point of law, must be a combination producing a new and useful result. (*Griff.* 40.)

(p) *BINNEY v. FELDTMAN*. H. L. [1871-5]

Where the invention claimed was "a packing (for joints of engines) composed of dry powdered substances, combined with braided, twisted, or plaited fibrous material substantially as set forth," it was *Held*, that as the use of fibrous material for packing



was not new, and the use of mineral lubricants for such a purpose was not new, it could not be the subject of a patent to use fibrous strands, or any other fabric combined with mineral lubricant, in the sense of mainly using the two things together. And if the claim is limited by the words "substantially as set forth" to a particular process of manufacture, by which the two materials are combined, the patentee cannot thereby prevent a conjoint use of the two materials together, which will result in the ordinary course of use in producing the same thing which the patentee claims to produce intentionally. (*Griff. p. 49.*)

(q) *HINKS v. SAFETY LIGHTING COMPANY.* M. R. [1876]

It was contended that a patent for a lamp was anticipated by a prior patent for a lamp, the only material difference between the two being that one used a round wick and the other a flat wick. Jessel, M.R.: "On the one hand it was said you can never support a patent by substituting a round wick for a flat wick, as there is no invention in that. On the other hand it was said, Why not? If it is a combination patent, the very essence of a combination patent is that it is a new combination of known parts, and, in fact, very few machines are now invented which contain any new part. As a general rule, every machine invented is made up of parts which are previously known. A new part of a machine is very uncommon indeed; consequently that is an objection which, *per se*, is not of great weight. But, like every combination which is new, it must have merit, and now how is a judge to apportion the merit? I do not know. As far as I can ascertain from the authorities, the merit very much depends on the result produced. Where a slight alteration in a combination turns that which was practically useless before into that which is very useful and very important, judges have considered that, though the invention was small, yet the result was so great as fairly to be the subject of a patent; and, as far as a rough test goes, I know of no better." (4 *Ch. D.* 615.)

(r) *CLARK v. ADIE* (First App.) H. L. [1877]

Lord Blackburn, speaking of the case of *Crane v. Price* (4 *M. & Gr.* 580), said: "That was a case where a hot blast, which had been applied as a means of melting iron by the use of ordinary coal, was first applied to melting iron in Wales by anthracite coal, and thereby produced an enormous benefit, for it utilized the whole of the great Welsh coal-field. In that case there was a considerable difficulty in saying whether the patent was good or not, but it was held to be good. That case has gone as near the extreme end as any decided case has gone; it shows that an old combination, if producing a new and beneficial result, may be the subject of a patent. Whether it is so or not must depend upon the facts of the particular case; and again, whether it is properly described or not depends upon the facts of the particular case. In those cases there is great difficulty in saying how much must be described in the specification, and to what extent the combination must be described." (2 *App. Cas.* 335.)

(s) *SYKES v. HOWARTH.* Fry, J. [1879]

Machines for carding wool, &c., consisted, prior to the invention of the plaintiff, of a series of large cylinders on which smaller cylinders revolved, the last of the series of smaller cylinders termed a "fancy roller," being used to raise the fibre on the surface of the larger roller. The rollers were covered with "cards" (strips of leather thickly studded with short wires). These cards were cleaned by means of a hand-scraper, an objectionable method, inasmuch as from the fact of the person using the scraper having to stand at a side of the machine, and thus being unable to draw the scraper in an exact line with the gates of the cards (passages between the wires), the cards were liable to be injured. The plaintiff obtained a grant of letters patent for improvements in fancy rollers, by the introduction of wide spaces between the cards, which produced an exhaust current of air, and made the rollers operate in their function as fancy rollers. In addition to this, the fancy rollers were applicable and employed for cleaning the other card-covered cylinders:—*Held*, on the principle of *Murray v. Clayton* (*L. R.*, 7 *Ch.* 577), that the improvements were a proper subject-matter for a patent. (12 *Ch. D.* 826.)

(t) *HAYWARD v. HAMILTON.* C. A. [1879–1881]

The plaintiff was the proprietor of a patent for improvements in pavement lights. In his specification he stated that he glazed the frame of the pavement light with glass of a prism-like form underneath, resembling, to some extent, the glasses which are inserted into ships' decks to give light below, but differing entirely in the form and arrangement of the prism, in order that the light might be thrown forward in one direction. The jury found that it was not a new thing to form and arrange a prism so that the light might be thrown forward in one direction, but that it was a new thing to glaze lights as the plaintiff had done:—*Held*, that as the plaintiff had not tried to patent his idea, but had pointed out a combination by which it could be carried into execution, such combination was a proper subject of a patent. Per Brett, L.J.: "A point was raised and discussed, which for a time did seem to me to present a difficulty, namely, whether, although this was new and useful, it could be said to be an invention. . . . I did not recollect of myself any case in which, where a thing had been pronounced to be new and useful, the question of whether it was an invention had been ever discussed, or even left to a jury for instance. It seemed to me, in all previous cases, it had been taken for granted, that if the thing were new and useful, there must have been an invention in order to arrive at a thing that can be so described; and I should say, that in nine hundred and ninety-nine cases out of a thousand, that must be so. I say, if the thing is new and useful, it is impossible to suppose there is not sufficient to make an invention; but I do not think, as a matter of law, that could be predicated as an absolute rule of law; because I think it is possible, although a thing were new

and useful, it might be, under certain circumstances, that there was no invention in it." (*Griff.* 121, at p. 121.) (But see *Blakey v. Latham*, p. 510 (z).)

(u) *REYNOLDS v. AMOS.* [1886]

A patentee claimed, in the manufacture of ensilage, a combination of chains and cross-beams with means for anchoring or securing the chains, by which fodder might be compressed and retained in the compressed state. *Bacon, V.-C.*: "Its novelty is established beyond all doubt; its utility is proved, among many other things, by the defendants themselves who have adopted it; that it is cheaper, the evidence enables me to say. So that if I take what are upon authority the unquestionable requisites necessary to sustain a patent, I find that it is new, . . . that it is better than any other as the witnesses have proved, and that it is beyond all question very much cheaper. . . . There is no novelty in a chain; there is no novelty in pinning a chain so that it cannot shift its position; there is no novelty in shortening the chain by means of a pin; but the man who invented this mode of dealing with the chain for the purpose of manufacturing ensilage, says that he is entitled to a patent, and I have not heard a word of argument nor of authority that should induce me to doubt that that is the plain law." (*Griff.* 201; 3 *O. R.* 215, at p. 219).

(v) *EDISON AND SWAN UNITED ELECTRIC COMPANY v. WOODHOUSE AND RAWSON* (No. 1). *C. A.* [1886]

It is usually true to say that the mere change of size of a part of a combination cannot constitute a new manufacture so as to be good subject-matter; but where a filament was substituted for a rod with the definite purpose of making a physical law subserve the end in view, and the filament produced a result which the rod could not:—*Held*, that the substitution was good subject-matter. The introduction into an old combination of a new shape of one of the old elements of that combination, which invokes a law of nature otherwise left on one side, may be the subject of a patent. (4 *O. R.* 79.)

(w) *MOSELEY v. VICTORIA RUBBER COMPANY.* [1887]

The plaintiff's invention consisted in a new combination of old processes for the production of designs upon waterproof fabrics, and included an application of farina for the purpose of fixing or absorbing colouring matter which was previously unknown. *Held*, to be good subject-matter. (4 *O. R.* 241.)

(x) *ROWCLIFFE v. LONGFORD WIRE COMPANY.* [1887]

In an action for infringement of a patent for improvements in frames for woven or elastic wire-web mattresses, it appeared that the framework claimed was substantially that of the old four-post bedstead, and differed from it only (1) in not having any legs or posts; (2) in having the transverse sliding-piece on the top of the

sides instead of in grooves along the sides; and (3) in having the foot and head raised above instead of being flush with the sides:—*Held*, that the alleged invention was not subject-matter for a patent, and had been anticipated. (4 *O. R.* 281.)

(y) *BOYD v. HORROCKS.* [1888]

The plaintiff's patent was for improvements in machinery for winding, doubling and twisting yarn or thread. *Held*, to be good subject-matter, as being "a new method of adapting in a practical and useful form something well known by itself with something equally well known by itself, but so as in the combination to make something new and useful." (5 *O. R.* 557 at p. 578.) The judgment was reversed on another ground. (6 *O. R.* 162.)

(z) *BLAKEY v. LATHAM.* C. A. [1889]

Per Cotton, L.J.. "We were much pressed with two cases, one of which was *Hayward v. Hamilton*. . . . I doubted about it for a considerable time, and I do not agree with all that the Master of the Rolls says there; but I pointed out that there was invention in that case." See p. 522 (j). (6 *O. R.* 184, at p. 188.)

(a) *EDISON AND SWAN ELECTRIC LIGHT COMPANY v. HOLLAND.* C. A. [1889]

The plaintiffs' second claim was for the combination of a carbon filament within a receiver made entirely of glass, through which the leading wires pass, and from which receiver the air is exhausted for the purposes set forth. The patent had already been before the Court. *Held*, that the questions whether this claim was too wide or was properly subject-matter were questions depending partly on fact, and that it was not too wide and was good subject-matter. (6 *O. R.* 243.)

(b) *THOMSON v. AMERICAN BRAIDED WIRE COMPANY.* H. L. [1889]

In an action for infringement of a patent for improvements in bustles or dress improvers, it appeared that the patentee's bustle was composed of tubular sections of braided wire, the ends of which were secured by clamping as described, and that the bustle was thereby rendered very light, and was a considerable improvement, as evidenced by the public demand. It was shown that bustles had long been made of horsehair, whalebone, and other elastic materials; that prior patents had been granted to Jenkins for pillows and cushions made of braided wire; and to Lake for making pillows, &c., from strands of wire, woven or plaited into the form of a cylinder; and, in the Court of Appeal, further evidence was admitted to show that soft wire had been braided and used in tubular sections for various articles:—*Held*, by the Court of Appeal and the House of Lords (Lords Watson, Herschell, and Macnaghten, Halsbury, L.C., and Fitzgerald, L., diss.), that the invention was good subject-matter for a patent. Herschell, L.: "It is clear that no such bustle had ever been made before the date of the patent, and that as soon as this bustle became known

there was a large demand for it. . . . This is certainly a fact to which some weight may be attributed. Apart from that, however, the mode in which the tube of braided wire is made available as a bustle, by the use of clamps applied and fixed in the manner described, appears to me to be simple and efficient, and not so obvious as to occur to every one contemplating the use of braided wire for the purpose of a bustle. The result is a complete article, light, effective, not likely to get out of order, and capable of being manufactured, and therefore sold cheaply. And I am unable to say, that to produce a new thing combining these qualities, required no invention. . . . If the demand of the public for a particular article of dress be better met by a new combination than it has been by the articles previously in use, and if this new combination, though its component parts be not new, required some exercise of the inventive faculty to produce it, I think it can be protected by a patent, though it may be impossible to say that the invention is important or necessary for the public good." (6 *O. R.* 518, at p. 528.)

(c) *WILLIAMS v. NYE*. C. A. [1890]

In an action for infringement of a patent for an improved mincing machine, it appeared that the plaintiff in his machine had continued the shaft of the screw in Nye's machine and utilised it for the purpose of filling. Nobody had previously succeeded in producing a combined mincing and filling machine. *Held*, that there was not sufficient invention to support a patent. Cotton, L.J.: "It is difficult to express in words with preciseness what is meant by ingenuity and what is meant by invention; but I express my opinion that in order to maintain a patent there must be a substantial exercise of the inventive power or inventive faculty." (7 *O. R.* 62, at p. 67.)

(c\*) *NEWSUM v. MANN*. [1890]

The plaintiff's patent was for improvements in printing machines, the first and second claims being for the combination of certain brackets and an intermediate frame cast together. The invention was alleged to consist in the construction, which gave greater stability, but *held*, that the first and second claims were for the mere casting together of things well known and were not subject-matter, and that therefore the patent was invalid. (7 *O. R.* 307.)

### Process.

(d) *HORNBLOWER v. BOULTON*. [1799]

A patent was granted for a "method of lessening the consumption of steam and fuel in fire-engines." The specification stated that the "method consisted of the following principles" (describing the mode in which those principles were applied to the purposes of the invention):—*Held*, that the invention was the subject of a patent. (8 *T. Rep.* 95; *Dav. P. C.* 221; 1 *Carp. P. C.* 156.) Grose, J.: "I am inclined to think that a patent cannot be

granted for a mere principle; but I think that, although in words the privilege granted is to exercise a method of making or doing anything, yet if that thing is to be made or done by a manufacture, and the mode of making that manufacture is described, it then becomes in effect (by whatever name it may be called) not a patent for a mere principle, but for a manufacture of the thing so made, and not merely for the principle upon which it is made." (8 *T. Rep.* 105.) Lawrence, J., said: "Engine and method mean the same thing, and may be the subject of a patent. 'Method,' properly speaking, is only placing several things and performing several operations in the most convenient order; but it may signify a contrivance or device; so may an engine, and there I think it may answer the word 'method.' So 'principle' may mean a mere elementary truth, but it may also mean constituent parts; and in effect the specification is this: 'the contrivance by which I lessen the consumption of steam consists in the following principles—that is, constituent or elementary parts; a steam vessel, in which the powers of steam are to operate, to be kept as hot as the steam by a case; a distinct vessel to condense the steam; and pumps to draw off such vapour as is likely to impede the motion of the fire-engine,' &c." (*Ib.* 106.)

(a) *HUDDART v. GRIMSHAW.* N. P. [1803]

There may be several patents granted for several methods of obtaining the same object, provided the methods of obtaining that object are not identical. (1 *Web P. C.* 92.)

(b) *HALL v. JARVIS.* N. P. [1822]

The patent was granted for a "method of improving every kind of lace," &c. The invention consisted in causing lace to pass through a flame of gas, in order to singe off the projecting fibres, and the specification described the means by which the invention was to be performed. The patentee claimed the application of the flame of inflammable gas to the purposes described in the specification. It was proved that before the date of the patent, muslin had been passed over rollers of heated iron, and that mits and stockings had been passed through oil and alcohol flames for a similar purpose. It was objected that the mere doing that with the flame of gas which had long before been done by means of other kinds of flame, was not such an invention as to constitute the subject-matter of a patent. The patent was, however, held to be good. (1 *Web. P. C.* 100; 1 *Carp. P. C.* 423.)

(c) *JONES v. PEARCE.* N. P. [1832]

The plaintiff's patent was for "a certain improvement or improvements on wheels for carriages." The patentee, in his specification, said: "I hereby claim as my invention, and declare that my improvement or improvements on wheels for carriages consist in substituting suspending rods made of iron or other suitable metal in lieu of spokes, by which suspending rods I hang or suspend the weight or load from that part of the wheel which happens to be

uppermost, and prevent any support being given to the said weight or load by the rods which happen to be immediately under the axletree." At the trial the defendant's counsel contended that the specification did not confine the claim to any particular mode of constructing wheels on the suspension principle, but expressly claimed the invention of the principle itself. Patteson J., was of opinion that, on the specification taken as a whole, the claim was for the invention of a method of making wheels on the principle of suspension, which method was described in the specification. (1 *Web. P. C.* 122; 1 *Carp. P. C.* 524.)

(d) *RUSSELL v. COWLEY.* [1835]

Before the patent, for the infringement of which the plaintiff sued, iron tubes were made by drawing them through rollers, a mandrel being placed inside the tube so as to form an internal support. The patent in question was granted for a process of manufacturing iron tubes by drawing them through fixed dies or holes without the use of a mandrel. The tubes made by this process were of greater length, were more uniform, and could be manufactured at a cheaper rate than by the old process. The Court held this to be a good subject-matter for a patent. (1 *C., M. & R.* 864; 1 *Web. P. C.* 463; 1 *Carp. P. C.* 557; 16 *Rep. Arts., N. S.* 116.)

(e) *WALTON v. POTTER.* N. P. [1841]

Tindal, C.J.: "There can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose." (1 *Web. P. C.* 590.)

(f) *GIBSON v. BRAND.* [1842]

Tindal, C.J.: "The patent is taken out 'for a new or improved process or manufacture of silk, and silk in combination with certain other fibrous substances;' taken out, therefore, strictly for a process. On the present occasion it is not necessary to go into the question (upon the view I take of this specification), whether a patent can be granted for a process, in the strict and proper sense of that term, or not. Undoubtedly there is a very strong reason to suppose, if the specification is carefully and properly prepared, so as to point out, with great distinctness and minuteness, what the process is, that such a patent may be good in law." (1 *Web. P. C.* 633.) Erskine, J.: "Although it may be true, that a party may have a patent for an improved process, under circumstances which would show that the improvement in the process really amounted to a new invention, and a new manufacture, within the terms

of the Act of Parliament, I think the evidence in this case does not show, that here there has been such an improvement." (*Ib.* 638.)

(g) *HELLIWELL v. DEARMAN.* [About 1842]

The object of the plaintiff's invention was the rendering fabrics waterproof, but at the same time leaving such fabrics pervious to air. Before the plaintiff's patent a solution of alum and soap was made, and the fabric to be rendered waterproof was immersed therein. By this means a waterproof surface was produced on the fabric, but it was not of a lasting nature: it wore off. According to the plaintiff's invention, the fabric was immersed first in a mixture of a solution of alum with some carbonate of lime, and then in a solution of soap. The effect was, that by the first immersion every fibre became impregnated with the alum, the sulphuric acid of the alum being neutralized by the carbonate of lime, and by the second immersion the oily quality rendering it repellant of water was given to every fibre, so that every fibre was rendered waterproof instead of the surface only; but the whole fabric continued pervious to air:—*Held*, that this was such a change in the *modus operandi* as to constitute a new manufacture. (1 *Web. P. C.* 401 (n).)

(h) *STEVENS v. KEATING.* N. P. [1847]

Pollock, C.B.: "The word 'manufacture' is introduced, and all patents must be for a manufacture. The real invention may be not so much for the thing when produced, as for the mode in which it is produced; and its novelty may consist, not so much in its existence as a new substance, as in its being an old substance, but produced by a different process. In one sense, an old substance produced by a new process is a new manufacture; of that there cannot be a doubt; and therefore, although the language of the Act has been said to apply only to manufactures and not to processes, when you come to examine it, either literally or even strictly, it appears to me the expression 'manufacture' is free from objection, because, though an old thing, if made in a new way, the very making of it in a new way makes it a new manufacture. Therefore, although I think this is a patent for the process rather than the product, I think it may be a patent for the product." (2 *Web. P. C.* 182.)

(i) *WALLINGTON v. DALE.* [1852]

Previous to the plaintiff's patent being granted, gelatine was obtained by submitting large pieces of hides to the action of caustic alkali, or by reducing them to pulp in a paper machine, and employing blood to purify the product. The invention claimed consisted in cutting the hides into shavings, thin slices, or films, whereby the use of blood in the process of purification became unnecessary:—*Held*, that the invention was the subject-matter of a patent. (7 *Exch.* 888; 23 *L. J., Ex.* 49.)



## (j) BOOTH v. KENNARD. [1856]

Patent for "improvements in the manufacture of gas." The patentee, in his specification, said: "Hitherto in manufacturing gas from oils, oily or resinous matter, it has been usual to go through the costly process of obtaining the oils, &c., from seeds and other substances, and to use the same in a fluid or semifluid state . . . . Now, my invention consists in the direct use of seeds, leaves, flowers, branches, nuts, fruits, and other substances, and matters containing oil or oily or resinous matter, or other matter useful in the manufacture of vegetable gas. . . . I claim for making gas direct from seeds and matters herein named, instead of making it from oils, resins, and gums, previously extracted from such substances:"—*Held*, that assuming the invention to be new, it was a good subject-matter for a patent. (1 *Hurl. & N.* 527; 26 *L. J., Ex.* 23; 3 *Jur., N. S.* 21.) The patent was afterwards set aside for want of novelty. (2 *Hurl. & N.* 84; 26 *L. J., Ex.* 305.)

## (k) BEWLEY v. HANCOCK. [1856]

Lord Cranworth: "A discovery that the mixture of two or more simple substances, in certain definite proportions, will form a compound substance valuable for medical or other qualities, would afford a good ground for a patent. A discovery of some machinery, whereby such a mixture may be more quickly or more effectually accomplished, might be the foundation of another patent." (6 *De G., M. & G.* 402.)

## (l) BOVILL v. PIMM. [1856]

Where the subject of an invention is not new, any patent taken out for a method of performing the operation is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general phrase. (11 *Exch.* 739.)

## (m) BOVILL v. KEYWORTH. [1857]

If the specification of a patent does not point out the mode by which a patented process is to be performed, so as to accomplish the object in view, it will be a statement of principle only, and the patent will be invalid. (7 *E. & B.* 735.)

## (n) HIGGS v. GOODWIN. [1858]

The invention for which the patent was granted was "treating chemically the collected contents of sewers and drains in cities, towns, and villages, so that the same may be applicable to agricultural and other useful purposes." In the specification the patentee said: "For the purpose of precipitating the animal and vegetable matter contained in the sewage water, I prefer to employ hydrate of lime, commonly termed 'slacked lime.' . . . What I claim as my invention is, the precipitation of animal and

vegetable matter from sewage water by means of the chemical agent hereinbefore described." Lord Campbell, C.J., said: "It seems to me that the invention of the plaintiff is a subject for a patent, as the invention was for producing an article of commercial profit." (*El. Bl. & El.* 529; 5 *Jur.*, *N. S.* 97; 27 *L. J.*, *Q. B.* 421.)

(o) *HILLS v. LONDON GAS LIGHT COMPANY.* [1860]

An invention consisted in the purification of coal gas by employing the hydrated oxides of iron to remove the sulphuretted hydrogen from the gas. On an action for the infringement of a patent for this invention, it was contended by the defendants that this was not the subject of a patent. Baron Bramwell, delivering the judgment of the Court, said: "If a man were to say 'I claim the use of hydrated oxide of iron for the purification of coal gas,' without saying how it is to be applied, it is possible the objection might be well founded; but here the plaintiff says, 'I claim it in the manufacture of gas in the way I have described,' and he shows how it may be used. Therefore this objection fails." (5 *Hurl. & N.* 312; 29 *L. J.*, *Ex.* 409.)

(p) *YOUNG v. FERNIE.* [1864]

Vice-Chancellor Sir John Stuart said: "What the law looks to is the inventor and discoverer who finds out and introduces a manufacture which supplies the market for useful and economical purposes with an article which was previously little more than the ornament of a museum. It has been established to my satisfaction, by the evidence in this cause, that the plaintiff Young is an inventor of this class, and that his patent is entitled to the protection of the law. I find that he has ascertained, by a course of laborious experiments, a particular class of materials among many, and a particular process among many, which has enabled him to create and introduce to the public a useful manufacture, which amply supplies the market with that which, until the use of the materials and process, and temperature indicated by him, had never been supplied for commercial purposes. At the date of his patent something remained to be ascertained, which was necessary for the useful application of the chemical discovery of paraffine, and paraffine oils. This brings it within the principle stated by the Lord Chancellor in the late case of *Hills v. Evans*. The manufacture, with the materials and process indicated by him, according to the sense in which I understand the word 'manufacture' to be used in the statute, was a new manufacture, not in use at the date of his patent." (4 *Giff.* 611; 10 *Jur.*, *N. S.* 936; 12 *W. R.* 903; 10 *L. T. Rep.*, *N. S.* 865.)

(q) *CURTIS v. PLATT.* [1864]

Where an invention consists of the discovery of particular means for attaining a result, which result is already perfectly well known, the invention is only for the means; and the invention of one set of particular means does not interfere with the invention of

another set of means to the same end, provided that the two sets of means are distinct, and the latter does not involve a colourable imitation of the former, or an incorporation of the former, with additions. (11 *L. T. Rep.*, *N. S.* 245; 3 *Ch. D.* 138 (n).)

(r) *NEWALL v. ELLIOTT.* [1864]

The plaintiff obtained a patent for "improvements in apparatus employed in laying down submarine electric telegraph wires," which he effected by a combination of a wire or cable round a cone of supports, placed cylindrically outside the coil, and the use of rings in combination with them:—*Held*, to be a good subject for a patent. (10 *Jur.*, *N. S.* 954; 13 *W. R.* 11; 10 *L. T. Rep.*, *N. S.* 792.)

Bramwell, B., said: "Two other matters remain. One is, the point that was pressed by Mr. Cleasby, but which I confess I have considerable difficulty in understanding, that this is not the subject of a patent, because the thing is not prepared and vendible—because, for the convenience of buyer and seller, instead of being ready made and afterwards fitted up in the ship, it is fitted into the ship by the owner of the ship, or the user of the ship, when he uses it. I confess I am unable to understand that. It seems to me to be an argument equally good to say that you could not have a patent for a smoke-jack, because the size of the smoke-jack depends upon the size of the chimney, and because it is more convenient that it should be put up by a country smith." (10 *Jur.*, *N. S.* 959.)

(s) *SIMPSON v. HOLLIDAY.* H. L. [1866]

Patent for "improvements in the preparation of red and purple dyes." The specification thus declares the nature of the invention: "I mix aniline with dry arsenic acid, and allow the mixture to stand for some time; or I accelerate the operation by heating it to, or near to, its boiling point, until it assumes a rich purple colour." The patentee claimed "the manufacture or preparation of red and purple dyes, by treating aniline dyes with arsenic acid, as herein-before described." Chelmsford, L.C., said: "There is nothing upon the face of the specification to show that the invention described is not in every part of it the subject of a patent." (*L. R.*, 1 *H. L.* 315; 35 *L. J.*, *Ch.* 811.)

(t) *BAILEY v. ROBERTON.* H. L. [1878]

A patent may be obtained for the use of a solution of one or more chemical substances for a particular purpose, without confining the claim to any particular mode of use or application. (*Per* Lord Cairns, L.C., 3 *App. Cas.* 1064; and *per* Lord Blackburn, *Ib.* 1077.)

(u) *BADISCHE ANILIN UND SODA FABRIK v. LEVINSTEIN.* H. L. [1887]

Where a patent is taken out for a process for arriving at a known result, any other person may take out a patent for another process,

or may use another process, without any infringement of the first patent. But where a patent is taken out for a new result, and there is one process in the patent which is effectual for the purpose of arriving at that new result at the time when the patent is taken out, the patentee is entitled to protection against all other processes for the same result. It is no objection to a patent to say that the inventor only completed by one step the route to which chemical discoveries had been tending without his aid. (24 *Ch. D.* 171; 12 *App. C.* 710.)

(v) *BADISCHE ANILIN UND SODA FABRIK v. DAWSON.* [1889]

In an action for infringement of a patent for the preparation of yellow colouring matters soluble in water and suitable for dyes, it was shown that dinitronaphthol, which was known as Manchester yellow, had long been in use, but that it was not very soluble in water. In trying to correct this and other defects the patentee discovered that by treating alpha naphthol with additional sulphuric acid, an acid was obtained which, when treated with nitric acid, retained one or more of its sulpho groups. This product was completely new, and no one had ever discovered before how to procure a sulpho acid of alpha naphthol which kept one or more of its sulpho groups under the action of nitric acid. The mode of preparation was also new, and it was *held*, by Charles, J., that the mode of preparation and production was just as much subject-matter of a patent as the production of the sulpho acids of oxyazonaphthaline, which had already been held to be good subject-matter. (6 *O. R.* 387.)

*Addition to a known Machine or Process.*

(w) *MORRIS v. BRANSON.* N. P. [1776]

An addition made to an old machine is a good subject-matter for a patent. If it were the law that there could be no patent for an addition, it would go to repeal almost every patent that was ever granted. (*Bull. N. P.* 76; 1 *Carp. P. C.* 30; 1 *Web. P. C.* 51.)

(x) *R. v. ARKWRIGHT.* *Sci. Fac.* [1785]

Buller, J., in addressing the jury, said: "In the case of an invention, many parts of a machine may have been known before, yet if there be anything material and new, which is an improvement of the trade, that will be sufficient to support a patent; but whether it must be for the new addition only, or for the whole machine, would be another question." (1 *Web. P. C.* 71.)

(y) *BOULTON v. BULL.* [1795]

Buller, J., said: "That a patent for an addition or improvement may be maintained, is a point which has never been directly decided; and *Bircot's case*, 3 Inst. 184, is an express authority against it, which case was decided in the Exchequer Chamber. What were the particular facts of that case we are not informed, and there seems to me to be more quaintness than solidity in the

reason assigned, which is, that it was to put but a new button to an old coat, and it is much easier to add than to invent. If the button were new, I do not feel the weight of the objection that the coat on which the button was to be put, was old. But in truth, arts and sciences at that period were at so low an ebb, in comparison with that point to which they have been since advanced, and the effect and utility of improvements so little known, that I do not think that case ought to preclude the question. In later times, whenever the point has arisen, the inclination of the Court has been in favour of the patent for the improvement, and the parties have acquiesced, where the objection might have been brought directly before the Court. In *Morris v. Branson*, which was tried at the sittings after Easter term 1776, the patent was for making oilet holes, or net-work in silk, thread, cotton or worsted; and the defendant objected that it was not a new invention, it being only an addition to the old stocking-frame. Lord Mansfield said: 'After one of the former trials on this patent, I received a very sensible letter from one of the gentlemen who was upon the jury, on the subject whether on principles of public policy, there could be a patent for an addition only. I paid great attention to it, and mentioned it to all the judges. If the general point of law, viz., that there can be no patent for an addition, be with the defendant, that is open upon the record, and he may move in arrest of judgment. But that objection would go to repeal almost every patent that was ever granted.' There was a verdict for the plaintiff, with 500*l.* damages, and no motion was made in arrest of judgment. Though his lordship did not mention what were the opinions of the judges, or give any direct opinion himself, yet we may safely collect that he thought, on great consideration, the patent was good, and the defendant's counsel, though they had made the objection at the trial, did not afterwards persist in it. Since that time, it has been the generally received opinion in Westminster Hall, that a patent for an addition is good. But then it must be for the addition only, and not for the old machine too. In *Jessop's case*, as quoted by my brother Adair, the patent was held to be void because it extended to the whole watch, and the invention was of a particular movement only." (2 *H. Bl.* 489.)

(z) *HORNBLOWER v. BOULTON.* [1799]

Grose, J.: "A doubt is entertained, whether there can be a patent for an addition to an old manufacture. This doubt rests altogether upon *Bircot's case*, 3 Inst. 184; and if that were to be considered as law at this day, it would set aside many patents for very ingenious inventions, in cases where the additions to manufactures before existing are much more valuable than the original manufactures themselves. I shall content myself with referring to what Lord Chief Justice Eyre said in this cause, in the Court of Common Pleas, in answer to this passage, and to the case of *Morris v. Branson*, cited by my Brother Buller upon the same point. If indeed a patent could not be granted for an addition, it would be depriving the public of one of the best benefits of the statute of

James. Lord Coke's opinion, therefore, seems to have been formed without due consideration ; and modern experience shows that it is not well founded." (8 *T. Rep.* 104 ; *Dav. P. C.* 233.)

(a) *Ex parte Fox.* [1812]

The petitioners having applied for a patent in respect of certain improvements in steam-engines, a caveat was entered under an existing patent, from which it was alleged the new patent was borrowed, and with which it would interfere. The affidavit of an engineer was put in, stating that they were not the same, nor in any respect resembling each other.

Lord Chancellor Eldon said : " If the petitioners have invented certain improvements upon an engine for which a patent has been granted, and those improvements could not be used without the original engine, at the end of fourteen years the petitioners could make use of a patent taken out under their improvements, though before that period expired they would have no right to make use of the other's substratum. At the end of that time, the public has a choice between the patents. My present opinion is, that this patent must go." Patent granted. (1 *V. & B.* 67 ; 1 *Web. P. C.* 431.)

(b) *LISTER v. LEATHER.* [1857]

Lord Campbell, C.J., said : " The second argument was that, if a subsequent patent for a combination includes a part of an invention already protected by patent, it infringes on the property of another, and so is a violation of his right, and ought to be held illegal on account of his interest. The answer is that the patent for an improvement on an invention already the subject of a patent, if confined to the improvement, is not an infringement of the former patent. The use of the improvement with the former invention, during the existence of the former patent, without licence, would be an infringement ; but, with licence, that also would be lawful, as is in constant experience. Indeed the objection was carried to the extent that a patent for an improvement on a patent invention of the same patentee would be void ; but this rests only on the assumption that the improvement cannot be distinguished from the invention on which it is made. The assertion, that all patents for improvements on existing patents must be void, is obviously untenable." (8 *El. & B.* 1017.)

(c) *RALSTON v. SMITH.* H. L. [1865]

The word " manufacture " comprehends a new process or an improvement of an old process. (11 *H. L. Cas.* 223 ; 20 *Com. B.*, *N. S.* 28 ; 35 *L. J.*, *C. P.* 49 ; 13 *L. T. Rep.*, *N. S.* 1.)

(d) *FOX v. DELLESTABLE.* [1866]

Malins, V.-C. : " No doubt a man may make an invention which is partly covered by an existing patent, but he cannot use it with-

out the licence of the patentee. He may wait for the expiration of the patent, and take out one himself if his invention be novel, and that patent will be valid." (15 *W. R.* 195.)

(e) *EADES v. STARBUCK WAGON COMPANY.* [1881]

Eades was owner of a patent for an invention described as being a method of making the body of a tramcar so as to swivel upon the underframe or carriage. There was an existing patent for the same purpose from which Eades' patent differed only in the addition of a lengthening of the truck and the addition of two extra segmental circles for the purpose of better supporting the car:—*Held*, that these additions did not constitute such an invention as to entitle the plaintiff to a patent. (*W. N.* 1881, 160.)

(f) *JENSEN v. SMITH.* [1885]

The question being whether there is sufficient invention in the difference between the plaintiff's machine and the alleged anticipation to be the subject of a proper patent, the fair way to try that question is, supposing the plaintiff to have been first, and that some one had then made the machine now alleged to be an anticipation, would the plaintiff have submitted to that, or would he not have said that it was an infringement of his patent? (*Griff.* 136; 2 *O. R.* 249.)

(f\*) *PHILPOTT v. HANBURY.* [1885]

The plaintiff's patent was for improvements in apparatus for use in drafting patterns for dresses:—*Held*, that as patents already existed by which you could supplement measurements by applying curves, you could not get a valid fresh patent by putting new curves or slightly changed curves to the measurements. (2 *O. R.* 33.)

(g) *UNITED HORSESHOE AND NAIL COMPANY v. SWEDISH HORSENAIL COMPANY.* [1888]

The substitution of a pivot for a hinge in connection with a movable plate for the conductor of a finishing machine for nails is not good subject-matter. (6 *O. R.* 1.)

(h) *COLE v. SAQUI.* C. A. [1888]

The introduction into an automaton toy of a free top spun in a cup as the motor in place of a top spun on a fixed bearing is merely the substitution of one known mechanical equivalent for another, and is not patentable. (6 *O. R.* 41.)

(i) *HERBURGER SCHWANDER ET CIE v. SQUIRE.* C. A. [1889]

A method of modifying the action of a lever in pianoforte actions by using an arm at right angles or nearly so, and placing the centre of the damper at the end of the arm is not good subject-matter. (6 *O. R.* 194.)

(j) *BLAKEY v. LATHAM AND COMPANY.* C. A. [1889]

The plaintiff claimed an improved heel plate properly shaped to fit the heel of a boot or shoe, and formed or provided with pegs, spikes, or teeth, whereby it is secured on the heel as described. The invention was said to consist in making the spikes solid with the plate, whereas formerly holes were made in the plate and spikes driven through. Smaller plates called clinkers with two prongs solidly attached had long been known and used to protect the toes of boots. *Held*, by the Court of Appeal that the patent was bad for want of subject-matter. Cotton, L.J.: "We were much pressed with *Hayward v. Hamilton*. I doubted about it for a considerable time, and I do not agree with all that the Master of the Rolls says there, but there really was invention in that case." (6 O. R. 184.)

(k) *SLAZENGER v. FELTHAM.* C. A. [1889]

Kekewich, J., following North, J., in *Moss v. Malings* had held that a patent for making grooves down the handles of lawn tennis racquets and adding a knob to make an enlargement at the end was good so far as subject-matter was concerned:—*Held*, by the Court of Appeal, that it was merely a roughing of the handle similar to the grooves made on the stock of a gun, or the twine on a cricket bat, and the knob at the end of the handle of a hammer, and was not the subject-matter of a patent. (5 T. L. R. 364; 6 O. R. 232.)

*Application of a known Machine, Process or Material to a New Purpose.*(l) *HARTLEY'S CASE.*

A method of disposing plates of iron so as to produce a useful effect, viz., to secure buildings from fire, is a good subject-matter, (2 H. Bl. 493.)

(m) *MACINTOSH v. EVERINGTON.*

A claim for the application of indiarubber, in a state of solution, as a cement between two fabrics to make a waterproof covering is good, notwithstanding the application of other substances, and of indiarubber in other states, to the same purpose. (6 Rep. Arts, N. S. 317, 365.)

(n) *BRUNTON v. HAWKES.* [1821]

Patent for improvements in ships' anchors, &c. Abbott, C.J., in speaking of the anchors, says: "Formerly three pieces were united together, the plaintiff unites only two; and, if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent." (4 B. & Ald. 550.)

(o) *LOSH v. HAGUE.* N. P. [1838]

There is a material difference between applying a new contrivance to an old object, and an old contrivance to a new object. (1 Web. P. C. 207.)



(p) *KAY v. MARSHALL*. H. L. [1841]

Lord Cottenham, L.C., said, in the House of Lords; "If he (the patentee) has discovered any means of using the machine, which the world had not known before the benefit of, that he has a right to secure to himself by means of a patent; but if this mode (described in the specification) of using the spinning machine was known before, then the plaintiff cannot deprive them of having the benefit of that which they enjoyed before." (2 *Web. P. C.* 82.)

(q) *WALTON v. POTTER*. [1841]

The adaptation of a substance of known properties to a particular purpose may be the subject of a patent. An invention of improvements in cards for carding wool, cotton, silk and other fibrous substances, and for raising the pile of woollen and other cloths by the application and adaptation of caoutchouc or india-rubber, as a substitute for the fillets or sheets of leather, is patentable.

Coltman, J., said; "It appears to me that it is a very useful application and adaptation of a substance, the properties and qualities of which for the purpose had never been known before, and therefore that it was properly the subject of a patent." (4 *Scott's N. R.* 91; 3 *M. & G.* 411; 1 *Web. P. C.* 597.)

(r) *MUNTZ v. FOSTER*. N. P. [1844]

Action for the infringement of a patent, granted to the plaintiff in 1832, for "an improved manufacture of metal plates for sheathing the bottoms of ships or other such vessels." The defendants pleaded (*inter alia*) want of novelty in the invention. Tindal, C.J., "I look upon the invention to consist in this, that he has by an experiment ascertained that a certain mixture of the alloy of zinc with copper will have the effect of producing a better sheathing, by reason and by means of its oxydizing just in sufficient quantity; that is, not too much, so as to wear away and impair the sheathing, and render the vessel unsafe, but enough at the same time to keep, by its wearing, the bottom of the vessel clean from those impurities which before attached to it. That I consider to be the meaning of the patent, and the object with which it was taken out. And I cannot think, as at present advised, that if it was shown (as possibly it may be), that sheets had been made of metal before, in the same proportions which he has pointed out; that if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground. . . . When I come to that part of the case in which they (the defendants) seek to show this is not so (a proper ground of a patent), because these metal plates have been invented before—that is, persons have used them before—in my judgment it will not go far enough, unless they can show there has been some application of them before to this very useful purpose." (2 *Web. P. C.* 103.)

(s) *POW v. TAUNTON.* [1845]

Patent for the invention of a nipping lever for causing the rotation of wheels, shafts or cylinders, under certain circumstances. The specification claimed as the invention "the nipping lever, with its tusk and sliding box, applied to a rimmed wheel, or to a rimmed flange, for the purpose of causing the same to rotate or move together with any shaft, cylinder, or other suitable machinery which may be attached thereto." The nipping lever was not new, but the application of it by means of the sliding box was new. Denman, C.J., said: "As the plaintiff did not claim the invention of the nipping lever, but only the application of it to a subject-matter, to which it had not been applied before, it was contended, for the defendant, that the mere application of a known instrument to a new purpose will not support a patent, unless the means or method of the application is also new. The application of a nipping lever to the surface of a wheel, for the purpose of making it revolve, may be new, but the mere novelty of the application is not enough; it must also appear that the means, essential for carrying the application into effect, are new also. In the present case, the means for applying the old invention to the new purpose are the sliding boxes; and, if they are essential to the application, and novel as means for the purpose, the patent may be supported." (9 *Jur.* 1056.)

(t) *REG. v. CUTLER.* N. P. [1847]

*Scire facias* to repeal letters patent granted to the defendant for "Improvements in the construction of the tubular flues of steam boilers." The specification described two methods of welding iron tubes, and a method of making iron tubes coated with copper, brass, &c. The patentee after claiming the two methods, described in the specification, of welding iron tubes, and disclaiming the method of coating iron tubes with copper, &c., proceeded thus: "Thirdly: I claim the application of either iron or steel tubes, when coated with copper, brass, or other alloys of copper, in the construction of tubular flues for steam boilers. And, fourthly: I claim, in the construction of tubular flues of steam boilers, the application of welded iron or steel tubes, which have been drawn through a circular hole or die, or between rollers, and which have been drawn over a mandrel." Among other suggestions of grounds for the repeal of the patent, it was contended for the Crown that the supposed invention described in these claims, was not a principle of working or making any manner of new manufacture. Lord Denman, C.J., said: "With regard to the third and fourth claims, in which the defendant Cutler claims the application of tubes in the construction of tubular flues, it appears to me that he has no right to take out a patent for the mere application of particular things to any particular purpose. If he had made a new combination, that might have been a new discovery, and a proper subject for a patent; but I think Lord Abinger's illustration is a striking

one, and applicable to the present case. 'It is like sweeping a carpet of a new manufacture with an old broom.' If he had introduced a new article which required the application of a new principle to the production of it, it might have formed a subject of a patent; but the mere application of a thing which existed before does not appear to me to be a subject for a patent. And, in general terms, I think that the application of an article to produce any particular result, the party having no claim either to the mode of producing the article or to the mode of applying it for attaining that result, forms no ground for a patent. It appears from the specification, and indeed it is admitted by the defendants, that the coated tubes mentioned in the specification are not new; and I think, therefore, that the third part of the invention which is claimed in this specification cannot be made the subject of a patent. It seems to me, also, that the same objection applies to the fourth part—nothing more is claimed than the mere application of the tubes." At a new trial, which was granted on another point, Wightman, J., said: "I entertain a strong opinion on this question, as to whether a mere application can be made the subject of a patent; for when once you have got a material, you may apply it as you may think fit." (*Macrory*, P. C. 124; 3 C. & K. 215; 14 Q. B. 372, (n).)

(u) *STEINER v. HEALD*. [1851]

Prior to the date of the plaintiff's patent, granted to him in 1843, madder dye had been obtained from fresh madder by the application of hot water, but there still remained in the dye-vats a residuum, called "spent madder," which was known to contain some colouring matter, but which had never been extracted from it, and the "spent madder" was consequently thrown away as useless. Some time prior to the plaintiff's patent a process was discovered, which, by the application of hot water and acid to fresh madder, produced a dye called garancine, which possessed different properties to the old madder dye. This process extracted the whole colouring matter from the fresh madder. The plaintiff, by his patent, claimed the application of this process to "spent madder," whereby he obtained garancine. And the "spent madder" thereby became of much value:—*Held*, that, as "spent madder" might be in its nature and properties the same as or different from "fresh madder," it did not follow, as matter of law, that the plaintiff's patent was void; but that it was a question of fact for the jury, whether the plaintiff's invention was a new manufacture of garancine. (6 *Exch.* 607; 17 *Jur.* 875; 20 *L. J., Exch.*, 410.)

(v) *BUSH v. FOX*. H. L. [1852—1856]

Patent for "Improvements in the means of, and in the apparatus for, building and working under water." The patentee, in his specification, says: "My invention relates to means and apparatus for working under water, in order to produce excavations and building foundations of lighthouses, piers, jetties, and other structures under water." And the patentee continued:

“What I claim is, the mode of constructing the interior of a caisson, in such manner that the workpeople may be supplied with compressed air, and be able to raise the materials excavated, and to make or construct foundations and buildings, as above described.” At the trial it was proved that the apparatus described in a prior patent was the same in all material respects as the plaintiff’s caisson, the mode of working was the same in both cases, and they differed only in their application, the prior patent being for excavating and sinking shafts, &c., on land, the plaintiff’s for sinking, excavating, and constructing foundations under water. Pollock, C.B., in directing the jury, said: “I think that an invention must be a production of something that can be used or sold or made use of for some purpose, or some method which results in something of the same sort. And I think that a man cannot, if he has applied—supposing this to be a new application—an old invention, or part of an old invention, to a new purpose, obtain a patent for such an application. Now, if the construction of this caisson, or pile, or whatever it is to be called, is to be looked upon as old, and the object of the patent is for applying it to a new purpose, that is not a manufacture; and the application is such an operation (if so it can be called) that nothing new which results from it can, I think, be the subject of a patent. . . . If a man were to take out a patent for a telescope, to be used to make observations on land, I do not think any one could say, ‘I will take out another patent for that telescope, to be used for making observations on the sea.’ I therefore direct you, that, in point of law, in my judgment, the supposed invention was not an invention of any manner of new manufacture in manner and form as the plaintiff has alleged.” (*Macr. P. C.* 164.) Aff. in Exch. Ch. Maule, J.: “Assuming that the machine itself is old, the learned judge held that a mere application is not a new manufacture, and therefore, not the subject of a patent; and my present opinion is that, on the evidence, he was right in so directing the jury.” (*Macr. P. C.* 166; 23 *L. J. Ex.* 257. Aff. in H. of L., 5 *H. L. Cas.* 707; 25 *L. J., Ex.* 251; 2 *Jur. N. S.* 1029; *Macr. P. C.* 178.)

(v) MARTIN AND HYAM’S PATENT. [1855]

A patent was granted for improvements in goloshes or overshoes, on the ground that the application of gutta-percha to such a purpose might be good subject-matter. (3 *W. R.* 433.)

(w) TETLEY v. EASTON. [1857]

The discovery that a particular advantage may be attained by the use of a machine known before, in a manner known before, is not an invention or application which can be made the subject of a patent. (2 *Comb. B., N. S.* 706; 26 *L. J., C. P.* 269.)

(x) THE PATENT BOTTLE ENVELOPE COMPANY v. SEYMER. [1858]

Infringement of a patent for “improvements in the manufacture of cases or envelopes for covering bottles.” The invention consisted in an arrangement of apparatus by which lengths of

rush, straw, or other suitable material, may be tied together so as to form cases or covers to protect bottles from breakage when packed. For this purpose the plaintiff employed moulds or mandrels, corresponding in form to the bottle for which the case or cover is intended, over which he tied the lengths of rush, &c. After describing the manner of performing his invention, the patentee claimed "the combination of mechanism and the making of envelopes for bottles, as herein described." The defendants also worked a patent for "improvements in the manufacture of cases or packings for bottles or jars," in which they employed a similar mould or mandrel, and this was the infringement complained of by the plaintiffs. Willes, J. delivering the judgment of the Court of Common Pleas, said: "The fact that the model or mandrel constitutes part only of the plaintiff's process does not of itself affect the question. The infringement of any part of a patent process is actionable, if that part is of itself new and useful, so as that it might be the subject-matter of a patent, and is used by the infringer to effect the object, or part of the object, proposed by the patentee. The question, therefore, is whether the plaintiffs could have taken out a patent, simply for applying a model or mandrel in the form of a bottle, or, indeed, a bottle itself, in making envelopes for bottles. We are of opinion that they could not. The use of a model or mandrel, for producing given forms of pliable materials, was admitted at the trial, and, indeed, without such admission, is well known to have been for ages common and usual in various arts. Such use was part of common knowledge, and a model or mandrel for purposes similar to that of this patent was an ordinary and well-known tool. It is merely in respect of the sort of material to which it is applied, and the form of the utensil produced by it, that the plaintiff's application of the model possesses any novelty. The application of a well-known tool to work previously untried materials, or to produce new forms, is not, in our opinion, the subject-matter of a patent. The observations of the Court in giving judgment in the recent case of *Tetley v. Easton* sustain this proposition. Indeed, to hold the contrary might tend to produce oppressive monopolies in the application of old and well-known implements to new materials, without any further novelty or merit than the discovery of the material, or the form into which it is to be worked. Such a discovery is not, in our opinion, one of a new 'manufacture' within the statute of James; and a patent for it alone cannot be maintained." (5 *Com. B.*, N. S. 164; 28 *L. J.*, C. P. 22; 5 *Jur.*, N. S. 174.)

(y) *BROOK v. ASTON*. [1859]

A patent was obtained in 1856 for "An improvement in finishing yarns of wool or hair, and in the finishing of woven fabrics, or piece goods." The specification stated the improvement to consist of causing yarns of wool or hair, whilst distended and kept separate, to be subjected to the action of rotatory beaters or burnishers,

by which such yarns will be burnished or polished on all sides; and in subjecting woven fabrics or piece goods of cotton, linen, silk, wool, hair or other fabrics to a similar process. The separate parts, as well as the exact details of machinery employed, were disclaimed, the patentee claiming as his invention merely the application of the above process to the yarns and fabrics specified. The defendants at the trial proved that a patent had been obtained in 1853 for the same improvement in finishing cotton and linen yarns by a similar process similarly applied:—*Held*, that the plaintiff's patent was bad, as the mere application of known machinery by the same means to some new substance is not the subject of a patent. (8 *El. & Bl.* 478; 27 *L. J.*, *Q. B.* 145; 4 *Jur.*, *N. S.* 279.) This judgment was affirmed in the Exchequer Chamber. Cockburn, C.J., said: "It seems to me that the material to which the process under the respective patents are to be applied are of so similar a nature, that where a patent is taken out for a process as to one, another patent cannot be taken out for applying the same process to the other." Martin, B.: "The application of a well-known tool to work previously untried materials, or to produce new forms, is not the subject of a patent. When a machine is well known it becomes in fact a tool. I am therefore of opinion that the application of this machinery to woollen yarns is not the subject of a patent." (28 *L. J.*, *Q. B.* 175; 5 *Jur.*, *N. S.* 1025.)

(z) *MACKELCAN v. RENNIE.* [1862]

The plaintiff's patent was for "Improvements in floating docks." It was proved at the trial that the construction of the floating docks was not new. The plaintiff then said that his invention consisted, not in the construction of floating docks, but in the application of iron, in the place of wood, to their manufacture. The Court, having determined that this claim was not borne out by the specification, continued: "We think it right to add, that it must not be inferred that the Court entertains an opinion that the alleged invention, even if it were appropriately claimed, could properly be the subject of letters-patent. It is unnecessary on this occasion to give any opinion upon that point; but we wish not to be supposed to sanction such a notion." (13 *Com. B.*, *N. S.* 52.)

(a) *THOMPSON v. JAMES.* Ch. [1863]

Hoops of whalebone, cane, and other substances, suspended from the waist and forming a petticoat, had long since been used by ladies. The plaintiffs took out a patent for using, for the same purpose, hoops made of steel watch springs. The Master of the Rolls said: "If the plaintiffs' claim is simply to use steel springs in a position where formerly whalebone was used, that does not appear to me to be the subject of a patent; there is no invention, and nothing that can properly be called an invention in that, and nothing which can properly form the subject of a patent. . . . To constitute the subject of a patent there must be some real novelty

in the invention, either by a new combination of old existing materials, or else by the discovery of something that did not exist before." (32 *Beav.* 570.)

(b) *PENN v. BIBBY*; *PENN v. JACK*. [1866]

The plaintiff's patent was granted for an improvement in the bearings and bushes for the shafts of screw and submerged propellers. The specification described the invention as follows: "The inner surfaces of these bearings are grooved to receive fillets of wood, which project to some extent beyond the inner surfaces of the metal bearings so as to prevent the shaft coming into contact with the metal of the bearings, and these spaces admit of the water flowing freely between the shaft and the inner surfaces of the metal bearings." At the end of the specification the patentee said: "What I claim is the employing of wood in the construction of the bearings and bushes for the shafts of screw and submerged propellers as herein described." It was objected that this was not the subject-matter of a patent, because the alleged invention was merely a new application of an old and well-known thing. The only examples of old use alleged by the defendants were in grindstones and water-wheels. The Lord Chancellor said: "It is very difficult to extract any principle from the various decisions on the subject which can be applied with certainty to every case; nor indeed is it easy to reconcile them with each other. The criterion given by Lord Campbell in *Brook v. Aston* has been frequently cited (as it was in the present argument), that 'a patent may be valid for the application of an old invention to a new purpose; but to make it valid there must be some novelty in the application.' I cannot help thinking that there must be some inaccuracy in the report of his lordship's words; because, according to the proposition as he states it, if the invention is applied to a new purpose, there must be some novelty in the application. Lord Chief Justice Cockburn approaches much nearer to the enunciation of a principle, or, at least, of a rule, for judging in these cases, in *Harwood v. The Great Northern Railway Company*; there he says, 'Although the authorities establish the proposition that the same means, apparatus, or mechanical contrivance cannot be applied to the same purposes, or to purposes so nearly cognate and similar as that the application of it in the one case naturally leads to the application of it when required in some other, still the question in every case is one of degree, whether the said amount of affinity or similarity which exists between the two purposes is such that they are substantially the same, and that determines whether the invention is sufficiently meritorious to be deserving of a patent.' In every case of this description, one main consideration seems to be, whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study." Applying this test to the present case, his lordship held, that the patented invention was not merely an application of an old thing to a new

purpose, but that it was a sufficient invention to support a patent. (*L. Rep.*, 2 *Ch.* 127; 36 *L. J.*, *Ch.* 455; 15 *W. R.* 208; 15 *L. T. Rep.*, *N. S.* 399.)

(c) *WHITE v. TOMS.* *Ch.* [1867]

Ladies' mourning bonnet and hat falls having previously been made with the ornamental folds on the outside only, so that when turned up a "wrong side" was exposed to view, the plaintiff introduced and patented an improved mode of making them with the folds on the inner side also, so as to form both sides alike, but there was no novelty in the process of manufacture. *Malins, V.-C.*, held, that this was not a subject for a patent, for "where there is merely an improvement in the mode of manufacture and no invention, that is not a proper subject for a patent." (37 *L. J.*, *Ch.* 204; 17 *L. T. Rep.*, *N. S.* 348.)

(d) *RUSHTON v. CRAWLEY.* *Ch.* [1870.]

The plaintiff obtained a patent for the use of animal fibre, by preference Russian wool, or wool of a coarse texture, in the manufacture of artificial hair to be made up as ladies' head-dresses, and for upholstery, and other like purposes. Upon bill filed to restrain an infringement of the patent, Vice-Chancellor Sir R. Malins said: "It is a gross violation of the privilege conferred upon inventors for a person to take out a patent for a known article which has been used for years, because he finds he can produce a thing cheaper or better by a new material, or to suppose that directly he uses the new material it can be a subject for a patent. Suppose any one should discover some other well-known material for making these things, such as paper, is he to take out a patent for it? And afterwards someone else should find out they could be made of straw, is he also to have a patent? So far as my opinion goes, and I desire it to be distinctly understood, the use of a new material to produce a known article is not the subject of a patent, but there must be some invention, something really new, something more valuable to the public than the simple use of a new material to produce a known article. I do not think it is necessary to go through the various authorities which were cited. The case of *Crane v. Price* was a patent for the use of anthracite coal. The patent was established, but it is now generally considered that such a case would not succeed in the present day. The case of *Brook v. Aston* is conclusive against the plaintiff. That was a patent for simply using some machinery for wool which had been previously used for linen, yarn, or cotton. That, therefore, was using the same thing for a new material; this is using a new material for an old thing, according to the statement of the plaintiff. But it turns out from the evidence that it is not a new material, but a perfectly old material. Assuming, however, that it was new, and that wool had never been used before for making these articles, upon that assumption, in my opinion, the patent would be wholly void." (*L. Rep.*, 10 *Eq.* 522.)



(e) *JOHNSON v. RYLANDS.* Exch. Ch. [1873]

A patent for improvements in testing the strength of wire, claimed the passing wire for that purpose over surfaces, one of which is caused to draw it forward at an accelerated rate. A similar apparatus had been previously in use for the purpose of straining and taking the kinks out. Blackburn, J. : "It appears to me that if the plaintiff had made a claim of this sort knowing that the defendant had strained wire and it had been done and used openly and knowingly, and said 'I claim two drums for straining the wire and taking the kinks out, using the same mode of straining and the same mode for the purpose of ascertaining and testing the strength of the weakest part of the wire,' that would not have been the subject of a patent at all. That would have been applying it to effect an old purpose in a way it had not been done before, and it is not because it happened that nobody had used it before in that way, that that therefore would have made it the subject of a patent." The patent was however held good on the ground that the drums being so arranged that there was uniform expansion of, say, two per cent. in the wire before it was wound on the second drum, the invention was valuable as showing that all the wire was capable of bearing that percentage of expansion. (*Griff.* 138.)

(f) *CROYSDALE v. FISHER.* [1884]

The patent was for improvements in the manufacture of manure. Pollock B. : "If an inventor comes forward and does not claim too widely, but claims honestly an invention as an invention, and gives to the public for the first time the result obtained by the admixture of different processes, although these processes had been known before for some purposes, and although the product had been known before, still if the process is new in the sense that some hitherto unknown result is produced by a known process, and that such result is useful and of commercial value, in that case he is entitled to a patent." The test whether the object attained is new or only cognate, is in this case : "Given the desideratum of manufacturing this powder, given the existence of Forrest's machine, given the knowledge which previously existed with regard to what could be effected by the admixture of sulphuric acid in any proportions with shoddy, given all these as data, is there any one who could say that the application of Forrest's machine in the mode in which it was specified for by the plaintiff would produce not only that which he claims but which he proves by his witnesses to have been carried out." (1 *O. R.* 17 at p. 19.)

(g) *LISTER v. NORTON.* [1886]

The glossiness and softness of silk, and the resiliency of mohair were well known and the two had been used together in making glacé goods, but held that the use of the two together in a specified manner so as to attain a more perfect imitation of sealskin involved sufficient invention to support a patent. (3 *O. R.* 199.)

(h) EDISON AND SWAN ELECTRIC LIGHT COMPANY *v.* WOODHOUSE.  
(No. 2.) C. A. [1887]

The patent claimed, secondly, a material for the manufacture of illuminating conductors produced by electrically heating carbon in a carbon gas, and was attacked on the ground of the prior production of a similar material by Despretz experimentally. The Court came to the conclusion that for all useful and practical purposes the processes and the products were different, and expressed no opinion whether, in case they had been in all respects the same, the patent would have been bad, although it showed how to apply to a useful purpose, carbon which neither Despretz nor any one else was aware had the special useful qualities discovered by the patentee. (*Griff.*, p. 94; 3 O. R. 183; 4 O. R. 99.)

(h\*) EHRLICH *v.* IHLEE. C. A. [1888]

The plaintiff's patent was for improvements in musical instruments, in which the notes are produced by the passage of a perforated sheet across levers operating valves, and the invention consisted substantially in employing a perforated disk instead of a band. A disk had already been applied in looms to operate on levers instead of a band, but in that case the motion was discontinuous, whereas here it was continuous:—*Held*, that the application of the disk to a musical instrument was new, and was good subject-matter. (5 O. R. 437.)

(i<sup>1</sup>) DOWLING *v.* BILLINGTON. [1890]

A new method of using existing machinery for the weaving of wire mattresses, so as to produce a new and useful result, viz., the more even distribution of strength:—*Held*, to be good subject-matter. (7 O. R. 191.)

*Application of a known Machine, Process or Material to an Analogous Purpose.*

(i) LOSH *v.* HAGUE. N. P. [1838]

The application of a well-known thing to an operation analogous to that for which it has already been used is not the subject of a patent. (1 *Web. P. C.* 208.)

(j) KAY *v.* MARSHALL. [1839—1848]

Patent for "a new and improved machinery for preparing and spinning flax, hemp, and other fibrous substances, by power." The first part of the invention claimed, consisting of machinery for macerating flax, &c., was held to be new, and a proper subject for a patent. The second part of the invention consisted in placing the drawing rollers only two and a half inches from the retaining rollers. It was proved that before the date of the patent flax and other fibrous substances were spun with machines by which the reach was varied according to the staple or fibre of the article to be spun, and that that had been a fundamental principle of dry spinning. Cotton had also been spun at a short reach. The use

of moisture in spinning flax had been adopted under a prior patent, though in a manner different from that proposed by the plaintiff. The question before the Court therefore was, whether the application of the short reach to the spinning of flax, when in a state of maceration, was a proper subject for a patent. Tindal, C.J., held, that it was not, being merely "the application of a piece of machinery already known and in use, to the new macerated state of the flax. . . . Suppose a patent to have been first obtained for some entirely new method, either chemical or mechanical, of reducing the fibres of flax to a short staple, we think that a second patent could not be taken out for an improved mode of machinery in spinning flax, which consisted of nothing more than the spinning of the short staple of flax by a spinning machine with a reach of a given length, not less than that already in use for the spinning of cotton; the effect of which would be, to prevent the first patentee from working his invention with the old machine at the proper reach. If a patent taken out for that object separately would be invalid, so also a patent taken out for an invention consisting of two distinct parts, one of which is that precise object, would be void also." (5 *Bing. N. C.* 492; 7 *Scott*, 548; 8 *L. J., C. P.* 261; 2 *Web. P. C.* 71. Judgment affirmed in the House of Lords, 8 *C. & F.* 245; *West*, 682; 5 *Jur.* 1028; 2 *Web. P. C.* 79.)

(i) *CALVERT v. ASHBURN.*

The application of caustic alkalies for the purpose of dissolving the gluten contained in flour, employed in the manufacture of size, is not good subject-matter, inasmuch as they had been previously employed for the purpose of dissolving gluten in the manufacture of starch. (*John.* 84.)

(j) *HYDE v. TRENT.*

The principal part of an invention for separating the fibres of cocoa-nut husks consisted in passing the split husks between crushing rollers such as had previously been employed in treating hemp:—*Held*, that their application to crushing cocoa-nut fibre was not good subject-matter. (*John.* 79.)

(k) *HORTON v. MABON.* [1862]

The plaintiff in his patent claimed the application of double-angle iron to the construction of the troughs of the hydraulic joints of telescope gasholders. Before the date of the patent these troughs were constructed of two long pieces of single-angle iron, which were attached to a sheet of iron of equal length by means of a double row of rivets. The jury found, first, that a trough of double-angle iron had not been applied to the purpose of gasholders before the date of the patent. Secondly, that double-angle iron was a known article of commerce, of a variety of sizes, and applied to a variety of purposes in the form in which the plaintiff claimed to use it. Willes, J.: "I do not deny that a new combination of old materials producing a new effect may be the

subject of a patent, but there must be some invention. Here all that was done was the application of an old idea to the subject of telescopic gasholders. That is no invention at all. The invention consists in the idea, and the mode in which the idea is made of practical utility. But the merit of that invention belongs to the person who first moulded iron in one piece into the form of double-angle iron, and applied it to such purposes as this." (31 *L. J.*, *C. P.* 225; 12 *Com. B.*, *N. S.* 437; 10 *W. R.* 582; 6 *L. T. Rep.*, *N. S.* 289; affirmed on appeal, 16 *Com. B.*, *N. S.* 141; 12 *W. R.* 491; 9 *L. T. Rep.*, *N. S.* 815.)

(l) *ORMSON v. CLARKE.* [1862]

The patent was for an improvement in the manufacture of cast tubular boilers for the heating of horticultural buildings. Boilers of the same form had been made previously to the plaintiff's patent, the several parts being cast separately and afterwards fixed together. The plaintiff's improvement consisted in casting the boiler in one piece; there was no claim as to the mode of casting. The Court held, upon the authority of *Harwood v. The Great Northern Railway Company*, and *Horton v. Mabon*, that this was not the subject of a patent, being a mere application of the well-known process of casting to an article previously well-known. (32 *L. J.*, *C. P.* 8; 13 *Com. B.*, *N. S.* 337; 9 *Jur.*, *N. S.* 749; 11 *W. R.* 118; 7 *L. T. Rep.*, *N. S.* 361; affirmed in the Exchequer Chamber, where, however, it was stated that if the patent had been taken out for an improved mode of casting tubular boilers in one piece, probably it might have been supported; 32 *L. J.*, *C. P.* 291; 14 *Com. B.*, *N. S.* 475; 10 *Jur.*, *N. S.* 128; 11 *W. R.* 787.)

(m) *WILLIS v. DAVISON.* [1863]

The pneumatic lever (a kind of bellows) was used in organs before 1851; the compensating valve was used in the pedal bellows of organs before 1851, for the purpose of easing their working, but had never been applied to the pneumatic lever: the plaintiff, in 1851, took out a patent for the application of the compensating valve to the pneumatic lever, for the purpose of easing the working of the latter:—*Held*, that plaintiff's contrivance was not such a new invention as was capable of becoming the subject of a patent. (1 *N. R.* 234.)

(n) *HARWOOD v. THE GREAT NORTHERN RAILWAY COMPANY.* [1860—1865]

The plaintiffs were the executors of Wild, to whom a patent had been granted for "improvements in fishes and fish-joints for connecting the rails of railways," which consisted in forming a recess or groove in one or both sides of each fish, so as to reduce the quantity of metal at that part, and to be adapted to receive the square heads of the bolts. (The facts are more fully set out at p. 238 *r.*) In the House of Lords, in answer to the Lord Chancellor, Blackburn, J., delivering the opinion of Mr. Justice Shee and himself,

after reading sect. 6 of the Statute of Monopolies, said: "In order to bring the subject-matter of a patent within this exception there must be invention so applied as to produce a practical result. And we quite agree with the Court of Exchequer Chamber, that a mere application of an old contrivance in the old way to an analogous subject, without any novelty or invention in the mode of applying such old contrivance to the new purpose, is not a valid subject-matter of a patent. There are many decisions to that effect, which were referred to at your Lordships' bar; and, if the matter were now for the first time to be decided on the construction of the statute, without reference to the cases, we should think, on principle, that such should be the conclusion of the Court. But then, in every case, arises a question of fact, whether the contrivance before in use was so similar to that which the patentee claims, that there is no invention in the differences, if any, between the old contrivance, and that for which the patentee claims a monopoly; and if there be none, there arises a further question of fact, viz., whether the purpose to which the contrivance was before applied and the new purpose are so analogous or cognate, that there is no discovery or invention in the new application; whether, in short, it is a mere application or not? For, if there is invention or discovery producing a practical benefit, as in the case of *Crane v. Price*, it is the valid subject of a patent. And we think it always must be a question of degree; a question of, more or less, whether the analogy or cognateness of the purposes is so close as to prevent there being an invention in the application." (35 *L. J.*, *Q. B.* 33.) Channell, B., delivering the opinion also of Keating, J., and Pigott, B., said, it was argued "that there was invention at all events in this—that, whereas the grooved iron, as used in the bridges, had been applied for the purpose of binding together pieces of material laid upon one another horizontally, the grooved iron in fishing the rails was applied laterally, binding together the material, and that its great merit consisted in its performing the novel function of resisting the vertical pressure to which it was exposed, and did so by means of a plate equally strong, but rendered lighter than that previously in use by the removal of that portion of the plate which was useless in resisting such pressure. We do not find that any allusion to such an invention, as that now suggested, was made either at *Nisi Prius*, or in any of the judgments in the Court of Queen's Bench supporting, or in that of the Exchequer Chamber invalidating, the patent right; nor do we think, looking to the terms of the specification, that Wild ever intended to claim, or did claim any such. . . . There is no novelty or invention to support the patent." (35 *L. J.*, *Q. B.* 35.) The Lord Chancellor, in delivering the judgment of the House of Lords, said: "The question is, whether there can be any invention of the plaintiff in having taken that thing, which was a fish for a bridge, and having applied it as a fish to a railway. Upon that I think the law is well and rightly settled, for there would be no end to the interferences with trade, and with the liberty of any mechanical contrivance being adopted, if every slight difference in the application of a well-known thing

were held to constitute a patent. . . . No sounder or more wholesome doctrine, I think, was ever established than that which was established by the decisions which are referred to in the opinions of the four learned judges, who concur in the second opinion delivered to your Lordships, namely, that you cannot have a patent for a well-known mechanical contrivance merely because it is applied in a manner or to a purpose which is analogous to the manner or to the purpose in or to which it has been hitherto notoriously used. The channelled iron was applied in a manner which was notorious, and the application of it to a vertical fish would be no more than the application of a well-known contrivance to a purpose exactly analogous or corresponding to the purpose to which it had been previously applied." (35 *L. J., Q. B.* 38.)

(o) *RALSTON v. SMITH.* H. L. [1865]

The discovery of one particular use of a known machine, although more advantageous than that formerly known, is not the subject of a patent.

Before the date of the plaintiff's patent, a roller and a bowl were employed for calendering and for embossing woven goods. In the process of calendering the cloth was passed between a roller and a bowl; the roller was smooth, and the surface velocities of the roller and the bowl were unequal. In embossing, the cloth passed between a roller which had the pattern to be transmitted to the cloth engraved upon it, and a bowl, the two moving with equal surface velocity. The object of the calendering was to produce a gloss upon the cloth. The plaintiff obtained a patent for "Improvements in embossing and finishing woven fabrics and in the machinery or apparatus employed therein." This title was subsequently amended, so as to be in these words, "Improvements in embossing and finishing woven fabrics." The specification enrolled by the plaintiff alleged the invention to consist in the use of rollers having any design grooved, fluted, engraved, milled, or otherwise indented upon them. A disclaimer was afterwards filed, and stated that the effect desired could only be produced by the use of a certain species of roller not particularly described in the specification, namely, a roller having circular grooves round its surface; and the use of all other rollers was disclaimed. The amended claim was for "the employment of grooved, fluted, or indented rollers of hard metal, or other suitable material, driven at a greater speed than the bowl or bowls connected with them, so as to exert a rubbing or friction upon the fabric submitted to their action, and thereby produce an indefinite variety of pattern, as well as a bright finish or lustre," &c. Lord Cranworth: "It is not every useful discovery that can be made the subject of a patent, but you must show that the discovery can be brought within a fair extension of the words, 'a new manufacture.' Now how is this possible to be called 'a new manufacture'? I, as a manufacturer, have my roller, which I am in the habit of rolling upon a bowl (if that is the proper expression); the fabric passing between the two at equal velocities. Then I can impress my pattern upon it. I have my roller without any pattern

engraved upon it; I can impress that at an unequal velocity, and it will calender. But I do not do them both at the same time, because I suppose that in so doing I shall tear my fabric; and I rightly so suppose, until the plaintiff makes the discovery that there is one particular sort of pattern which may be produced without tearing the fabric. Now that is a very useful discovery; but it would be strange to say that that is a new manufacture, and that, therefore, I am to be deprived of the most useful way of using my roller. There is nothing new in the invention, except that I now know what I did not know before, that by a particular use of it I shall obtain a result which I did not know before, that I could obtain." (11 *H. L. Cas.* 223; 20 *Com. B., N. S.* 28; 13 *L. T. Rep., N. S.* 1; 35 *L. J., C. P.* 49.)

(p) *JORDAN v. MOORE.* [1866]

The plaintiff obtained a patent for "certain improvements in the construction of ships and other vessels navigating on water." The first and most important claim in the specification was "for the combination of an iron frame, with an external covering of timber planking for the sides, bilges, and bottoms." The Court construed this claim to be a claim for planking with timber *any* iron frame of a ship. Byles, J., delivering the judgment of the Court, said: "Iron and wood being both of them materials long used for the construction of the frame and coating of vessels, can the application of wooden planking to the iron frame of a vessel (without any peculiarity in the nature of that planking) be the subject of a patent? We think it cannot. It is not only the substitution of one well-known and analogous material for another, that is, wood for iron, to effect the same purpose on an iron vessel, but it is the application of the same old invention, namely, planking with timber, which was formerly done on a wooden frame to an analogous purpose, or rather the same purpose, on an iron frame. In this view of the case the recent decision of the Exchequer Chamber, and of the House of Lords, in *Harwood v. The Great Northern Railway Company*, appears to us to be in point, and decisive for the defendant." (*L. Rep.*, 1 *C. P.* 624; 12 *Jur., N. S.* 766; 35 *L. J., C. P.* 268; 14 *W. R.* 769.)

(q) *PARKES v. STEVENS.* Ch. [1869]

James, V.-C., said: "I am clearly of opinion that there can be no patent right in the substitution of a slide for a hinge, whether applied to the door of a house, the door of a carriage, or the door of a lamp or lantern, whether large or small, suspended or not suspended. It was hardly contended before me that the introduction of the door alone would have been sufficient to sustain a patent; but it was contended that because it was, as alleged, a novel part of a novel combination and arrangement, it was so protected. To say that a patent for an entire combination is a valid patent for a part, when that part would not of itself be patentable, is, in my judgment, a *reductio ad absurdum* of the supposed principle of *Lister v. Leather.*" (*L. R.*, 8 *Eq.* 367; 38 *L. J., Ch.* 631.)

Judgment affirmed on appeal.—Hatherley, L.C., held, that the adaptation of a sliding door to a spherical lamp, sliding doors having previously been applied to cylindrical lamps and to other glazed surfaces, cannot of itself be the subject of a patent. (*L. R.*, 5 *Ch.* 36; 18 *W. R.* 233; 22 *L. T. Rep.*, *N. S.* 635.)

(*r*) *TATHAM v. DANIA.* [1869]

A patentee must show not merely newness, in the sense of doing a thing which has not been done before, but he must show newness in the shape of novelty by producing a thing which requires some exertion of mind that could properly be called invention. To apply an old tool to a new material could not be the subject of a patent, although all mankind had been previously using another sort of tool which produced a much inferior effect, and although, therefore, the application of the other tool had the merit in it that it produced a useful result in the easier working of a material to which that tool had not been applied before, but inasmuch as the tool has been used for an analogous purpose to that which all mankind knew it was useful for before, although the application was new, yet it was not a novelty in the sense of invention so as to sustain a patent. (*Griff.* 213.)

(*s*) *BAMLETT v. PICKSLEY.* [1875]

Where the invention claimed is the application of a known machine to a fresh purpose, the question is, Is that or is it not a cognate purpose? *Crane v. Price* (see p. 502) can only be upheld, if at all, on the ground that there a new product was produced of a different class and character. (*Griff.* 40.)

(*t*) *HILL v. TOMBS.* [1881]

The use of a guide in a frilling machine for the purpose of keeping down the work is not good subject-matter, because guides of similar character have been employed in many other machines. (*John.* 82.)

(*u*) *CROPPER v. SMITH AND HANCOCK.* C. A. [1884]

The plaintiff's patent was for improvements in lace machines, and the third claim was for a central longitudinal plate connecting the end standards:—*Held*, that what was claimed was a mere application of a plate to tie standards, and not an intelligent re-arrangement of the lace machine to effect that application, and that the patent was therefore void. (1 *O. R.* 81.)

(*v*) *SHARP v. BRAUER.* [1886]

The application of cardboard to the construction of window blinds is not good subject-matter. (3 *O. R.* 193.)

(*w*) *ALBO CARBON LIGHT COMPANY v. KIDD.* [1887]

In an action for infringement of a patent relating to the use of solid naphthaline for enriching gas, it appeared that other forms of naphthaline were in common use for that purpose, and that solid naphthaline was, at the date of the patent, a well-known commercial



article, and could be used for enriching gas in the form in which it was on the market:—*Held*, that the alleged invention was not the subject of a patent. (4 O. R. 535.)

(u) *ODDY v. SMITH.* [1888]

A method of holding strips of leather for covering metallic rollers by means of spiked bars held not to be subject-matter for a patent. (5 O. R. 503.)

(v) *SIDDELL v. VICKERS.* C. A. [1888]

Cotton, L.J.: "None of the cases which have held that you cannot claim a patent for applying an old machine to an analogous purpose will apply where there is a new machine, although that new machine does contain, as most new machines must do, old and well-known mechanical appliances." (5 O. R. 416 at p. 430.)

(w) *TICKELPENNY v. ARMY AND NAVY CO-OPERATIVE STORES.* [1888]

The use of iron columns, with water-tight joints hollow and filled with water to support the girders carrying the floors of a building, is not good subject-matter. (5 O. R. 405.)

(x) *Longbottom v. Shaw.* C. A. [1889]

The plaintiff's patent was for improvements in frames for holding pile or other fabrics. Such machines had long been made of a frame with a triangle at the end, in the inside of which hooks were fixed, from which the pile or material was suspended. These hooks were liable to bend, and so cause risk in fastening up the pile fabric on them, and, to avoid this, the plaintiff proposed to make rows of hooks firmly fixed on a bar in either of three ways described, and then to fasten the bar to the frame. It was proved that the new machine was a cheaper and better article:—*Held*, that there was not sufficient subject-matter in it to support a patent, as the fastening of hooks firmly on to a bar was old, and that this was, therefore, only a new application of an old thing to produce an old result. (5 O. R. 497; 6 O. R. 143, 510.)

(x\*) *MORGAN v. WINDOVER.* H. L. [1890]

The mere adaptation to a new purpose of a known material or appliance, if that purpose be analogous to a purpose to which it has already been applied, and if the mode of application be also analogous, so that no inventive faculty is required, and no invention is displayed in the manner in which it is applied, is not the subject-matter of a patent, although it may be true that it is accompanied by advantages not thought of or practised before. At the date of the plaintiff's patent for improvements in carriages there were in common use three different arrangements of springs; in one the body rested on four C-shaped springs, the two front springs being secured to a perch rigidly connected with the fore axle; in another the body rested on four elliptical springs, two being in rigid connection with each axle; in the third the front rested upon two elliptical springs, while the back rested upon two composite springs, half C-shaped and half elliptical, which were fastened to the axle in the same manner as the elliptical springs,

the elliptical ends being placed below the body of the carriage. The alleged invention substantially consisted in the substitution of composite for elliptical springs in the fore part of the carriage, and in attaching them to the fore axle in the same way in which they were previously attached to the hind axle, except that the C end of the spring was turned forwards:—*Held*, that this involved no ingenuity, and was not good subject-matter. (7 O. R. 131.)

(x) *LEADBEATER v. KITCHIN*. C. A. [1890]

The plaintiff's specification described improvements in guards to prevent accidents where belts and pulleys, and also where geared wheels were used:—*Held*, that the claim included guards both for geared wheels and belts, and was therefore too wide, and that even if confined to guards as applied to belts, it was only for the use of an old thing for an analogous purpose. (7 O. R. 235.)

### *Principle.*

(y) *BOULTON v. BULL*. [1795]

Rooke, J.: "The term 'principle' is equivocal; it may denote either the radical elementary truths of a science, or those consequential axioms which are founded on radical truths, but which are used as fundamental truths by those who do not find it expedient to have recourse to first principles." (2 H. Bl. 479.) Heath, J.: "The Marquis of Worcester discovered, in the last century, the expansive force of steam, and first applied it to machinery. As the original inventor he was clearly entitled to a patent. Would the patent have been good applied to all machinery, or to the machines which he had discovered? The patent decides the question. It must be for the vendible matter, and not for the principle. Another objection may be urged against the patent, upon the application of the principle to an old machine, which is, that whatever machinery may be hereafter invented would be an infringement of the patent, if it be founded on the same principle. If this were so it would reverse the clearest positions of law respecting patents for machinery, by which it has been always holden, that the organisation of a machine may be the subject of a patent, but principles cannot. . . . Indeed it seems impossible to specify a principle, and its application to all cases, which furnishes an argument that it cannot be the subject of a patent." (*Ib.* 483.) Mr. Justice Buller: "The very statement of what a principle is, proves it not to be a ground for a patent. It is the first ground and rule for arts and sciences, or in other words, the elements and rudiments of them. A patent must be for some new production from those elements, and not for the elements themselves." (*Ib.* 485.) (2 H. Bl. 463; 1 Carp. P. C. 117; Dav. P. C. 162.)

(z) *JUPE v. PRATT*. [1837]

Alderson, B., said: "You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented

some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention." (1 *Web. P. C.* 146.)

(a) *NEILSON v. HARFORD.* [1841]

Alderson, B.: "I take the distinction between a patent for a principle and a patent which can be supported, is, that you must have an embodiment of the principle in some practical mode described in the specification of carrying the principle into actual effect, and then you take out your patent, not for the principle, but for the mode of carrying the principle into effect." (1 *Web. P. C.* 342.) "There is no difference between (claiming) a principle to be carried into effect in any way you will, and claiming the principle itself." (*Ib.* 355.)

(b) *THE HOUSEHILL COMPANY v. NEILSON.* [1843]

Lord Justice Clerk Hope: "A patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of nature, or any property of matter, apart from any mode of turning it to account in the practical operations of manufacture, or the business, and arts, and utilities of life. The mere discovery of such a principle is not an invention, in the patent-law sense of the term. Stating such a principle in a patent may be a promulgation of the principle, but it is no application of the principle to any practical purpose. And without that application of the principle to a practical object and end, and without the application of it to human industry, or to the purposes of human enjoyment, a person cannot in the abstract appropriate a principle to himself. But a patent will be good, though the subject of the patent consists in the discovery of a great, general, and most comprehensive principle in science or law of nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained. (1 *Web. P. C.* 683.) . . . A claim for all modes of applying the principle to the purpose specified, according to or within a general statement of the object to be attained, and of the use to be made of the agent to be so applied, is no objection whatever to the patent. That the application or use of the agent for the purpose specified, may be carried out in a great variety of ways, only shows the beauty, and simplicity, and comprehensiveness of the invention. (*Ib.* 684) . . . I state to you the law to be, that you may obtain a patent for a mode of carrying a principle into effect; and if you suggest and discover, not only the principle, but suggest and invent how it may be applied to a practical result by mechanical contrivance and apparatus, and show that you are aware that no particular sort or modification, or form of apparatus, is essential, in order to obtain benefit from the principle, then you may take your patent for the mode of carrying it into effect, and are not under the necessity of describing and confining yourself to one form of apparatus. If that were necessary, you see what would be the result? Why, that a patent could hardly ever be obtained for any mode of carrying a newly-discovered principle into practical results, though the

most valuable of all discoveries. For the best form and shape or modification of apparatus cannot, in matters of such vast range, and requiring observation on such a great scale, be attained at once; and so the thing would become known, and so the right lost, long before all the various kinds of apparatus could be tried. Hence you may generally claim the mode of carrying the principle into effect by mechanical contrivance, so that any sort of apparatus applied in the way stated will, more or less, produce the benefit, and you are not tied down to any form." (*Ib.* 685.) (1 *Web. P. C.* 673; 9 *C. & F.* 788.)

(c) *CROSSLEY v. POTTER.* N. P. [1853]

The title was for "certain improvements in weaving figured fabrics." The patentee in his specification says: "My improvements in weaving figured fabrics apply to those particular kinds of fabric which have a terry or raised loop surface, such as coach lace, Brussels carpeting, velvets, and other woven goods having terry or raised surfaces, either plain or figured." The evidence went to show that without additional parts, which were not mentioned, the machine described in the specification was capable of making coach lace, but not of making either carpet or velvet goods. Pollock, C.B., in directing the jury, said: "The truth appears to me to be this, that the patent is very much like what has often been attempted, viz., to take out a patent for a principle, which the law will not allow. Any man who takes out a patent must take it for a manufacture. It is very true that patents are continually taken out for what are called 'methods,' or 'processes'; but the real object of the patent, the real end that is secured by the statute, the matter that is alone mentioned in it capable of being made the subject of a patent, is a new manufacture; and everybody who takes out a patent under the name of a process, really takes it out for that which is the result of the process, for the thing that is manufactured, or the process by which it is produced." (*Macrory's P. C.* 240.)

(d) *PATTERSON v. THE GAS LIGHT AND COKE COMP.* H. L. [1877]

The discovery of a more skilful and efficient mode of working a process, already known and in use, is not the proper subject of a patent. (2 *Ch. D.* 812. Affirmed in H. of L., 3 *App. Cas.* 239.)

A patentee claimed, "First: The employment of sulphides of calcium in separate purifiers, as a means of purifying coal gas from sulphur existing in other forms than in that of sulphuretted hydrogen. Secondly: A method or system of employing lime purifiers in the manner hereinafter described, whereby the contents of all the said purifiers, or of any required number of them, can be converted into sulphides of calcium, and also (if required) be maintained in that condition." James, L.J., delivering the judgment of the Court of Appeal (James, Baggallay, L.J.J., and Lush J.), said: "There is nothing in this (the first claim) but the enunciation of a chemical truth, that pure sulphides of calcium will absorb the sulphur compounds. The plaintiff believed that he had discovered that chemical truth, although it had been

taught for many years in many books, and was well known to chemists. There is no invention of any particular process or means of employing the pure sulphide of calcium. If pure sulphide of calcium is to be used, it must be used in some separate holder of it, and the thing holding it would be a separate purifier, and there is nothing, therefore, in any previous part of the specification to limit the universality of the claims to the employment of sulphides of calcium for the removal of sulphur in other forms than sulphuretted hydrogen. It is obviously impossible to support such a claim as that, which was plainly based on the plaintiff's mistaken idea that he had discovered that peculiar property in sulphide of calcium." (2 *Ch. D.* 833.)

Referring to the second claim, the Court said: "There is in that no suggestion of any new apparatus—of any new process. There is no device or scheme of any kind. Lime purifiers in succession were in general, almost universal use, wherever lime could be freely used. . . . What he (the plaintiff) claims to have discovered is, that if the carbonic acid, which is the first thing taken up by the lime, is not wholly taken up at the beginning, and is allowed to enter the last purifier or purifiers, it in fact poisons the latter, decomposes the sulphide of calcium already formed, disengages the other sulphur absorbed by the sulphide, and of course fills the gas again with the sulphur impurities which had been removed. This is a very valuable working caution and direction, but it is impossible to make anything more of it than a working caution and direction. It really amounts to nothing more than a direction to be sufficiently liberal in the use of the caustic lime in the first stage, and an instruction that the moment it is so far carbonated as not to arrest the carbonic acid, it should be removed and a fresh supply of lime got. It may be a direction and instruction of the greatest possible value and utility, but it is utterly impossible to make such a direction and instruction, however valuable, the subject of a patent." (*Ib.* 834.)

In the House of Lords, Lord Blackburn said: "The appellant appears, from what he says in his specification, to be of opinion that, if he first discovered the theory and reason of that which had before been done empirically, he is entitled to a patent. I need hardly point out that this is a mistake; if, by reason of knowing the theory, he is enabled to make some improvements, he may take out a patent for the improvements, but he cannot take out a patent to prevent others using what they had used before, though only empirically." (3 *App. Cas.* 246.)

(e) *BADISCHE ANILIN UND SODA FABRIK v. LEVINSTEIN.* H. L. [1887]

A patent cannot be granted for a principle alone, but may be granted for a principle coupled with a process by which the principle may be carried into effect:—*Held*, therefore, that the principle on which the plaintiff's method of producing colouring matters was based being new, and the process being sufficiently described to be commercially worked, the patent was valid. (24 *Ch. D.* 156; 12 *App. C.* 710.)

**(f) AUTOMATIC WEIGHING MACHINE COMPANY v. KNIGHT. C. A. [1889]**

Cotton, L.J.: You cannot take out a patent for a principle, you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle but invented some mode of carrying it into effect. . . . Where there is a principle first applied in a machine capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle and say they do it by a different mode, and looks to see whether in effect, although the mode is not exactly the same, it is only a colourable difference." (6 O. R. 297, at p. 304.)

**(g) THOMSON v. MOORE. Ir. C. A. [1889]**

Palles, L.C.B.: "Although a principle, as distinct from the machine by which it is proposed to be applied, cannot be the subject of a patent, the consideration of the principle sought to be so applied may be material in determining the essence of that invention." (6 O. R. 426, at p. 450.) Affirmed in H. of L. (7 O. R. 325)

**Substitute** for Attorney-General may petition for revocation if authorised. Patents Act, 1883, sect. 26 (4) b., p. 402.

*Cases as to Applications for Authority.***(h) BELL AND COLEMAN'S PATENT.**

Authority was refused while an action for infringement was pending in Scotland. (*Griff.* 320.)

**(i) MARTIN'S PATENT.**

Where an application for authority is abandoned the law officer has no power to give costs. (*Griff.* 320.)

**(j) SIDDELL'S PATENT.**

The application for authority was directed to stand over on Siddell's undertaking to bring an action. (*Griff.* 320.)

**(k) WATLING'S PATENT.**

The patentee had notice and did not appear, and authority was granted. (*Griff.* 320.)

**(l) GOULARD AND GIBBS' PATENT.**

Authority was given without notice to the patentees. (*Griff.* 320.)

**(m) ROTHWELL'S PATENT.**

Although an application to amend was pending, authority was given without notice to the patentee, who had abandoned an action for infringement against the applicant. (*Griff.* 320.)

**Substituted Service** granted, p. 40 (k).

**Substitution** of new ingredients is not patentable, pp. 528 (a), 530 (d), 538 (v) (t).

**Sufficiency** of Specification. See under Specification, pp. 421-436.

**Superiority** of Materials is not good subject-matter, pp. 530 (*d*), 537 (*p*).

**Supply** of anticipating publication, p. 545 (*g*).

(*g*) **PICKARD AND CURRY v. PRESCOTT.** [1890]

A French periodical containing what was admittedly an anticipation, was supplied to one person before the date of the plaintiff's patent. *Held*, that in the absence of further evidence this was fatal. (7 O. R. 361.)

**Tenants in Common**, right to sue descends to survivor, p. 287 (*s*)  
right to work patent vested in trustee for, p. 207 (*l*).

**Terms** of grant of letters patent, pp. 148, 149.

**Terms** imposed on extension, pp. 136-139.

**Terms** in specification to be explained by jury, pp. 461 (*p*), 470 (*p*).

### Threats,

person aggrieved by, may bring action, Patents Act, 1883, sect. 32, p. 546  
section not to apply if person making, prosecutes action with due diligence, sect. 32, p. 546.

*Cases as to, before the Act of 1883*, p. 546

action formerly did not lie unless *mala fides* was shown, p. 546 (*h*)  
or if defendant *bonâ fide* intended to follow up his threats, p. 547 (*i*) (*k*)  
or if he undertook to do so, p. 547 (*j*)  
or if made with reasonable and probable cause, p. 547 (*k*)  
or if threatening statements were true, p. 547 (*l*)  
or if defendant believed them to be true, p. 548 (*m*)  
circular issued *bonâ fide* not restrained by interim injunction unless in violation of contract, p. 548 (*n*)  
validity of patent was not in issue, p. 552 (*y*).

*Cases since the Act of 1883*, p. 549

plaintiff is person aggrieved when he is threatened, sect. 32, p. 546  
or his customers, p. 553 (*a*)  
or when customers of his licensees are threatened, p. 553 (*z*)

injunction granted,

where threats were admitted, p. 554 (*c*)  
where plaintiff made *primâ facie* case of non-infringement,  
p. 551 (*u*) (*x*)

although not proved, p. 551 (*u*) (*x*)

motion adjourned where defendants had commenced action first,  
p. 550 (*s*)

or where defendant commenced cross-action, pp. 550 (*r*), 554 (*e*)

threats by advertisement, p. 553 (*a*)

or by circular, p. 551 (*w*)

or by solicitor's letter, pp. 553 (*z*\*), 554 (*e*)

or by private letter, p. 550 (*t*)

action to bring defendant within the proviso, p. 551 (*w*) (*x*)

must be prosecuted without delay, pp. 549 (*p*), 550 (*r*), 554 (*d*), 555 (*g*)

must be of same character as that threatened, pp. 551 (*x*), 554 (*e*)

need not be against person aggrieved, p. 551 (*x*)

but must test validity of patent or fact of infringement, p. 551 (*x*)

abandonment of when clear that it would fail, p. 555 (*g*)

validity of patent is in issue, p. 552 (y)

procedure in action to restrain,

particulars of objection to be given by plaintiff, p. 553 (a)

after defendants have stated on what patents they rely, p. 553 (a)

certificate that validity came in question granted, p. 553 (z\*)

onus on defendants when threats were admitted, p. 554 (c)

form of order for injunction, pp. 551 (x), 553 (b)

delay, three months is *prima facie* not too great, p. 555 (g)

damages, pp. 550 (t), 552 (y), 554 (c)

costs, pp. 552 (y), 554 (e).

PATENTS ACT, 1883, sect. 32. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats:

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

### *Cases before the Act of 1883.*

#### (h) WREN v. WEILD. [1869]

Rule to set aside a nonsuit. The declaration contained counts to the effect that the plaintiffs made and sold spooling-machines, and that the defendant falsely and maliciously wrote to persons in treaty with the plaintiffs for such machines that they were infringements of a patent of the defendant's, and that if they were used he would claim royalties for their use, and, if not paid, take legal proceedings; in consequence of which the plaintiffs lost the sale of their machines. There was no allegation that the defendant did this without reasonable or probable cause, nor, except indirectly, that the defendant had any patent. Plea, not guilty, and issue thereon. At the trial the plaintiffs, after proving the facts stated in the declaration, tendered evidence to show that the defendant's patent was void for want of novelty, that the defendant himself knew the facts which would render his patent void, and that the plaintiffs' machines were no infringement of the defendant's patent.

Lush, J., was of opinion that, inasmuch as the defendant's patent was still subsisting and not set aside on *scire facias* or otherwise, this evidence was immaterial. A rule for a new trial was subsequently discharged, when it was *Held*, (1) that the evidence in question was immaterial to the issue raised; and (2) that the action would not lie unless the plaintiffs could affirmatively prove that the defendant's claim was made *malâ fide*. (*L. R.*, 4 *Q. B.* 730; 38 *L. J.*, *Q. B.* 327; 20 *L. T. Rep.*, *N. S.*, 1007.)

#### (i) DALZIEL v. RAILWAY CARRIAGE AND STEAMBOAT GASLIGHT COMPANY.

Malins, V.C., expressed an opinion: "that a man has no right to go about boasting of a patent and not attempt to try its validity." (Not reported. Cited *L. R.*, 13 *Eq.* 358.)



(i) *ROLLINS v. HINKS*. Ch. [1872]

There is no presumption in law in favour of the validity of a patent, and therefore a patentee is not entitled to publish statements of his intention to institute legal proceedings, in order to deter persons from purchasing alleged infringements of his patent, if he has no *bonâ fide* intention to follow up his threats by taking such proceedings, and the Court will in such case restrain him from making such publication. (*L. R.*, 13 *Eq.* 355; 41 *L. J.*, *Ch.* 358.)

A person alleging the invalidity of a patent is not bound to assert his claim by *scire facias*, in order to establish his right to restrain the publication of statements by the patentee, threatening with legal proceedings persons buying articles of his manufacture alleged to be infringements of the patent. (*Ib.*)

(j) *AXMANN v. LUND*. Ch. [1874]

The Court will restrain a patentee from issuing circulars threatening legal proceedings against infringers, unless he will undertake to commence proceedings to assert the validity of his patent; and the fact that the party seeking the aid of the Court was formerly a licensee of the patent under the patentee, and had himself concurred in issuing similar circulars, does not prevent the Court interfering after the expiration of the licence. *Rollins v. Hinks* followed. (*L. R.*, 18 *Eq.* 330.)

(k) *HALSEY v. BROTHERHOOD*. C. A. [1881]

A patent is *primâ facie* good as long as it stands, and the person who alleges it is not good must prove it. Therefore, a patentee who issues notices threatening actions for infringement, cannot be restrained merely because he refuses to follow up his threats by an action, but only if the statement that there is an infringement is untrue to his knowledge, or is not made *bonâ fide*, or is proved to be untrue at the time of the action at which the injunction was sought. (15 *Ch. D.* 514; 19 *Ch. D.* 386.) The defendant was the holder of a patent for engines, the validity of which was not impeached. Baggallay, L.J.: "I take it to be the result of the case to which I have referred (*Wren v. Weild*), that he (the defendant) was entitled to state that the engines manufactured by the plaintiffs were infringements of his patent, and to threaten proceedings against any person in respect of such infringement, provided he observed the rule that those threats must have been made with reasonable and probable cause; unless they are made with reasonable and probable cause, there would be the inference that they were maliciously made." (19 *Ch. D.* 390.)

(l) *BURNETT v. TAK*. [1882.]

The plaintiff brought an action to restrain the defendant from issuing notices to plaintiff's customers, that plaintiff, in selling goods, was infringing defendant's rights, and from threatening such customers with legal proceedings in case they should purchase

such goods, and applied for an interim injunction:—*Held*, that as the plaintiff had not satisfied the Court that the statements made by the defendant were false, there was no evidence of *malá fides*, and therefore the injunction was refused. (45 *L. T.* 743.)

(m) *SUGG v. BRAY*. [1881–5]

In 1881 the plaintiff brought an action for an injunction to restrain the repetition of statements by the defendants that the plaintiff infringed the defendants' patent, which the plaintiff alleged were false and maliciously made, and for damages. In 1883 the plaintiff applied for leave to amend, by adding a claim for a declaration that he had not infringed the defendants' patents, or if he had, that those patents were bad. Leave was refused, with costs. The defendants did not commence any action in respect of the alleged infringements, but they contended that they had reasonable and probable cause for making the statements:—*Held*, that the plaintiffs had not, in fact, infringed the defendants' patent, and that the statements were unfounded; but that the plaintiffs had not proved that the defendants had not made the statements *boná fide*, in support of rights which they believed they had, and that therefore the plaintiffs were not entitled to damages nor to an injunction.

The 32nd section of the Act of 1883 does not apply to threats made before it came into operation. (1 *O. R.* 45; 2 *O. R.* 223; *Griff.* 210.)

(n) *SOCIÉTÉS ANONYMES DES MANUFACTURES DE GLACES v. TILGHMAN'S PATENT SAND BLAST COMPANY*. C. A. [1883]

The defendants, who were owners of patents in Belgium and England for an invention for making globes, by deed granted a licence to plaintiffs to use and employ the invention at their manufactory (which was in Belgium), but not elsewhere. The plaintiffs manufactured articles under this licence in Belgium, and sold them in England, and the defendants issued a circular to the trade, warning persons that such importation and sale would be a violation of the English patent. The plaintiffs' application for an injunction to restrain such issue was refused. Where a trade-circular is issued *boná fide*, an interim injunction will not be granted to restrain it, unless it is in violation of some contract, however much the balance of convenience may be in favour of granting it. (25 *Ch. D.* 1; 53 *L. J. Ch.* 1.)

(o) *SHARP v. BRAUER*. *BRAUER v. SHARP*. [1885–6].

The plaintiff, Sharp, issued a circular, threatening proceedings against persons infringing his patent for folding-screens. Brauer, a maker of folding-screens in Germany, commenced an action to restrain the issue of this circular to his customers, or persons who might become his customers, whereupon Sharp commenced an action against Brauer, and his agent in England, for infringement. The latter action was heard first, and the patent was held invalid for want of novelty. On the first action coming on for trial, *Held*,

that at the time the circular was issued, the defendant had a right to advertise himself as patentee, and that there was no evidence of malice on his part. That, therefore, there could be no damages, and no injunction. Section 32 was not referred to in the judgment. In the circumstances, the action was dismissed without costs. (3 *O. R.* 193; *Griff.* 205.)

*Cases since the Act of 1883.*

(p) *BARNETT v. BARRETT'S SCREW-STOPPER COMPANY.* [1884]

The defendant company issued a circular, stating that a "so called" patent stopper of Barnett and Foster was an infringement of their patent, and that they were about to take proceedings against Barnett and Foster, and every one who used the stopper. Barnett and Foster commenced an action under section 32, and moved for an interlocutory injunction. It appeared that the defendants were exclusive licensees of the patent for an area of twelve miles round London, and that the patentee had commenced an action against Barnett and Foster for infringement, and that the defendants were to be joined as co-plaintiffs in that action. Pearson, J., said: "I do see this, that a motion of this kind being made a defendant might, simply to stave off proceedings, issue a writ and nothing more, and then, when it had served his purpose, he might discontinue the action and the Court might be in great difficulties to know what to do. If a new motion were made, he might say, 'I do not mean to continue writing any more letters or circulars. You cannot get an injunction, because we have told you we do not mean to write any more.' Therefore I think the better course will be to adjourn this motion until the result of the action is known, with liberty to apply, and reserving all questions of costs." (1 *O. R.* 9, at p. 10; *Griff.* 47.)

(q) *BARNEY v. UNITED TELEPHONE COMPANY.* [1885]

The plaintiff having advertised that he was prepared to supply the Boulton telephone, the directors of the defendant company issued an advertisement, warning the public that they were advised that the Boulton telephone was an infringement of their patent rights, and that proceedings would be taken to protect their rights. The defendants' solicitors had refused to make the plaintiff sole defendant in an action for infringement, on the ground that he was not in a position to pay damages or costs. On motion for an interlocutory injunction, Chitty, J., said: "I will assume, for the purpose of this judgment, that it comes within section 32. Under that section the Court can grant an injunction against the continuance of this threat, and that I am now asked to do. But the section contains this condition: 'If the manufacture, use or sale to which the threat relates is not, in fact, an infringement of any legal right of the person making the threats.' Now it appears that there is a serious question between the parties as to whether there is, in fact, an infringement or not, . . . and that is a question which I cannot decide on the present materials. That being so, there can

be no injunction granted, because the plaintiff is unable to prove that there was not, in fact, an infringement, and he is not able even to present to the Court such a case as would show that, probably even at the trial, that result would be brought about. That being so, I have nothing to do with the proviso at the end." (28 *Ch. D.* 394; 52 *L. T.* 573; 33 *W. R.* 576; 2 *O. R.* 173; *Griff.* 48.)

(r) *HOUSEHOLD AND ROSHER v. FAIRBURN AND HALL.* [1884-5]

The plaintiffs, who were the makers of water elevators, commenced an action to restrain the defendants from continuing to issue a circular cautioning the public against the use of such elevators, as being infringements of the defendants' patents, and gave notice of motion for an injunction. The defendants commenced a cross action to restrain the plaintiffs from infringing their patents:—*Held*, that as there was no evidence of *malâ fides* on the part of the defendants, they ought not to be restrained from issuing the circular until the action had been disposed of, but that they must undertake to prosecute their action with due diligence. The defendants, in fact, prosecuted their action as leisurely as they could, and the plaintiffs again moved in the original action for an injunction to restrain the issue. The injunction was granted. (51 *L. T. Rep., N. S.*, 498; 1 *O. R.* 109; 2 *O. R.* 140; *Griff.* 131.)

(s) *WILSON AND CO. v. WALTER E. CHURCH ENGINEERING COMPANY.* [1885.]

The defendant company had commenced an action for infringement against the plaintiffs. The plaintiffs subsequently commenced an action under sect. 32, and applied for an injunction *ex parte* on an affidavit that the defendants had claimed royalties on machines supplied by the plaintiffs:—*Held* not to be a case for an *ex parte* injunction, but that notice of motion must be given. (2 *O. R.* 175.)

(t) *DRIFFIELD LINSEED CAKE COMPANY v. WATERLOO MILLS CAKE COMPANY.* [1886]

The words "Threats by circulars, advertisements, or otherwise," in sect. 32, include threats by private letter to the person charged with infringement, the words "or otherwise" not being restricted to communications *ejusdem generis* with circulars or advertisements. The solicitor to the defendants sent a letter to the plaintiffs alleging an infringement of defendants' patents, and threatening proceedings. The plaintiffs asked for particulars. The defendants' solicitors refused to give the details asked for, but again threatened proceedings. No proceedings were taken, and in their defence to this action the defendants at first alleged an infringement, but afterwards struck out the allegation. A perpetual injunction was granted, with costs. The plaintiffs further claimed damages, and alleged that since the defendants' threats, they had stopped the progress of certain new works. Their business had not been sus-

pendent :—*Held*, that there was no case for an inquiry as to damages. (31 *Ch. D.* 638; 55 *L. J.*, *Ch.* 391; 54 *L. T. Rep.*, *N. S.*, 210; 34 *W. R.* 360; 3 *O. R.* 46; *Griff.* 80; 2 *T. L. R.* 314.)

(u) *WALKER v. CLARKE.* [1887]

On a motion for an interim injunction, under sect. 32, to restrain threats, it is not necessary for the plaintiff, in every case as a condition precedent, to prove that he has not infringed the defendant's patent; but the question is one of the balance of convenience and inconvenience, and the Court will decide according to its opinion whether more harm will be done by granting or refusing an injunction. (56 *L. J.*, *Ch.* 239; 56 *L. T. Rep.*, *N. S.* 111; 3 *T. L. R.* 297; 4 *O. R.* 111; 35 *W. R.* 245.)

(v) *GOULARD v. LINDSAY.* [1887]

The plaintiffs, having brought an action for infringement, pending the trial issued advertisements, stating that in consequence of the continued infringement of their patent by the defendants they had commenced an action against the defendants, and that actions would be commenced against all persons employing or using apparatus which was not according to the letters patent without the leave of the patentees :—*Held*, that notwithstanding the proviso at the end of sect. 32, the plaintiffs were not justified in issuing advertisements containing a positive statement that defendants had infringed. (56 *L. T. Rep.*, *N. S.*, 506; 4 *O. R.* 189.)

(w) *FUSEE VESTA COMPANY v. BRYANT AND MAY.* (No. 2.) [1887]

The plaintiffs having commenced an action for infringement, asked for leave to apply to disclaim, and that, pending the decision thereon, further proceedings might be stayed. Having obtained, on terms, the order asked for, the plaintiffs sent circulars to customers of the defendants, threatening legal proceedings. The defendants, as the proceedings were stayed, did not bring in a counter-claim, under sect. 32, but moved for an injunction to restrain the threats :—*Held*, that the Court had jurisdiction to grant the injunction asked for. (56 *L. T. Rep.*, *N. S.* 136; 3 *T. L. R.* 408.)

(x) *CHALLENGER v. ROYLE.* C. A. [1887]

Sect. 32 consists of two parts: the first part contains directions as to what circumstances will enable a person threatened to obtain judgment in an action; the second part contains a proviso which excepts certain cases from the section, so that if a case comes within the proviso, it must be dealt with under the old law. The first part contemplates a final judgment, and in order to obtain an interlocutory injunction, the plaintiff must make out a *prima facie* case, i.e. a case such that, if the evidence remains the same at the hearing, it is probable that he will obtain a decree, and unless he makes out such a case, an injunction will not be granted on the mere balance of convenience and inconvenience. *Primâ facie*

the onus is on the plaintiff to show that what he did was "not an infringement of any legal right," and (*semble*) for that purpose, he may call in question the validity of the defendant's patent.

Challender brought an action against Royle, under sect. 32, to restrain Royle from issuing threats against persons selling Challender's patent articles. After the issue but before service of the writ, Royle commenced an action for infringement against a company who were selling Challender's articles:—*Held*, that the case was within the proviso, for that in order to bring the case within the proviso, the action need not be against the person aggrieved, but may be any action to test the validity of the patent, or the fact of infringement honestly brought with reasonable diligence against any of the persons to whom the threats have been made, and that in considering whether such action is brought with due diligence, the time of issuing the threats, and not the time when the party bringing the action first knew of the alleged infringements, is the period to be looked at. (36 *Ch. D.* 425; 3 *T. L. R.* 790; 4 *O. R.* 363.)

In this case the order made by Bristowe, V.-C., was substantially in the terms of the notice of motion, viz., to restrain the defendant, personally or by his servants, agents and workmen, by circulars, letters, or otherwise, from threatening any person with legal proceedings or liability in respect of the manufacture, use, sale, or purchase, of a certain tap-union, of which the plaintiff was patentee, and from interfering by such threats, or otherwise, with the manufacture, use, sale, or purchase, of the plaintiff's invention. (36 *Ch. D.* 427.)

(*y*) KURTZ *v.* SPENCE. C. A. [1887]

Formerly, in an action for an injunction against threats by a person claiming the benefit of a patent, the two issues were: first, the good faith of the person making the threat; second, whether the person threatened was in fact infringing the patent. The validity of the patent was not in issue. (33 *Ch. D.* 581.) In an action under sect. 32, the plaintiffs alleged that the defendant's patent, which they were accused of infringing, was invalid.

Chitty, J., being of opinion that the words in sect. 32, "not in fact an infringement of any legal rights," did not allow the plaintiff to put in issue the validity of the patent, ordered the allegation to be struck out. (33 *Ch. D.* 579.) Subsequently the case was transferred to Kekewich, J., and the remarks in the case of *Challender v. Royle* having meantime established a contrary view of the law, and the time for appeal being passed, the plaintiffs applied for leave to amend by again alleging the invalidity of the patent. The application was refused, but, on appeal, leave to amend was given by the majority of the Court of Appeal on the terms that the plaintiffs should pay solicitor and client's costs of the application, and all costs incurred and wasted, and that the defendants should have the same notice of objections, and the same rights of beginning and replying as they would have had if they had brought an action for violation of their

patent. (36 *Ch. D.* 770; 3 *T. L. R.* 827; 4 *O. R.* 427.) Ultimately it was held that the patent was void, on the ground of part of the invention claimed being impracticable, and that the plaintiffs were entitled to an injunction, and forty shillings damages. (5 *O. R.* 161.) (33 *Ch. D.* 579; 36 *Ch. D.* 770; 55 *L. J., Ch.* 919; 3 *T. L. R.* 827; 55 *L. T. Rep., N.S.*, 317; 35 *W. R.* 26; 3 *O. R.* 368; 5 *O. R.* 161.)

(z) *BURT v. MORGAN AND CO.* [1887]

The plaintiff was a patentee of an invention for improvements in carriage springs. The defendants wrote to customers of licensees of the plaintiff, who had fitted the plaintiff's springs to carriages, stating that the springs were infringements of the defendants' patents. The defendants were prosecuting an action for infringement against certain persons other than the plaintiff:—*Held*, that the plaintiff was a person aggrieved, within sect. 32, and was entitled to an injunction, or an undertaking to abstain from threatening. (4 *O. R.* 278; *W. N.* 1887, 123; 3 *T. L. R.* 666.)

(z\*) *CRAMPTON v. PATENTS INVESTMENT COMPANY.* C. A. [1888]

In an action to restrain threats, the Court having held that the defendants' patent was valid, and had been infringed, gave a certificate that the validity of the patent came in question without prejudice to the validity of such certificate. (5 *O. R.* 382.) The words "or otherwise" in section 32 of the Patents Act are not confined to matters *ejusdem generis* with circulars or advertisements, and may include threats made by a solicitor's letter. (*Ib.* 393.) An appeal as to the question of validity was dismissed. (6 *O. R.* 287.)

(a) *UNION ELECTRICAL POWER AND LIGHT COMPANY v. ELECTRICAL STORAGE COMPANY.* C. A. [1888]

The defendant company caused a notice to be inserted immediately below the plaintiffs' advertisement in the *Standard*, to the effect that the defendants were the owners of patents for various specified modes of construction of secondary batteries, and that every manufacturer or individual user of secondary batteries of such construction, without licence from the defendants, rendered himself responsible for such unlawful manufacture or use. The defendants also sent threatening letters to the plaintiffs' customers. The plaintiffs alleged that the defendants' patents were all invalid, and applied for an injunction to restrain the threats. The defendants applied for particulars of objections to their patents. Ordered, that on the defendants giving a list of the patents on which they intended to rely, the plaintiffs should within three weeks deliver particulars of objections to the validity of those patents. (38 *Ch. D.* 325; 5 *O. R.* 329.)

(b) *COLLEY v. HART.* [1888 and 1890.]

Form of order to restrain threats in *Challender v. Royle*, (36 *Ch. D.* 427), followed by North, J. In an action to restrain threats, when

there is a doubt whether the thing does infringe what the defendant calls his rights, the fact that the defendant does not bring an action to assert his rights is a fact to be considered in forming an opinion whether he has such rights or not. (6 O. R. 17.)

(c) *UNGAR v. SUGG AND Co.* [1889]

Action for an injunction to restrain threats in respect of some lamps supplied by the plaintiff and alleged to be infringements of the Sugg patent. The threats were admitted, and it was held by Huddleston, B., that on the pleadings the onus was on the defendants. The jury was asked whether the lamps supplied by the plaintiffs were substantially copies of the Sugg patent, and gave a verdict for the plaintiff, and an injunction was granted with an inquiry as to damages. (5 T. L. R. 373; 6 O. R. 337.)

(d) *HERBURGER SCHWANDER ET CIE. v. SQUIRE.* [1889]

The defendant, Squire, in an action to restrain threats, made the threats in October, 1886, and September, 1887. The action was commenced in October, 1887. In November, 1887, the defendant commenced two actions against other persons, and in December he counterclaimed for infringement:—*Held*, that he had not shown due diligence. An injunction to restrain was granted under sect. 32, although the claim was framed as if for slander of title, and not under sect. 32. (5 O. R. 589; 6 O. R. 194.)

(e) *COMBINED WEIGHING AND ADVERTISING MACHINE COMPANY v. AUTOMATIC WEIGHING MACHINE COMPANY.* [1889]

In consequence of two letters, dated September 21st, 1887, sent by the solicitors of the defendant company, the plaintiff company, on September 27th, 1887, having simply acknowledged the receipt of one of the letters which was addressed to them, commenced this action to restrain threats. On September 30th the defendant company commenced an action against the plaintiffs for infringement. The defendants having written another threatening letter to one of the plaintiffs' customers, the plaintiffs applied to North, J., for an interim injunction, but were refused, and given liberty to apply if the infringement action were not prosecuted with due diligence. On April 27th, 1888, the plaintiffs in this action offered to stay proceedings until the action for infringement was concluded; but the defendants refused, and threatened to apply for judgment, and accordingly the plaintiffs set the action down for trial, and the two actions were tried together. Kekewich, J., held that the infringement was proved, and accordingly dismissed the action for threats with costs. The Court of Appeal *held* that the combined company had not infringed, and reversed the judgment in the action for threats, and referred it back to Kekewich, J., to deal with the costs. (6 O. R. 367.) The Automatic Company had, prior to the threats in question, instituted and prosecuted an action against another defendant for other infringements:—*Held*, by Kekewich, J., (1)



that this latter action did not bring the defendants within the proviso in section 32, because it was not an action for an infringement of the same character as that which was threatened; (2) that the solicitors' letters were "threats;" (3) that there was no impropriety in the plaintiffs commencing this action to restrain threats, without first communicating with the defendants' solicitors; (4) that although this action was properly commenced, yet the action for infringement against the plaintiffs was commenced and prosecuted with due diligence, and that therefore section 32 ceased to apply; (5) that it was therefore impossible to make the defendants pay costs, but that, owing to their conduct, they ought not to have them. (6 *O. R.* 502; 42 *Ch. D.* 665; 58 *L. J. Ch.* 709.) [As to staying the payment of costs in the infringement action pending the other action, see 37 *W. R.* 636; 57 *L. J. Ch.* 647.]

(f) *DAY v. FOSTER: BARRETT AND ELSERS, LIMITED, v. DAY.*

Day being a patentee of an improved bottle, granted an exclusive licence to Foster to use part of the invention, called the trigger-opener. Subsequently Foster obtained a licence from Barrett and Elers, who were the owners of a later patent for improvements in the opening of internally-stoppered bottles, and claimed to make trigger-openers under this latter licence without paying royalties to Day. Day's solicitors, in December, 1888, wrote to Foster's solicitors, that Barrett and Elers' specification was clearly an infringement of Day's patent, and that, in the action against Foster, claims would be made in respect of this patent. Barrett and Elers, who were assisting Foster, and employing the same solicitors, required Day to withdraw such threats, or to commence an action to make them good. In April, 1889, Day commenced an action against Foster only to restrain infringement, and alleged therein that the trigger-openers of Barrett and Elers' patent did not differ materially from his (Day's) invention. Barrett and Elers asked to be joined as defendants in this action, but were refused, and in August, 1889, commenced an action against Day to restrain threats. Cross summonses to stay proceedings were then taken out by Day in the last, and by Foster in the first action:—*Held*, that the letter to Foster's solicitors gave a cause of action, under section 32, to any person aggrieved thereby, but that Day's action was an action for infringement within the proviso; that it was not necessary that such an action for infringement should be brought after the action for threats, nor that it should be an action in which the validity of the patent could be tried; that Day's action was brought with due diligence, and that therefore Barrett and Elers had no cause of action:—*Held*, also, that Barrett and Elers' action was vexatious, and must be stayed; it being clear that no relief could be granted at the trial. (7 *O. R.* 54; 43 *Ch. D.* 435.)

(g) *COLLEY v. HART.* [1890]

The plaintiff asked for an injunction to restrain threats by a circular which the defendant had issued on September 15th, 1888.

The writ was issued on September 22nd. In November, 1888, the defendant commenced an action for infringement; but being subsequently advised that he would fail, in November, 1889, he discontinued the action, and paid the costs:—*Held*, that although it was impossible to fix any rule as to the time within which an action would be commenced with due diligence, according to section 32, yet that *prima facie* three months was not too long, and this action was within that period. A defendant, in an action to restrain threats, is entitled to wait until the statement of claim is delivered, in order to see if he can counterclaim for infringement:—*Held*, further, that as the action had only been abandoned when it was seen that it would probably fail, it had been prosecuted with due diligence, and that therefore the defendant came within the proviso of section 32, and must succeed. (44 *Ch. D.* 179; 7 *O. R.* 101; 62 *L. T.* 424; 38 *W. R.* 501.)

(h) *LAW v. ASHWORTH.* [1890]

The plaintiffs in an action to restrain threats alleged that the defendants had by letters and by advertisements in newspapers and otherwise threatened the plaintiff company and other persons with proceedings for infringement. The defendants applied for particulars of the threats alleged before delivering their defence. *Held*, that the defendants ought to be enabled at the earliest possible moment to stop the advertisements, and that full particulars should be given. (7 *O. R.* 86.)

**Time,**

for application for international patent, within seven months from foreign application, Patents Act, 1883, sect. 103, p. 61

for application by personal representatives of inventor, six months from death, sect. 34 (2), p. 81

for appeal from comptroller, notice to be filed within fourteen days of decision, Rule 5, p. 380

but comptroller or law officer may allow further time, Rule 5, p. 380

for opposition to grant, notice to be given within two months of advertisement of acceptance of complete specification, sect. 11, p. 38

for notice of opposition to amendment, within one month from advertisement, sect. 18 (2), p. 10

for opponent of grant to file evidence, fourteen days from end of two months, Rule 37, p. 39

for applicant to file evidence in answer, fourteen days from delivery of list of opponent's evidence, Rule 38, p. 39

for opponent to file evidence in reply, fourteen days, Rule 38, p. 39

for patentee's evidence in opposition to petition for compulsory licence, fourteen days, Rule 64, p. 78

for petitioner for compulsory licence to reply, fourteen days, Rule 65, p. 78

when Patent Office is open, Patent Rules 7, p. 558

of notice by comptroller to applicant of hearing upon question of amendment, ten days, Rule 11, p. 36

by law officer of hearing of appeal, seven days, Rule 6, p. 380

by comptroller of hearing on opposition, ten days, Rule 41, p. 39

for payment of renewal fees, Rules 45 to 48, p. 558

enlargement of, Patent Rule 49, p. 558

prescribed by Rules may be enlarged, Rule 51, p. 558.

*For filing and sealing—*

for leaving complete specification, within nine months from application, sect. 8, p. 557

may be extended by comptroller for one month, Patents Act, 1885, sect. 3, p. 557

for accepting complete specification, twelve months, sect. 9 (4), p. 557

may be extended by comptroller for three months, Patents Act, 1885, sect. 3, p. 557

for sealing patent, fifteen months from application, sect. 12 (3), p. 557

may be extended by comptroller for four months, Patents Act, 1885, sect. 3, p. 557

computation of, whether exclusive or inclusive, p. 58 (g)

extension of when delay due to opposition, p. 558 (j)

or to non-delivery of letter, p. 558 (k)

not where there has been neglect, p. 59 (h).

*Of expiration of Patent—*

fourteen years from date, Patents Act, 1883, sect. 17 (1), p. 559

or on failure to make payment, sect. 17 (2), p. 559

unless enlargement granted by comptroller, sect. 17 (3) and (4), p. 559

fourteen years reckoned inclusively of day of date, p. 559 (j)

three years reckoned exclusively, p. 559 (k).

*For Filing and Sealing.*

PATENTS ACT, 1883, sect. 8. (1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.

(2) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

Sect. 9 (4). Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept), the application shall at the expiration of those twelve months, become void.

Sect. 12 (3). A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned, that is to say—(a) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct. (b) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

PATENTS ACT, 1885, sect 3 (recites these sections, and that it is expedient to empower the comptroller to extend in certain cases the said times and enacts): A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

PATENTS ACT, 1883, sect. 98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a

Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

PATENT RULES, 1890, 7. The Patent Office shall be open to the public every week day between the hours of ten and four, except on the days and times following:—Christmas Day. Good Friday. The day observed as Her Majesty's birthday. The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

45. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to keep the same in force, he shall, before the expiration of such fourth or eighth year, as the case may be, subject as hereinafter provided, pay the prescribed fee of 50% or 100%, as the case may be.

46. In the case of patents granted before the commencement of the said Acts, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year."

47. If the patentee intends to pay annual fees in lieu of the above mentioned fees of 50% and 100%, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the 13th year thereof, pay the prescribed fee. The form J in the second schedule, duly stamped, should be used for the purpose of this and the payment referred to in Rule 45.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the comptroller shall issue a certificate that the prescribed payment has been duly made.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake or inadvertence has failed to make such payment, and the comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

50. An application for enlargement of time for leaving or accepting a complete specification shall state in detail in what circumstances and upon what grounds such extension is applied for, and the comptroller may require the applicant to substantiate such allegations by such proof as the comptroller may think necessary.

51. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

(j) *In re* SIMPSON AND ISAACS' PATENT. [1853]

A petition for a patent was lodged on the 2nd October, and the warrant to seal the patent was issued on the 9th of February following. By reason of objections having been filed to the application, and to the warrant to seal, the patentees were unable to file their specification within six months from the date of the letters patent. Time extended, on petition, to seven months. (21 *L. T. Rep.* 81.)

(k) *In re* HARRIS' PATENT. [1855]

Leave was granted to file a specification after the time for that purpose had expired, when the delay had arisen solely from the

non-delivery of the letter containing the proper instruction for filing. (25 *L. T. Rep.* 90.)

*Time of Expiration of Patent.*

PATENTS ACT, 1883, sect. 17. (1.) The term limited in every patent for the duration thereof shall be fourteen years from its date.

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

(3.) If, nevertheless, in any case, by accident, mistake or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment.

(4.) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:—

(a.) The time for making any payment shall not in any case be enlarged for more than three months.

(b.) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

(j) *RUSSELL v. LEDSAM.* [1845]

Original letters patent were granted on the 26th February, 1825, and renewed letters patent were dated on the 26th February, 1839:—*Held*, that the day of the date must be reckoned inclusively, and that the former term expired on the 25th February, 1839, and consequently the renewed letters patent were granted after the original letters patent had expired. (14 *M. & W.* 574; 14 *L. J. Exch.* 353.)

(k) *WILLIAMS v. NASH.* [1859]

The day of the date of the letters patent is excluded, and the three years do not expire until twelve o'clock at night of the anniversary of the day on which the letters patent are granted. (28 *Beav.* 93; 28 *L. J. Ch.* 886.)

**Title.**

*Generally—*

specification must commence with, Patents Act, 1883, sect. 5 (5), p. 560  
examiner to report whether it sufficiently indicates subject-matter, sect. 6, p. 560

if not comptroller may require application, specification or drawings to be amended, Patents Acts, 1883, sect. 7 and 1888, sect. 2, p. 560

to be read with specification, pp. 560 (*k*), 561 (*n*), 566 (*c*), 567 (*f*), 568 (*l*)

discloses object of invention, pp. 560 (*l*), 566 (*e*)

how affected by subsequent discoveries, p. 560 (*m*).

*Largeness of—*

ambiguity, pp. 562 (*g*), 567 (*f*) (*h*)

vagueness, pp. 563 (*s*), 564 (*v*) (*w*), 567 (*f*) (*g*) (*h*)

*Variance from specification—*

by introducing improvement, p. 566 (*d*)

*Title Generally.*

PATENTS ACT, 1883, sect. 5 sub-sect. (5). A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

Sect. 6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

Sect. 7 amended by Patents Act, 1888, sect. 2. For sect. 7 of the principal Act the following section shall be substituted, namely :—

- “7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.
- “(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.
- “(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.
- “(4.) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.
- “(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.”

(k) *HORNBLOWER v. BOULTON.* [1799]

Grose, J., said : “I consider the patent (title) and specification so connected together as to make a part of each other, and that to learn what the patent is I may read the specification, and consider it as incorporated with the patent.” (*Dav. P. C.* 230.)

(l) *THE HOUSEHILL COMPANY v. NELSON.* N. P. [1843]

The title of a patent discloses the object of the invention. (*1 Web. P. C.* 678.)

(m) *THE ELECTRIC TELEGRAPH COMPANY v. BRETT.* [1851]

Patent “for improvements in giving signals and sounding alarums in distant places, by means of electric currents transmitted through metallic circuits.” Subsequently to the patent, it was

discovered that the return current could be conducted back to the battery through the earth as effectually as through a continuous metallic circuit, and this was the method used by the defendants. Cresswell, J., delivering the judgment of the Court, said: "With regard to the use of the words 'metallic circuits' in the title of the patent, it was urged that the patentees, by using those words, would mislead a person who was in possession of improvements identical with the plaintiff's, but which he intended to use in giving signals by non-metallic circuits, and who might have opposed the grant of a patent of a more comprehensive title, but would acquiesce in one confined to metallic circuits. But it appears to us, that, whatever might be the case, supposing currents transmitted in the manner used by the defendants to have been known at the time of granting the patent, or of giving notice of the application for it, the title did, in the actual circumstances of the case, that is to say, the earth-circuit not being publicly known, give sufficient notice to any person secretly acquainted with that discovery, or thinking it probable that some such discovery might be made, and having also invented improvements like those of the patentees, to put him on his guard, and on an inquiry how far the proposed patent might interfere with him." (10 *Com. B. Rep.* 881; 20 *L. J., C. P.* 130; 15 *Jur.* 582.)

(n) *NEWTON v. VAUCHER.* [1851]

The title of a patent, which should be read in conjunction with the specification, may limit a patentee's claim, which would otherwise have voided the patent as being too large. (6 *Ex.* 866; 21 *L. J., Ex.* 308.)

(n\*) *HILLS v. THE LONDON GAS LIGHT COMPANY.* [1860]

The title of a patent was for "an improved mode of manufacturing gas." The invention consisted in the application of the hydrated oxides of iron in purifying gas from sulphuretted hydrogen, and in renovating the oxides so used by exposure to the air. The Court held this to be an improved mode of manufacturing gas. (5 *H. & N.* 370; 29 *L. J., Ex.* 424.)

(o) *BROWN'S PATENT.* [1887]

The title being for "improvements in casks and tubs," the specification described the invention as applicable to tubs and analogous vessels in which the staves were formed with a groove. *Held*, by the law officers that the title was sufficient. (2 *Griff.* 1.)

*Largeness of Title.*

(o\*) *REX v. ELSE.* [1785]

The patent was for a newly invented manufacture of lace, called French, or wire-ground lace. The specification went generally to the invention of mixing silk and cotton thread upon the frame. It was proved that this was not new. It was contended, in answer, that the former use was inadequate to the purpose of making lace on account of its coarseness, and that the patentee was the first to

succeed in uniting strength and fineness. Buller, J., held the patent void, as the claim (expressed in the title) went to the exclusive liberty of making lace composed of silk and cotton thread mixed, and not to any particular mode of making it. (1 *Web. P. C.* 76; *Dav. P. C.* 144; *Bull. N. P.* 76.)

(p) *COCHRANE v. SMETHURST.* [1816]

A patent was granted for "a method or methods of more completely lighting cities, towns, and villages." The invention described consisted of improvements in street lamps:—*Held*, that the patent was void, on the ground of the title being too large. The patent ought to have been taken for an improvement in street lamps. (*Dav. P. C.* 354; 1 *Stark, N. P.* 205.)

(q) *CAMPION v. BENYON.* [1821]

Where a patent was obtained, for "a new and improved method of making and manufacturing double canvas and sail cloth with hemp and flax, without any starch whatever," and the specification described the invention to consist in an improved texture, or mode of twisting the threads, to be applied to the making of un-starched cloth; on its being proved that the exclusion of starch had been before adopted:—*Held*, that such patent was void, as being taken out for more than the patentee had really discovered. Dallas, C.J.: "If there be any ambiguity, either in the patent itself, or in the specification, in any material point, it is of itself a ground for rendering the patent absolutely void." (6 *B. Mo.* 71; 3 *B. & B.* 5.)

(r) *BRUNTON v. HAWKES.* [1821]

A patent was granted for improvements in the construction of ships' anchors, windlasses, and chain cables. It was proved at the trial, that the windlasses and chain cables were new, but that the anchors had been before constructed and used. The patent was held bad for want of a consideration, upon the authority of *Hill v. Thompson*. Abbott, C.J., said: "The consideration is the entirety of the improvement of the three; and if it turns out there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention." (4 *B. & Ald.* 552.) Best, J., based his judgment expressly upon the ground of fraud. He said the patentee had "taken out his patent for more than he is entitled to; and I am of opinion that that avoids the patent *in toto*. For the King is deceived; the patentee is represented to have the merit of inventing two things, whereas he has discovered only one; and the Crown might have considered the discovery, as to both, a sufficient ground for granting a patent, when it would not have thought so of the discovery of one alone. . . . The united consideration upon which the whole grant was made, is therefore void, and, consequently, the grant itself is void." (*Ib.* 558.)

(s) *BLOXAM v. ELSEE.* [1827]

Action for the infringement of a patent for "a machine for



making paper in single sheets, without seam or joinings, from 1 foot to 12 feet and upwards wide, and from 1 foot to 45 feet and upwards in length." It appeared in evidence, that the machine was so constructed as to be capable of producing paper of one definite width only, and that in order to vary the width a new machine was required. It was held by the Court of King's Bench, that the meaning of the patentee's representation was, that paper of various widths might be obtained by one and the same machine; and, as that representation, which was a material one, was not true, the consideration for the grant had failed, and the patent was void. (6 *B. & C.* 169; 9 *Dow. & Ry.* 215.)

(s) *STURTZ v. DE LA RUE.* [1828]

The patent was "for certain improvements in copper and other plate printing." The specification declared that "the nature of the invention consisted in putting a glazed or enamelled surface on paper, to be used for copper and other plate printing, by means of whitelead and size, whereby the finer lines of the engraving are better exhibited than heretofore, and also in a mode of polishing the said enamel, and the impression after it has been drawn from the plate. Lord Lyndhurst, L.C.: "The description in the patent must unquestionably give some idea, and, so far as it goes, a true idea of the alleged invention, though the specification may be brought in aid to explain it. The title in this patent is for 'certain improvements in copper and other plate printing.' Copper-plate printing consists of processes involving a great variety of circumstances; the paper must be of a particular description: before it is used, it must be damped; it must remain damp a certain time, and must be placed in a certain temperature; the plate must be duly prepared, and duly applied, and various processes must be gone through, before the impression is drawn off and brought to a finished state. An improvement in any one of those circumstances,—in the preparation of the paper, for instance, or the damping it, &c.—may truly be called an improvement in copper-plate printing." (5 *Russ.* 322.)

(t) *FELTON v. GREAVES.* N. P. [1829]

A patent was granted for "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments." As the machine described in the specification would not do for sharpening scissors, the patent was held void. (3 *C. & P.* 611.)

(u) *MORGAN v. SEAWARD.* [1837]

The patent was taken out "for certain improvements in steam engines and in machinery for propelling vessels; which improvements are applicable to other purposes." The jury found that the alleged invention was not an improvement in steam engines. Parke, J., delivering the judgment of the Court, said: "Upon the authorities we feel obliged to hold that the patent is void, upon the ground of fraud on the Crown. . . A patent for two or more

inventions, when one is not new, is void altogether, as was held in *Hill v. Thompson*, and *Brunton v. Hawkes*; for, although the statute invalidates a patent for want of novelty, and, consequently, by force of the statute, the patent would be void as far as related to that which was old, yet the principle on which the patent has been held to be void altogether, is, that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it." (1 *Web. P. C.* 196; 2 *M. & W.* 561; *Mur. & H.* 60; 1 *Jur.* 529.)

(v) *STEAD v. WILLIAMS.* N. P. [1843]

Action for the infringement of a patent "for making or paving public streets and highways, and public and private roads, courts and bridges, with timber or wooden blocks." The defendants pleaded, *inter alia*, "that the title, in its claim, was too large, uncertain, inapplicable, inexplicable, inconsistent, vague and ambiguous, and at variance with the specification." Cresswell, J., referring to this, said: "Whether it is too vague or not is rather a matter of law than anything else, and upon that I also say that I am in favour of the plaintiff. I think that it is not too vague, and therefore I advise you to find that issue for the plaintiff." (2 *Web. P. C.* 137.)

(w) *COOK v. PEARCE.* [1844]

The patent was taken out "for improvements in carriages," and the invention was an improvement in German shutters, which could only be used in some kinds of carriages:—*Held*, that, by reason of the title of the invention being too large and general, the patent was void. (8 *Q. B.* 1050; 12 *L. J., Q. B.* 190; 7 *Jur.* 765.) This decision was reversed on appeal. Tindal, C.J., delivering the judgment of the Exchequer Chamber, said: "The mere vagueness of the title appears to us to be an objection that may well be taken on the part of the Crown, before it grants the patent, but to afford no ground for avoiding the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown, in obtaining the patent with such title, the patent in those cases might, undoubtedly, be held void. Any evidence of a design on the part of the inventor to choose a vague and general title, in order that he might avail himself, at the time of the enrolling of the specification, of an invention not discovered by him at the time of taking out the patent, or in order to prevent other subjects of the Queen from availing themselves of a discovery made by them, upon the ground of its falling within the range of the general terms of the title, although such invention was different from that for which the patent was really and in truth taken out, might afford such proof of fraud upon the Crown and such injury to the subject, as that the vagueness and generality of the title in such case might avoid the patent. But, in the present case, no such evidence was given, nor was

the existence of fraud suggested; but the patent has been held void (in the Court below), upon the mere ground of the title being so large as to be capable of comprising a different invention from that which is described in the specification, and from no other cause." (8 Q. B. 1064; 8 Jur. 500; 13 L. J., Q. B. 192.)

(x) CROSSLEY v. POTTER. N. P. [1853]

Pollock, C.B., in summing up to the jury, said: "In the year 1842, Mr. Thompson, a weaver and machinist, takes out a patent for an improvement in weaving figured fabrics; and one of the objections of the defendants to the patent, stated in the notice of objections, is, that the patentee has taken out his patent for an invention entitled, 'Improvements in weaving figured fabrics,' and that these improvements are applicable to a certain class of figured fabrics only, namely, those which have a terry surface. That objection, in my opinion, is not well founded. The improvement in a particular portion of figured fabrics may be well called, I think, an improvement in weaving figured fabrics. Though it be not applicable to all, it is an improvement in the general weaving of figured fabrics; though it may not apply itself to any particular individual case, I think there is nothing wrong in that." (*Macr. P. C.* 242.)

(y) NEWALL v. ELLIOTT. [1864]

Pollock, C.B., stated that he had, when Attorney-General, refused an application for a patent for "an improvement in locomotion," such a title being too general. (13 W. R. 15; 10 Jur., N. S. 955.)

(y\*) BROWN'S PATENT. [1887]

The patentee is entitled to frame his title in his own way, provided he does not infringe the rules of the statute. (2 Griff. 1.)

#### *Variance between Title and Specification.*

(z) BAINBRIDGE v. WIGLEY. N. P. [1810]

Action for the infringement of a patent for improvements on the flageolet. The specification stated that by the improvements the instrument produced notes not before produced on the old instrument. It appeared also in evidence, that the invention was a great improvement, but that only one new note was produced. Ellenborough, C.J., held, that this was fatal to the patent, the consideration on which it was granted not being truly stated. For the patentee had stated that, by his improvements, he had given new notes, when in fact he had given but one new note. (*Parl. Rep. Pat.* 1829, p. 197; 18 Rep. Arts. 127; 1 Carp. P. C. 270.)

(a) REX v. METCALF. *Sci. fac.* [1817]

This was a *scire facias* brought to repeal a patent, obtained by the defendant, for the manufacture of hair brushes, which were

described to be tapering brushes. The specification directed a method of making brushes in which the bristles would be of unequal lengths. Lord Ellenborough: "If the word tapering be used in its general sense, the description is defective; there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be received in its perverted sense." No such evidence being given there was a verdict for the Crown. The Court subsequently refused a rule *nisi* for a new trial. (2 *Stark. N. P.* 249; 1 *Web. P. C.* 141 (n).)

(b) *HILL v. THOMPSON.* [1818]

A patent had been obtained for "the invention of certain improvements in the smelting and working of iron." The specification claimed certain improvements by which the iron in slags or cinders could be brought into the state of bar iron; and also the discovery of the employment of lime, to prevent that quality in iron called "cold short." At the trial for an infringement of the patent it was proved that the lime had been used for the above purpose before the date of the patent. And further, that the iron from slags and cinders had been before obtained when those materials were used in various proportions:—*Held*, that the patent was void, as the specification claimed, not an improvement upon the previous use of lime, but the discovery of its power of preventing cold short; and "if any part of the alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void." (8 *Taunt.* 375; 1 *Web. P. C.* 239; 2 *B. Moore*, 424.)

(c) *REX v. WHEELER.* *Sci. fac.* [1819]

Patent for "a new and improved method of drying and preparing malt." The specification described an invention which consisted in submitting malt, prepared by the ordinary process, to a high degree of temperature, and thus producing a colouring material for beer:—*Held*, that the patent was void, on the ground (*inter alia*), that the patent was for a different thing from that described in the specification. Abbott, C.J.: "The language of the patent may be explained and reduced to certainty by the specification; but the patent must not represent the party to be the inventor of one thing, and the specification show him to be the inventor of another; because, perhaps, if he had represented himself as the inventor of that other, it might have been well known that the thing was of no use, or was in common use, and he might not have obtained a grant as the inventor of it. . . . It was contended that this process was in truth a preparation of malt to answer a particular purpose, and that the purpose need not be noticed in the grant. It may be true in general that the purpose need not be mentioned in the grant; but if in any particular case the mention of the purpose be necessary to explain the words previously used, to show that they were not used in their ordinary and obvious sense, but in a sense limited

and confined to that particular purpose; in such a case, we think the purpose ought to be mentioned." (2 *B. & Ald.* 345.)

(d) *CROSSLEY v. BEVERLEY.* [1829]

In moving for a nonsuit it was objected that the patent was void, as, between the date of the patent and the specification, the patentee had invented improvements in the apparatus, which he described in the specification as part of his invention:—*Held*, that the insertion of these improvements in the specification not only did not render the patent void, but that it was the duty of the patentee to communicate them to the public. (9 *B. & C.* 63; 1 *Web. P. C.* 112.)

(e) *FISHER v. DEWICK.* [1838]

The patent was for improvements in machinery for making bobbin net lace. The invention was for making a spot during a particular part of the process, and was useless where that addition was not wanted. The judge at nisi prius held the title to be sufficient, and the Court of Common Pleas refused a rule *nisi* for a new trial, on the ground of misdirection; Tindal, C.J., observing that it could not, without great refinement, be said, that the invention was not an improvement in the manufacture of bobbin net lace. (Not reported on this point. Cited in the argument in *Cook v. Pearce*, 8 *Q. B.* 1056.)

(f) *NEILSON v. HARFORD.* [1841]

The patent was granted for "an invention for the improved application of air to produce heat in fires, forges, and furnaces, where bellows and other blowing apparatus are required." The invention consisted in passing the air, from the blowing apparatus, into an artificially-heated receptacle, and from thence to the furnace. It was objected, that it was doubtful whether the patent was for the invention of the application of hot air, or only for an improved mode of applying hot air. Abinger, C.B., said: "If the specification is consistent with the title, that would be sufficient." Parke, B., delivering the judgment of the Court, said: "The title of the patent is for 'the improved application of air.' Though that is ambiguous, it is sufficiently explained by the specification, and is not at variance with it, as was the case in *Rex v. Wheeler*." (8 *M. & W.* 806; 1 *Web. P. C.* 331.)

(g) *NICKELS v. HASLAM.* [1844]

The plaintiff obtained letters patent for "improvements in the manufacture of plaited fabrics." The specification described that which together amounted to but a single improvement in the mode of manufacture:—*Held*, upon the authority of *Cook v. Pearce*, that this was not such an inconsistency between the title of the patent, and the description in the specification, as to invalidate the patent. (8 *Scott, N. R.* 97; 7 *M. & G.* 378; 8 *Jur.* 474; 13 *L. J., C. P.* 146.)

## (h) BEARD v. EGERTON. [1846]

The title described the patent to be for "a new or improved method of obtaining the spontaneous reproduction of all the images received in the focus of the camera obscura." The title was held to be sufficient, on the authority of *Neilson v. Harford*, and *Nickels v. Haslam*. Cresswell, J., said: "If part of the method be new, so as to produce a result that as a whole is new, surely it may be called a new or improved method. If the method be altogether new, may it not be properly called an improved method? They seem to be convertible terms." (3 C. B. 97; 15 L. J., C. P. 270.)

## (i) CROLL v. EDGE. [1850]

A patent was granted "for certain improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting and measuring gas." In the specification, the words "therein and" were interpolated between "used" and "when." So that the specification was represented to be "for improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used therein and when transmitting and measuring gas." The patent was held bad, as the patentees specified for "a more extensive and different patent from that which was granted to them." (9 C. B. 479; 14 Jur. 553; 19 L. J., C. P. 261.)

## (j) REGINA v. MILL. [1850]

The title of the patent was "for improvements in instruments used for writing and marking, and in the construction of inkstands;" and the specification, as amended by the disclaimer, described pens and pencils, and improvements in the construction of inkstands:—*Held*, that there was no variance. (10 C. B. 379; 1 L. M. & P. 695; 15 Jur. 59; 20 L. J., C. P. 16.)

## (k) PATENT BOTTLE ENVELOPE COMPANY v. SEYMER. [1858]

A patent was granted for "improvements in the manufacture of cases or envelopes for covering bottles." The specification, after describing the apparatus, in the arrangement of which the invention was stated to consist, claimed the combination of mechanism, and the making of envelopes for bottles as described:—*Held*, that the specification was for the mode of making, and not for the envelope; and that it was, therefore, not larger than the grant. (28 L. J., C. P. 22; 5 C. B., N. S. 164; 5 Jur. N.S. 174.)

## (l) OXLEY v. HOLDEN. [1860]

The title was "for certain improvements in the doors and sashes of carriages." The specification stated, that the improvements were applicable "in any position where windows and doors are subject to jar and vibration." Erle, C.J., delivering the judgment of the Court, said: "It seems to us reasonable that the claim should be construed with reference to the title, and confined accordingly to the doors and windows of carriages. The present case has no analogy to the decision of this Court in *Croll*

*v. Edge.*" (8 *C. B.*, *N. S.* 707; 30 *L. J.*, *C. P.* 74; 8 *W. R.* 627; 2 *L. T. Rep.*, *N. S.* 464.)

(*m*) *PENN v. BIBBY: PENN v. JACK.* [1866]

Evidence may be given, under an issue as to the sufficiency of the specification, to prove a variance between the complete specification and the title, or provisional specification. (*L. R.* 2 *Ch.* 130; 36 *L. J. Ch.* 458; 15 *L. T. Rep.*, *N. S.* 401; 15 *W. R.* 211.)

(*n*) *PARKES v. STEVENS.* [1869]

A patent was entitled for "improvements in the manufacture of railway station and other gas lamps," but the specification claimed only (by reference to a former specification) improvements in "that class of lanterns suitable for suspension in railway stations and other public places." Whether the patent was confined to lamps suspended, *quære.* (*L. R.*, 8 *Eq.* 358; 38 *L. J.*, *Ch.* 627.)

(*o*) *WRIGHT v. HITCHCOCK.* [1870]

Patent "for the invention of improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The provisional specification described the invention, as relating to the manufacture of frills or ruffles, but the complete specification extended the invention to the manufacture of frills, ruffles, or trimmings. *Held*, that as the words "frills, ruffles, and trimmings," are all *ejusdem generis*, and as they are only important as showing what it is that is ultimately to be made by the machinery of which alone the plaintiff claims to be the inventor, the variation is not such as to render the patent invalid. (*L. R.* 5 *Ex.* 37; 39 *L. J.*, *Ex.* 97.)

**Tools**, application of known, to new purpose, pp. 526 (*x*), 527 (*y*).

**Trade** known not prohibited, p. 492 (*y*).

**Trade Secrets**, disclosure of, by inspection, pp. 325 (*w*), 328 (*f*), 330 (*n*\*)  
by discovery, pp. 320 (*x*), (*a*), 324 (*q*\*)  
to assessor of Court, p. 65 (*c*), 95 (*c*).

**Transmission** of Patents to be entered on Register, sect. 23, p. 397.

**True and First Inventor.**

the person who discovers a new manufacture, p. 273 (*n*), 243 (*f*).

the importer from abroad of a new manufacture, p. 272 (*g*), 277 (*b*).

person who makes joint application with inventor, p. 206.

legal representative of inventor, Patents Act, 1883, sect. 34, p. 272.

declaration as to, sect. 5 subs. (2), p. 81.

patent to, not invalidated by fraudulent application, Patents Act, 1883, sect. 35, p. 569.

**PATENTS ACT, 1883, sect. 35.** A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

**Trust** not to be entered on Register. Patents Act, 1883, sect. 85, p. 569.

PATENTS ACT, 1883, sect. 85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive.

### Trustee.

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(*o*) *RUSSELL v. LEDSAM.*

User between expiry and renewal of patent is no infringement, (16 *M. & W.* 641.)

(*p*) *UNWIN v. HEATH.*

Proof of a user of an invention such as before the patent was granted would be evidence that there was no novelty, if taking place after the patent is evidence of an infringement. (25 *L. J., C. P.* 13.)

### Utility of Invention.

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*Want of in part of an invention—*

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or unnecessary waste is involved, p. 579 (b).

*Question for the jury—*

whether invention claimed is useful or not, p. 580.

### *Utility generally.*

(q) *DARCY v. ALLIN.* [1602]

“Where any man by his own charge and industry, or by his own wit or invention, doth bring any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before: and that for the good of the realm: that in such cases the King may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth bring by his invention to the commonwealth: otherwise not.” (*Noy, R.* 182.)

(r) *EDGEBERRY v. STEPHENS.* [1691]

The Act 21 Jac. I. intended to encourage new devices useful to the kingdom. (1 *Web. P. C.* 35; *Dav. P. C.* 36.)

(s) *REX v. ARKWRIGHT.* *Scire facias.* [1785]

When an invention is proved to be new, the question of its materiality or utility arises. (*Dav. P. C.* 138; 1 *Web. P. C.* 72.)

(t) *TURNER v. WINTER.* [1787]

Ashurst, J., said: “I think that, as every patent is calculated to give a monopoly to the patentee, it is so far against the principles of law, and would be a reason against it, were it not for the advantage which the public derive from the communication of the invention.” (*Dav. P. C.* 151; 1 *T. R.* 605; 1 *Web. P. C.* 80.)

(u) *BOULTON v. BULL.* [1795]

Rooke, J., in the course of his judgment, said, that the public have a right to receive a meritorious consideration in return for the protection which a patentee claims. (2 *H. Bl.* 478.) Buller, J., said: “The invention professes to lessen the consumption (of steam), and, to make the patent good, the method must be capable of lessening the consumption to such an extent as to make the invention useful. More precision is not necessary, and absolute precision is not practicable.” (*Ib.* 498.)

(v) *HUDDART v. GRIMSHAW.* N. P. [1803]

Ellenborough, C.J., told the jury that if an invention “be productive of a new end, and beneficial to the public, it is that species of invention which, protected by the King’s patent, ought to continue to the person the sole right of vending.” (1 *Web. P. C.* 86; *Dav. P. C.* 278.)

(w) *MANTON v. PARKER.* N. P. [1814]

The patent was for "a hammer, on an improved construction, for the locks of all kinds of fowling-pieces and small arms." A material part of the invention consisted in a means of letting out the air from the barrel, and causing a communication between the powder in the pan and in the barrel, without, at the same time, letting out the powder. The witnesses for the defendant having proved that the powder passed through the same hole as the air, Thomson, C.B., held: "That the utility of the invention, and the purpose of the patent, wholly fail; for the purpose of the hole, as described in the specification, is to let the air pass through, and at the same time secure the powder from passing through; that of itself would be an answer to the action." (*Dav. P. C.* 327; 1 *Web. P. C.* 192, (n).)

(x) *MANTON v. MANTON.* N. P. [1815]

Gibbs, C.J., held that "in order to support a right to the exclusive enjoyment of any invention, it is necessary that the party who takes out the patent should show that the invention is new, that it was unknown to the trade and to the world before; that it is not only new, but that it is useful to the public." (*Dav. P. C.* 348.)

(y) *BOVILL v. MOORE.* N. P. [1816]

Action for the infringement of a patent. Gibbs, C.J.: "In point of law it is necessary that the plaintiff should prove that this is a new and useful invention, in order to entitle himself to the present action." (*Dav. P. C.* 399.)

(z) *HILL v. THOMPSON.* [1817-8]

A patent can be supported only for an invention which is useful. (3 *Mer.* 629; *Web. P. C.* 237.) Dallas, J., delivering the judgment of the Court of Common Pleas, said: "If any part of an alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void." (8 *Taun.* 401; 2 *B. Moore*, 457; *Web. P. C.* 249.)

(a) *LEWIS v. MARLING.* [1829]

Parke, J., in the course of his judgment, said: "The prerogative of the Crown as to granting patents was restrained by the statute 21 Jac. 1, c. 3, s. 6, to cases of grants 'to the true and first inventors of manufactures, which others at the time of granting the patent shall not use.' The condition therefore is, that the thing shall be new, not that it shall be useful; and although the question of its utility has been sometimes left to a jury, I think the condition imposed by the statute has been complied with when it has been proved to be new." (10 *B. & C.* 28; 4 *Car. & P.* 58; 1 *Web. P. C.* 497.)

(b) *LEWIS v. DAVIS.* N. P. [1829]

A patent being for an improvement on a former patent, it is not material whether a machine made according to the first patent

would be useful or not, if it be shown that a machine constructed according to the subsequent patent is useful. (3 *Car. & P.* 504; 1 *Web. P. C.* 489.)

(c) *MINTER v. WELLS.* N. P. [1834]

Alderson, B.: "The plaintiff, in order to establish his right, must show that the invention is new, and that it is useful." (1 *Web. P. C.* 129.)

(d) *RUSSELL v. COWLEY.* [1835]

Lyndhurst, C.J.: "The first question is, is this a new and useful invention?" (1 *Web. P. C.* 467.)

(e) *MORGAN v. SEAWARD.* [1837]

In delivering the judgment of the Court, Parke, B., said: "A grant of a monopoly for an invention which is altogether useless, may well be considered as 'mischievous to the State, to the hurt of trade, or generally inconvenient,' within the meaning of the statute of James I., which requires, as a condition of the grant, that it should not be so, for no addition or improvement of such an invention could be made by anyone during the continuance of the monopoly, without obliging the person making use of it to purchase a useless invention; and on a review of the cases, it may be doubted whether the question of utility is anything more than a compendious mode, introduced in comparatively modern times, of deciding the question, whether the patent be void under the statute of monopolies." (2 *M. & W.* 562; *Mur. & H.* 61; 1 *Jur.* 529; 1 *Web. P. C.* 197.)

(f) *Re CUTLER'S PATENT.* Ch. [1839]

This was a petition to the Lord Chancellor, to affix the great seal to letters patent, obtained by Cutler, against which a *caveat* had been lodged. It was urged that Cutler's invention was not useful, and that, therefore, the great seal ought not to be affixed to his letters patent. Lord Cottenham, L.C., referring to this objection, said: "It is not very easy sitting here to form any very conclusive opinion as to the usefulness, nor is it very necessary to inquire into that (particularly considering from whom the objection emanates), because if it be so perfectly useless as is represented, it will interfere with no man's rights, and it will be a mere dead letter, which no man would wish to imitate if they had the right." (1 *Web. P. C.* 426.)

(g) *CRANE v. PRICE.* [1842]

Tindal, C.J.: "If the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether by some sudden and lucky thought, or mere accidental discovery." (4 *M. & G.* 605; 1 *Web. P. C.* 411.)

(h) *WALTON v. BATEMAN*. N. P. [1842]

Cresswell, J. : "Then, gentlemen, we come to another objection—I really do not know what plea it applies to—that the invention claimed by the patent is not of any public use or benefit. It is supposed that that may be a question under the 'new manufacture.' I entertain great doubts upon that, because a thing may be a new manufacture, and perhaps may not be of any public use or benefit." (1 *Web. P. C.* 623.)

(i) *POW v. TAUNTON*. [1845]

Patent for the invention of a nipping lever, for causing the rotation of wheels, shafts, or cylinders, under certain circumstances. The specification claimed as the invention "the nipping lever, with its tusk and sliding-box, applied to a rimmed wheel, or to a rimmed flange, for the purpose of causing the same to rotate or move together with any shaft, cylinder, or other suitable machinery which may be attached thereto." The nipping lever was not new; but the application of it by means of the sliding-box was new:—*Held*, that it must also appear that the use of a sliding-box was essential to the invention. (9 *Jur.* 1056.)

(j) *CROSSLEY v. POTTER*. N. P. [1853]

Pollock, C.B., in addressing the jury, said: "A patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the ingenuity of mankind, and the introduction of other inventions adapted to the particular subject to which the invention may be applicable. . . . a patent, the object of which is, not to benefit the world by its communication, but to obstruct by the very general character of the claims made for conferring peculiar privileges on the patentee; such a patent as that, in my judgment, cannot be supported." (*Macr. P. C.* 245.)

(k) *SIMPSON v. HOLLIDAY*. Ch. [1864]

It appears to be necessary that a patented invention should be useful, not only at the time the patent is granted, but also during the whole term of the grant. (20 *New Lon. Jour., N. S.* 107, 120.)

(l) *YOUNG v. ROSENTHAL*. [1883-4]

In law, utility means an invention better than the preceding knowledge of the trade as to a particular fabric. It does not mean abstract utility. Thus in the case of improved stays, the question is not whether stays are useful, but whether, taking stays as they were before, there is anything in the plaintiff's invention which is more useful than the stays people had before. The jury found that the invention was not useful. (*Griff.* 249; 1 *O. R.* 29.)

(m) *PHILPOTT v. HANBURY*. (1884-5)

Grove, J. : "It has been decided over and over again that the slightest amount of utility (I will not say an infinitesimal scintilla,

but a very slight amount of utility), is sufficient to sustain a patent, and that for the purpose of utility, as indeed for the purposes of most of the other issues, you must take it by itself." (*Griff.* 185; 2 *O. R.* 33 at p. 37.)

(n) *BADISCHE ANILIN UND SODA FABRIK v. LEVINSTEIN.* H. L. [1887]

In a patent "for improvements in colouring matters suitable for dyeing and printing," the specification began, "The invention consists in the production of red and brown colouring matters, which in chemical language may be termed the sulpho-acids of oxyazo naphthaline," and then described four processes. All the processes were, in fact, found to produce sulpho-acids of oxyazo naphthaline applicable to dyeing and printing which varied in colour, but within the limits of red and brown. The specification did not point out what particular shade would be produced by either of the processes, nor did it indicate which would be of the greatest practical utility either from the colour produced being in demand, or from greater economy in the cost of production; but it appeared from the evidence that when once a desired shade had been obtained there would be no practical difficulty in repeating the process with a reasonable certainty of producing the same result. The majority of the Court of Appeal (Bowen and Fry, L.JJ.), *held*, that as there was only one shade of red colouring matter which had any commercial value, and as it was impossible to discover without experiment which of the processes was to be used, and how it was to be conducted, in order to produce that shade, the patent was invalid, since either the specification intended to claim the production of the sulpho-acid of oxyazo naphthaline in all its isomeric modifications, in which case it was only an important step towards a useful discovery, but was not in itself useful, or the specification intended to claim the production of the particular isomer which was of commercial value, in which case it did not show without further experiment how to arrive at the desired result. (24 *Ch. D.* 156; 29 *Ch. D.* 366.) *Held*, by the House of Lords, that the patent was not invalid. That the specification intended to claim the production of all the isomeric forms, that it was not possible to differentiate the isomeric forms except by a description of the colour produced, and that it was not incumbent on the inventor in such a case to indicate the respective commercial advantages of the varying shades. (12 *App. C.* 710.) Per Lord Herschell: It is not "a correct test of utility to inquire whether the invented product was at the time of the patent likely to be in commercial demand, or capable of being produced at a cost which would make it a profitable speculation to manufacture it." (*Ib.* 710.)

(o) *DEUTSCHE NAHMASCHINEN FABRIK v. PFAFF.* [1889]

A largely increased sale of a machine owing to an improvement, is much more cogent evidence of the utility than it is of the novelty of the improvement. (7 *O. R.* 16.)

(p) WINBY *v.* MANCHESTER STEAM TRAMWAYS COMPANY. [1889]

In a patent for improvements in points and crossings for tramways:—*Held*, by Bristow, V.-C., that the invention of a movable bar or point piece, which is actuated by a spring in a vertical instead of a horizontal direction, and is automatic and effective to guide the cars on to the left hand track without any drop, is sufficiently useful to be good subject-matter. (6 *O. R.* 359; 7 *O. R.* 30.)

*Degree of Utility.*

(q) CORNISH *v.* KEENE. N. P. [1835]

Action for the infringement of a patent for “an improvement or improvements in the making or manufacturing of elastic goods or fabrics, applicable to various useful purposes.” Tindal, C.J.: “It is a circumstance in the case that it is found useful for surgical purposes. The patent, however, is not taken out for that purpose, and it would not be sufficient in order to maintain the patent, on the ground of its being an improvement, to show that it was an improvement in surgical cases for bandages only, because the patent is not only confined to that, but they must prove also that it is generally an improvement with respect to the general uses of that fabric or manufacture which was intended—that is, with respect to braces, garters, and other articles that are made of it. The evidence on the part of the plaintiffs states that it is cheaper, and cheapness is an improvement, and not to be laid aside and thought nothing of, and you are to consider it among other things; but that is not the only thing to be considered, because they may have a thing too cheap to be useful, and you must see whether it combines with it the other property of utility which the former fabric, when used for the same purpose, possesses.” (1 *Web. P. C.* 506.)

(r) MORGAN *v.* SEAWARD. N. P. [1836]

Action for infringement. Defendants denied the utility of the plaintiff's invention. Alderson, B., directing the jury upon this point, said: “It is not for you to consider to what extent the thing is useful. If it is a useful invention, then it is a subject to be protected by patent; and if, on the other hand, it is of no use, then it is no subject to be protected by patent. The issue is, whether it is of any use at all.” (1 *Web. P. C.* 172.)

(s) LOSH *v.* HAGUE. N. P. [1838]

Action for the infringement of a patent for “certain improvements in the construction of wheels for carriages to be used on railways.” Plea, *inter alia*, “that the said supposed improvements, &c. . . . are only trifling and insignificant alterations in the mode of making wheels before then known and in public use, and are not legal subjects for the grant of the said letters patent.” Abinger, C.B., in directing the jury, said: “I observe

one of the pleas states, that the improvements are something trifling and insignificant. If that is the improvement, you will consider whether it is worth a patent or not." (1 *Web. P. C.* 202.)

(t) *NEILSON v. HARFORD.* N. P. [1841]

An invention to support a patent must be productive practically of some beneficial result, no matter how great, provided it is sufficient to make it worth while (the expense being taken into consideration) to adopt it. (1 *Web. P. C.* 314.) It is not necessary that each part should have been actually tried and proved to answer; the evidence of scientific persons that it would answer may be sufficient. (*Ib.* 316.)

(t\*) *TETLEY v. EASTON.* N. P. [1852]

When a machine can do that which, apparently, no other machine can be got to do, it must be pronounced useful, even though its cost is very considerable. It is not necessary that a patent should be so useful as to exclude everything else; it is quite sufficient if on any occasion it is useful. (*Macr. P. C.* 63.)

(u) *HINKS v. SAFETY LIGHTING COMPANY.* M. R. [1876]

The legal meaning of the term "useful" is very slight utility indeed. (4 *Ch. D.* 616.)

(v) *LAWRENCE v. PERRY.* [1883]

North, J.: "Under these circumstances I have felt some difficulty in seeing how the plaintiff's invention can be useful when it only differs from an earlier one by an ingredient which does neither harm nor good." (*Griff.* 143; 2 *O. R.* 180 at p. 184.)

(w) *UNITED TELEPHONE COMPANY v. BASSANO.* [1886]

The defendants objected that the telephone in question, and especially the tension regulator portion thereof, was not commercially useful, and had never been in actual use:—*Held*, that it did not necessarily follow that the patent was bad, for even the most original and valuable inventions might be immediately superseded by simpler constructions involving the same principle. (3 *O. R.* 295.)

(x) *SIDDELL v. VICKERS.* C. A. [1888]

Kekewich, J., following *Badische Anilin v. Levinstein*, *held*, that it was no answer to the plaintiff to say that two of his processes were not immediately likely to be commercial successes, and on the evidence *held*, that the invention was useful. (5 *O. R.* 81.) The Court of Appeal refused to disturb the finding as being not incorrect, and as being a finding of fact. (5 *O. R.* 430.)

*Want of Utility in a Part of Invention.*

(w) LEWIS v. MARLING. [1829]

Where a patentee of an improved machine claimed as his invention a part of it which turned out to be useless, it was held that this did not vitiate the patent, the specification not describing it as essential to the machine. Bayley, J., said: "If the party knew that it (the useless part of the machine) was unnecessary, the patent would be bad on the ground that this was a deception; but if he thought that it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms no ground of objection." (1 *Web. P. C.* 496.)

(x) HAWORTH v. HARDCASTLE. [1834]

In an action for the infringement of a patent the jury found as follows: "The invention is new and useful upon the whole, . . . they also find that the machine is not useful in some cases for taking off goods." Verdict for the plaintiff. The Court subsequently refused to make absolute a rule *nisi* for a nonsuit, on the ground that the jury had, by their special finding, negatived the usefulness of the invention to the full extent of what the patent and specification had held out to the public. Tindal, C.J., delivering the judgment of the Court, said: "The jury find 'the invention is new and useful upon the whole; . . . but they also find that the machine is not useful in some cases for taking off goods.' . . . But we think we are not warranted in drawing so strict a conclusion from this finding of the jury, as to hold that they have intended to negative, or that they have thereby negatived, that the machine was useful in the generality of the cases which occur for that purpose. After stating that the machine was useful on the whole, the expression, that 'in some cases it is not useful to take up the cloths,' appears to us to lead rather to the inference that in the generality of cases it is found useful. And if the jury think it useful in the general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void. . . . We think that we should act with great hazard and precipitation if we were to hold that the plaintiff ought to be nonsuited, upon the ground that his machine was altogether useless for one of the purposes described in his specification." (1 *Web. P. C.* 483; 4 *M. & Sc.* 732; 1 *Bing. N. C.* 189.)

(y) MORGAN v. SEAWARD. [1837]

Alderson, B. . "We do not mean to intimate any doubt as to the validity of a patent for an entire machine or subject which is, taken altogether, useful, though a part or parts may be useless, always supposing that such patent contains no false suggestion." (1 *Web. P. C.* 197.)

(z) FREARSON v. LOE. M. R. [1878]

"It is not because a patentee has attempted to claim as an advantage something else to which he is not entitled, that the improvement he has made is to be held not worthy of a patent. I



am not to say that, because even half of the advantages said to arise from his invention may not be new, he is not to be protected in respect of the other half." *Per Jessel, M.R.* (9 *Ch. D.* 64.)

(2) *BAILEY v. ROBERTON.* H. L. [1878]

Patent for "improvements in preserving organic substances." The patentee (Rattray), in his specification, described his invention to consist of "the use of the alkaline and earthy sulphites." Lord Blackburn: The patentee says, "he will take any sulphite, and that, as it is pointed out in the evidence, is a matter which would prevent the operation of his patent from being beneficial. It is well known that some of the earthy sulphites in a dry form are rank poison, and that would be a very serious objection indeed to their use for the preservation of meat—others while not poisonous are objectionable. We know that the alkaline sulphite of soda, for instance, turns into Glauber salts, the sulphite of magnesia turns into Epsom salts, and we know what the effect of that upon the human body would be, and sulphite of lime turns into plaster of Paris. These are all objections which may be very strong ones against Rattray's specification." (3 *App. Cas.* 1078.)

(a) *EASTERBROOK v. GREAT WESTERN RAILWAY COMPANY.* [1885]

In an action for infringement of a patent for improvements in signalling apparatus for railways, it was shown that it was possible without straining to lower simultaneously the signals protecting the main up, the main down, and the branch line. The patent was held bad on the ground of want of utility. Wills, J.: "The specification here points to its universal application for railway signalling, including its use at the most complicated junctions and sidings. If it be useful for one very small and insignificant section of its proposed work, and for the rest is, as in my opinion it is proved to be, fraught with danger and death, the specification is bad, as not distinguishing between its useful and its useless applications. It is as consonant with good sense as I believe it to be with good law, that an inventor who invites the indiscriminate use of apparatus sure to bring about disaster in the long run if generally applied according to his invitation, cannot maintain a patent for his invention because it will do some useful work at places and under circumstances where mechanical appliances for preventing conflict of signals are scarcely necessary at all, while elsewhere it is full of danger to the public." (*Griff.* 85; 2 *O. R.* 201 at p. 210; 3 *O. R.* 94.)

(b) *UNITED HORSESHOE AND NAIL COMPANY v. SWEDISH HORSENAIL COMPANY.* [1888]

The invention claimed in the plaintiffs' sixth claim, consisted exclusively in making the nail blanks cut from one edge of the plate wider at or near the head than those cut from the other edge of the plate:—*Held*, that as this could not be done without unnecessary waste, the invention was of no utility, and that therefore the whole patent was invalid. (6 *O. R.* 1.)

(c) *EHRLICH v. IHLEE*. C. A. [1888]

Where there is general utility in an invention, it is necessary to show very little utility in order to support a second claim which is only subsidiary. (5 *O. R.* 437.)

*Question for the Jury.*

(d) *HILL v. THOMPSON*. [1817]

The utility of an invention is a question for the jury. (3 *Mer.* 630; *Web. P. C.* 237.)

(e) *BLOXAM v. ELSEE*. N. P. [1825]

Abbott, C.J., left it to the jury to say whether the invention was useful. (1 *C. & P.* 565.)

(f) *CORNISH v. KEENE*. N. P. [1835]

The evidence respecting the utility of a patented article being conflicting, and the article itself being produced, it is for the jury to use their own judgment of the matter, and determine whether it is useful or not. (1 *Web. P. C.* 506.)

(g) *MACNAMARA v. HULSE*. N. P. [1842]

Where, in an action for infringing a patent for blocks for pavement, the plaintiff claimed as his invention that his blocks were bevelled both inwards and outwards on the same side, but the specification did not state at what angle the bevels should be made; and one witness stated that the angle was material, but another witness stated that any angle would be of some benefit, Lord Abinger, C.J., said: "It will be for the jury to say whether any particular angle is essential, or whether any angle whatever is useful and beneficial." (*Car. & M.* 471.)

### Validity of Patent,

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### Variations in Rules.

PATENTS ACT, 1883, sect. 101. (1) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

- (c) For making or requiring duplicates of specifications, amendment, drawings, and other documents;
- (d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications drawings amendments and other documents;
- (e) For securing and regulating the making printing publishing and selling of indexes to, and abridgments of, specifications and other

documents in the Patent Office ; and providing for the inspection of indexes and abridgments and other documents ;

(f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad ;

(g) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

Sect. 115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal alteration or amendment shall take effect before the commencement of this Act ; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

## Vending,

patented article. See under Infringement, pp. 163-171.

## Venue,

motion to change, refused, p. 353 (*j*)

affidavit in support of, p. 353 (*i*)

changed to assizes, p. 353 (*l*) (*m*)

of petition for revocation, pp. 353 (*m*), 403 (*i*)

of infringement by posting from Scotland to England, p. 353 (*k*).

**Verbal errors** in specification, p. 430 (*t*).

**Waiver** of forfeiture by acceptance of licence rent, p. 213 (*y*).

**War**, munitions of, Patents Act, 1883, sect. 44, pp. 406, 407.

## Words,

in specification to be construed according to their ordinary meaning, p. 473 (*z*)

and read as by a person of ordinary understanding, p. 466 (*a*).

**Workman** is not liable for infringement committed by order of master, p. 165 (*u*).

## CASES CLASSED ACCORDING TO THEIR SUBJECT-MATTER.

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The following Table is given to facilitate the finding of a case of which the name is forgotten, while the nature of the invention is known. The classes are those under which the abridgments of Specifications are grouped by the Patent Office, and the numbers and letters following each class indicate some cases in which inventions belonging to that class have been before the Courts.

Acids, alkalis, oxides and salts .. ..	458 (e); 496 (l); 517 (t); 542 (d); 552 (y)
Agriculture :—	
I. Field implements .. .. .	176 (s); 506 (o)
II. Barn and farmyard implements ..	214 (e); 509 (u)
Air engines and other motive power engines	68 (n); 199 (g); 524 (s); 547 (k); 567 (f)
Anchors .. .. .	123 (r); 148 (p); 522 (n)
Artist's instruments and materials .. ..	436 (i); 439 (n); 444 (h)
Bleaching, dyeing and printing fabrics ..	53 (d); 136 (v); 154 (c); 242 (c); 313 (x); 320 (a); 443 (e); 575 (n); 518 (v); 525 (u)
Books, portfolios, card-cases, &c. .. ..	123 (n)
Brewing, wine making and distilling alcoholic liquids	241 (x); 423 (u)
Bricks and tiles .. .. .	46 (m); 49 (h); 109 (e); 183 (l); 352 (f)
Bridges, viaducts and aqueducts .. ..	525 (v)
Carriages and other vehicles for common roads	303 (j); 403 (h); 459 (i); 469 (m); 512 (c); 539 (x <sup>1</sup> ); 553 (z); 564 (w)
Casks and barrels .. .. .	37 (c); 45 (g)
Chains, chain cables, &c. .. .. .	49 (f); 223 (b); 306 (z); 531 (e)
Cooking, bread-making and confectionery	126 (a <sup>1</sup> ); 444 (f <sup>1</sup> )
Cork, preparation of, bottling liquids, &c.	160 (d); 196 (u); 238 (q); 526 (x); 549 (p); 555 (f)
Drains and sewers, including the manufacture of drain tiles and pipes	21 (d); 118 (s); 241 (y) (b); 515 (n)
Dressing and finishing woven fabrics, and manufacturing felted fabrics	70 (v); 439 (p); 459 (h); 463 (b); 464 (w); 470 (s) (t); 487 (g); 501 (b); 514 (g); 527 (y); 531 (g); 539 (x); 576 (q)
Electricity and magnetism :—	
I. Generation of .. .. .	63 (x); 271 (f); 420 (j); 553 (a)
II. Conducting and insulating .. ..	192 (p); 295 (y); 411 (n); 466 (b)
III. Transmitting and receiving signals, controlling mechanical action and exhibiting electrical effects	95 (b); 162 (i); 170 (z); 182 (i); 199 (f); 292 (n) (p); 298 (n); 349 (t); 382 (i) (j); 411 (n); 417 (c); 466 (b); 479 (k); 549 (q)
IV. Electric lighting, igniting and heating	52 (z); 315 (d); 404 (j); 435 (f); 444 (g); 532 (h)

Electricity and magnetism ( <i>contd.</i> ):—	
V. Electro deposition and electrolysis	329 ( <i>j</i> )
VI. Electric motive power engines and similar apparatus	291 ( <i>m</i> ); 306 ( <i>u</i> )
Farriery, including medical and surgical treatment of animals	451 ( <i>h</i> )
Fire-arms and other weapons, ammunition and accoutrements	59 ( <i>k</i> ); 117 ( <i>n</i> ); 138 ( <i>d</i> ); 169 ( <i>v</i> ); 184 ( <i>p</i> ); 196 ( <i>w</i> ); 198 ( <i>a</i> ); 216 ( <i>j</i> ); 297 ( <i>f</i> ); 332 ( <i>v</i> ); 432 ( <i>b</i> ); 449 ( <i>d</i> ); 460 ( <i>h</i> ); 572 ( <i>w</i> ) ( <i>x</i> )
Fire engines, extinguishers, escapes, &c.	46 ( <i>m</i> ); 522 ( <i>l</i> ); 539 ( <i>w</i> )
Food, preservation of .. .. .	111 ( <i>k</i> ); 403 ( <i>f</i> ); 415 ( <i>b</i> )
Fuel, preparation and combustion of ..	7 ( <i>j</i> ); 14 ( <i>c</i> ); 129 ( <i>o</i> ); 174 ( <i>n</i> ); 185 ( <i>x</i> ); 218 ( <i>p</i> ); 224 ( <i>d</i> ); 445 ( <i>k</i> ); 495 ( <i>h</i> )
Furniture and upholstery .. .. .	44 ( <i>c</i> ); 246 ( <i>s</i> ); 326 ( <i>b</i> ); 453 ( <i>l</i> ); 456 ( <i>u</i> ); 494 ( <i>e</i> ); 509 ( <i>x</i> ); 538 ( <i>v</i> ); 548 ( <i>o</i> )
Gas, production and applications of ..	53 ( <i>a</i> ); 89 ( <i>g</i> ); 121 ( <i>h</i> ); 159 ( <i>a</i> ); 200 ( <i>i</i> ) ( <i>j</i> ); 258 ( <i>s</i> ); 312 ( <i>q</i> ); 424 ( <i>x</i> ); 457 ( <i>b</i> ); 469 ( <i>l</i> ); 533 ( <i>k</i> ); 538 ( <i>w</i> ); 568 ( <i>i</i> )
Grinding grain and dressing flour and meal	177 ( <i>v</i> ) ( <i>w</i> ); 191 ( <i>k</i> ); 251 ( <i>d</i> ); 264 ( <i>k</i> ); 476 ( <i>d</i> ); 503 ( <i>g</i> )
Harbours, docks, canals, &c. .. ..	116 ( <i>g</i> ); 237 ( <i>p</i> ); 412 ( <i>o</i> ); 525 ( <i>v</i> )
Hinges, hinge joints, and door springs ..	537 ( <i>q</i> )
Hydraulics .. .. .	127 ( <i>g</i> ); 171 ( <i>b</i> ); 173 ( <i>i</i> ); 179 ( <i>c</i> ); 182 ( <i>j</i> ); 189 ( <i>i</i> ); 550 ( <i>r</i> )
Ice-making machines, ice safes, and ice houses	323 ( <i>n</i> )
Indiarubber and guttapercha, preparation of	52 ( <i>u</i> ); 188 ( <i>h</i> ); 207 ( <i>j</i> ); 333 ( <i>z</i> <sup>1</sup> ); 494 ( <i>f</i> ); 509 ( <i>w</i> ); 522 ( <i>m</i> )
Instruments, philosophical, nautical and meteorological	201 ( <i>p</i> ); 272 ( <i>h</i> ); 445 ( <i>i</i> )
Iron and steel, manufacture of .. ..	8 ( <i>m</i> ); 88 ( <i>d</i> ); 189 ( <i>j</i> ); 237 ( <i>o</i> ); 372 ( <i>c</i> ); 496 ( <i>l</i> ); 502 ( <i>e</i> ); 566 ( <i>b</i> )
Lace-making, knitting, netting, braiding and plaiting	50 ( <i>i</i> ); 198 ( <i>b</i> ); 299 ( <i>o</i> ); 415 ( <i>a</i> ); 429 ( <i>q</i> ); 447 ( <i>p</i> ); 454 ( <i>o</i> ); 459 ( <i>g</i> ); 512 ( <i>b</i> ); 538 ( <i>t</i> ) ( <i>u</i> ); 567 ( <i>e</i> )
Lamps, candlesticks, and other illuminating apparatus	128 ( <i>l</i> ); 418 ( <i>d</i> ); 431 ( <i>y</i> ); 537 ( <i>q</i> ); 548 ( <i>n</i> ); 554 ( <i>c</i> ); 562 ( <i>p</i> )
Locks, latches, bolts and similar fastenings	200 ( <i>k</i> <sup>1</sup> ); 235 ( <i>j</i> ); 308 ( <i>d</i> )
Locomotion, aids to .. .. .	217 ( <i>o</i> ); 218 ( <i>q</i> ); 240 ( <i>u</i> ); 292 ( <i>r</i> ) 50 ( <i>m</i> ); 323 ( <i>o</i> )
Manure .. .. .	89 ( <i>h</i> ); 130 ( <i>r</i> <sup>1</sup> ); 163 ( <i>n</i> ); 531 ( <i>f</i> )
Marine propulsion .. .. .	55 ( <i>j</i> ); 157 ( <i>x</i> ); 414 ( <i>y</i> ); 563 ( <i>u</i> )
Masts, sails, rigging, &c. .. ..	113 ( <i>x</i> ); 342 ( <i>j</i> ); 467 ( <i>f</i> ); 562 ( <i>q</i> )
Medicine, surgery and dentistry .. ..	436 ( <i>g</i> ); 438 ( <i>m</i> )
Metals and alloys .. .. .	18 ( <i>v</i> ); 114 ( <i>d</i> ); 137 ( <i>y</i> ); 172 ( <i>e</i> ); 222 ( <i>w</i> )
Mining, quarrying, tunnelling and well-sinking	17 ( <i>t</i> ); 42 ( <i>v</i> ); 49 ( <i>g</i> ); 72 ( <i>b</i> ); 156 ( <i>s</i> ); 162 ( <i>h</i> ); 209 ( <i>p</i> ); 441 ( <i>v</i> ); 432 ( <i>b</i> )
Music and musical instruments .. ..	521 ( <i>t</i> ); 532 ( <i>h</i> <sup>1</sup> ); 534 ( <i>m</i> ); 565 ( <i>z</i> )
Nails, rivets, bolts, screws, nuts and washers	240 ( <i>t</i> ); 376 ( <i>r</i> ); 521 ( <i>g</i> ); 579 ( <i>b</i> )
Needles and pins .. .. .	100 ( <i>d</i> )
Oilcloth, oilskin and other waterproof fabrics, and artificial leather	419 ( <i>g</i> ); 70 ( <i>v</i> ); 522 ( <i>m</i> )
Oils, fats, lubricants, candles, and soaps ..	69 ( <i>r</i> ); 132 ( <i>d</i> ); 257 ( <i>n</i> ); 349 ( <i>w</i> ); 365 ( <i>x</i> ); 402 ( <i>e</i> ); 420 ( <i>h</i> <sup>1</sup> )
Paints, colours and varnishes .. ..	477 ( <i>e</i> ); 436 ( <i>i</i> )
Paper, pasteboard and papier maché ..	53 ( <i>b</i> ); 112 ( <i>t</i> ); 439 ( <i>o</i> ); 455 ( <i>s</i> )
Photography .. .. .	295 ( <i>z</i> ); 465 ( <i>z</i> )

Pipes and tubes, metallic .. .. .	213 (z); 461 (n); 524 (t); 539 (w)
Plating or coating metals with metals ..	25 (z); 174 (k); 194 (s)
Pottery .. .. .	49 (d); 156 (q); 264 (m); 464 (y); 499 (u)
Printing, typographic .. .. .	123 (n); 327 (c); 442 (c); 445 (j)
Railway carriages and other vehicles ..	21 (c); 114 (c); 137 (w); 173 (j); 348 (n); 452 (i); 485 (a); 521 (e); 576 (s)
Railway signals and communicating apparatus	179 (b); 243 (h); 321 (g); 579 (a)
Railways .. .. .	448 (v); 534 (n); 576 (p)
Raising, lowering, and weighing .. ..	51 (r) (s); 200 (m); 201 (n) (o); 554 (e)
Roads and ways .. .. .	428 (k); 499 (s); 508 (t); 564 (v)
Saddlery, harness, stable fittings, &c. ..	451 (h)
Safes, strong rooms, tills, &c. .. ..	200 (k <sup>1</sup> )
Sewing and embroidering .. .. .	261 (c); 311 (m <sup>1</sup> ); 320 (x); 328 (e); 343 (q); 415 (z); 458 (c)
Ships building, repairing, sheathing, launching, &c.	322 (i); 428 (l); 472 (v)
Skins, hides and leather .. .. .	318 (t); 344 (x); 348 (r); 514 (i)
Spinning, including the preparation of fibrous materials and doubling of yarns and threads	18 (w); 45 (f <sup>1</sup> ); 177 (x); 184 (q); 213 (a); 418 (f); 454 (n); 458 (d); 462 (q); 482 (q); 504 (i); 508 (s); 532 (j); 533 (j); 567 (g)
Starch, gum, size, glue, and other stiffen- ing and adhesive materials	533 (i)
Steam engines .. .. .	12 (s); 28 (k); 182 (h); 183 (k); 421 (n); 445 (l); 457 (y); 498 (o); 506 (p); 520 (a)
Steering and manœuvring vessels .. ..	201 (p); 234 (i)
Sugar .. .. .	121 (f); 171 (a); 225 (f); 424 (z); 453 (k)
Toys, games and exercises .. .. .	193 (q); 231 (d); 521 (h); 522 (k)
Umbrellas, parasols and walking sticks ..	241 (a); 371 (u); 504 (l)
Watches, clocks and other time-pieces ..	149 (v); 50 (l)
Water-purifying .. .. .	127 (c); 197 (x); 306 (w)
Water-closets, earth-closets, urinals, &c. ..	228 (u); 305 (p); 333 (z)
Wearing apparel :—	
1. Head coverings .. .. .	242 (b); 273 (k); 530 (c) (d)
2. Body .. .. .	182 (f); 200 (l); 463 (u); 480 (p); 510 (b); 521 (f <sup>1</sup> ); 528 (a); 574 (l)
3. Foot .. .. .	21 (e); 522 (j)
4. Dress-fastenings and jewellery ..	52 (v); 501 (c); 463 (u)
Weaving .. .. .	44 (d); 230 (b); 567 (g)
Writing instruments and materials .. ..	20 (y); 174 (m); 219 (s); 258 (p); 295 (x); 568 (j)













